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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. ~~383.~~ 87

CHRISTOPHER C. CAMPBELL, PLAINTIFF IN ERROR,

vs.

THE CITY OF HAVERHILL.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

FILED FEBRUARY 11, 1891.

(14,478.)

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JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., JANUARY 27, 1894.

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1 *Writ of Error.*

UNITED STATES OF AMERICA, *ss:*

Seal of the Circuit Court, Massachusetts.	The President of the United States to the honorable the judges of the circuit court of the United States for the district of Massachusetts, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said circuit court, before you, between Christopher C. Campbell, a citizen of the United States and residing in Chester, in the county of Hampden, in said Commonwealth, plaintiff, and The City of Haverhill, a corporation created and existing in due form of law in the county of Essex, in the Commonwealth of Massachusetts, defendant, in an action of tort, a manifest error hath happened, to the great damage of the said plaintiff, as by his complaint appears, we, being willing that error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the second Monday of October next, in the said Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done herein to correct that error what of right and according to the laws and custom of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the said Supreme Court, the thirtieth day of September, in the year of our Lord one thousand eight hundred and ninety.

JOHN G. STETSON,
Clerk of the Circuit Court of the United States,
District of Massachusetts.

Allowed by—
LE BARON B. COLT,
Circuit Judge.

The defendant in error acknowledges due service of citation upon this writ and waives any and all other service herein.

LIVERMORE & FISH,
Att'ys for Defendant.

2 *Return of Circuit Court on Writ of Error.*

CIRCUIT COURT OF THE UNITED STATES, *District of Massachusetts.* } *ss:*

And now here the judges of the circuit court of the United States in and for the district of Massachusetts make return of this writ by annexing hereto and sending herewith, under the seal of the said circuit court, a true and attested copy of the record and proceedings in the suit within mentioned, with all things concerning the same, to the Supreme Court of the United States, as within commanded.

Seal of the Circuit Court,
Massachusetts.

In testimony whereof I, John G. Stetson, clerk of said circuit court of the United States in and for the district of Massachusetts, have hereto set my hand and the seal of said court this first day of October, A. D. 1890.

JOHN G. STETSON, *Clerk.*

3 UNITED STATES OF AMERICA, *Massachusetts District,* *ss:*

At a circuit court of the United States for the first circuit, begun and holden at Boston, within and for the district of Massachusetts, on Wednesday, the fifteenth day of May, in the year of our Lord one thousand eight hundred and eighty-nine.

Before the Honorable Thomas L. Nelson, district judge.

4 CHRISTOPHER C. CAMPBELL, a Citizen of the United States and Residing in Chester, in the County of Hampden and Commonwealth of Massachusetts, Plaintiff,

v.

THE CITY OF HAVERHILL, a Corporation Created and Existing in Due Form of Law in the County of Essex, in the Commonwealth of Massachusetts, a Citizen of the United States, Defendant.

2925. Law Docket.

In an action of tort, *ad damnum* $10,000.

The writ in this cause and plaintiff's declaration filed with the writ are as follows:

Writ.

MASSACHUSETTS DISTRICT, *ss:*

[L. S.] The President of the United States of America to the marshal of our district of Massachusetts or his deputy, Greeting:

We command you to summon The City of Haverhill, a corporation created and existing in due form of law in the county of Essex, in the Commonwealth of Massachusetts, a citizen of the United States, in our district of Massachusetts (if it may be found in your district), to appear before our judges of our circuit court of said United States for the first circuit, next to be holden at Boston, within and for our said district of Massachusetts, on the fifteenth day of October next, then and there in our said court to answer unto Ruel Philbrook, trustee, a citizen of the United States and residing in Boston, Commonwealth of Massachusetts; James Knibbs, a citizen of the United States and residing in Troy, in the county of Rensselaer, State of New York; Marcus P. Norton, a citizen of the United States and now residing in the city, county, and State of New York; Lemuel H. Tupper, a citizen of the United States and now residing at Brooklyn, in the county of Kings and State of New York; Helen M. Ingalls, a citizen of the United States and now residing in the city, county, and State of New York; Marcus P. Norton, trustee, a citizen of the United States and now residing in the city, county, and State of New York; Christopher C. Campbell, assignee in trust, a citizen of the United States and residing in Chester, in the county of Hampden and Commonwealth of Massachusetts; Benjamin Richardson, a citizen of the United States, residing in the city, county, and State of New York, in a plea of trespass on the case, in an action of tort, to the damage of the said plaintiffs, as they say, the sum of ten thousand dollars, which shall then and there be made to appear, with other due damages, and have you there this writ, with your doings therein.

Witness the Honorable Morrison R. Waite, at Boston, the twentieth day of May, in the year of our Lord one thousand eight hundred and eighty-seven.

ALEX. H. TROWBRIDGE,
Deputy Clerk.

Plaintiffs' Declaration.

(Filed with writ.)

Ruel Philbrook, trustee, a citizen of the United States and residing in Boston, Commonwealth of Massachusetts; James Knibbs, a citizen of the United States and residing in Troy, in the county of Rensselaer, State of New York; Marcus P. Norton, a citizen of the United States and now residing in the city, county, and State of New York; Lemuel H. Tupper, a citizen of the United States and now residing at Brooklyn, in the county of Kings and State of New York; Helen M. Ingalls, a citizen of the United States and now residing in the city, county, and State of New York; Marcus P. Norton, trustee, a citizen of the United States and now residing in the city, county, and State of New York; Christopher C. Campbell, *Christopher C. Campbell*, assignee in trust, a citizen of the United States and residing in Chester, in the county of Hampden and Commonwealth of Massachusetts; Benjamin Richardson, a citizen of the United States, residing in the city, county, and State of New York, plaintiffs in this suit, complain of The City of Haverhill, a corporation created and existing in due form of law in the county of Essex, Commonwealth of Massachusetts, defendant, in a plea of trespass on the case—

For that James Knibbs, of the city of Troy, in the county of Rensselaer and State of New York, before and at the time of his application for the hereinafter-mentioned letters patent, was a citizen of the United States and was the true, original, and first inventor and discoverer of certain new and useful mechanism and improvements in pumps for steam fire or other engine pumps fully described in the specification of letters patent hereinafter mentioned and named therein and which were not known or used in this country and not patented or described in any printed publication in this or any foreign country before his invention thereof and were not in public use or on sale more than two years prior to his application for letters patent of the United States therefor.

And for that heretofore, to wit, on the twenty-fourth day of May, eighteen hundred and sixty-four, upon the application of the said James Knibbs in due form of law, letters patent were duly allowed and granted and were issued and delivered in due form of law upon said application to James Knibbs and Marcus P. Norton, then of the city of Troy, assignees of the said James Knibbs, and the said letters patent were so issued and delivered in the name of the United States of America under the seal of the Patent Office of the United States and were signed by the Secretary of the Interior and were countersigned by the Commissioner of Patents, according to the provisions and requirements of law, on the twenty-6 fourth day of May, eighteen hundred and sixty-four, and numbered 42920, and wherein and whereby there was granted to the said James Knibbs and the said Marcus P. Norton, their heirs, administrators, or assigns, for the full term of seventeen years from and after the date thereof the full and exclusive right, privilege, and liberty of making, constructing, using, and vending to others to be used the said new and useful improvements in steam-fire-engine and other fire-engine pumps throughout the United States and the territories thereof, as will fully appear by the said letters patent ready in court to be produced, as by law or by the order of this honorable court may be required.

That prior to the granting, issuing, and delivery of the letters patent aforesaid and prior to the application therefor the said James Knibbs duly made, executed, and delivered unto himself and the said Marcus P. Norton a certain deed of assignment, and the same was duly recorded in the Patent Office of the said United States prior to the granting, issuing, and delivery of the said letters patent aforesaid, and such record was on or about the ninth day of May, eighteen hundred and sixty-four.

And in and by said deed of assignment the said James Knibbs did sell, assign, and transfer unto the said Marcus P. Norton, his heirs, assigns, or administrators, the full and exclusive right to an equal undivided half part or moiety of the aforesaid invention and improvements and did therein and thereby further sell, assign, and transfer unto himself, the said James Knibbs, the other and remaining half part or moiety of the said invention and improvements; and the said James Knibbs did therein and thereby request and authorize the Commissioner of Patents to issue the said letters patent to the said James Knibbs and said Marcus P. Norton, as the sole assignees of his whole right and title thereto, to the sole use, benefit, and behoof of the said James Knibbs and the said Marcus P. Norton and their heirs, assigns, or administrators.

And the said plaintiffs further aver and say that the said James Knibbs was and is the original and first inventor of the said invention and improvements described, claimed, and set forth in the letters patent aforesaid; that the same were not known or used by

others before the invention or discovery thereof by the said James Knibbs, and were not, at the time of his application for letters patent upon the same as hereinafter stated, in public use or on sale with his knowledge, consent, or allowance previous to a term of two years prior to the aforesaid application to the Commissioner of Patents for letters patent therefor and thereon made in due form of law, as herein set forth, other than legitimate experiments by said Knibbs in making and perfecting the said invention for general and public use and for sale as by law is provided; that before receiving said letters patent the said James Knibbs did make application therefor in writing to the Commissioner of Patents and made oath that he did verily believe that he was the original and first inventor of said invention and improvements for which he solicited letters patent; that he did not know or believe that the same were ever before known or used, and that he was a citizen of the United States; and the said James Knibbs also filed in the Patent Office a written description of his invention and improvements and of the
7 manner and process of making, constructing, and using the same in such full, clear, and exact terms as to enable any person skilled in the art to which it appertains or with which it is most nearly connected to make, construct, and use the same, and did also particularly specify and point out the part, the improvements, and the combinations which he claimed as his own invention or discovery, and also accompanied the whole with drawings and with written references thereon showing and representing his said invention, which said descriptions and drawings were duly signed by the said James Knibbs and were attested by two witnesses. The said James Knibbs did also furnish a model of his said invention and improvements and he did in all other things comply with the statutes of the United States aforesaid in such cases made and provided.

And the said plaintiffs further aver and say that the aforesaid letters patent bearing date the twenty-fourth day of May, eighteen hundred and sixty-four, being numbered 42920, were duly and lawfully issued and delivered in the name of the United States of America and were and are under the seal of the Patent Office of the said United States of America; that the said letters patent were duly signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, as by law required, and the same secured to the said James Knibbs and Marcus P. Norton, their heirs, administrators, or assigns, for the full term of seventeen years from the twenty-fourth day of May, eighteen hundred and sixty-four, the full and exclusive right, privilege, and liberty of making, constructing, using, and vending to others to be used the said invention and the said new and useful improvements in steam fire or other engine pumps for the extinguishment of fires in burning structures.

And the said plaintiffs further aver and say that on the twenty-third day of August, eighteen hundred and sixty-seven, the said James Knibbs did by a certain deed or instrument of assignment in writing sell, assign, transfer, and convey unto one Lemuel H. Tupper, then a resident of Troy, in the county of Rensselaer and

State of New York, but now a resident of Brooklyn, in the county of Kings and State of New York, one-fourth part of all his right in said patent, or one-eighth of the entire patent.

And the plaintiffs further aver and say that on the twentieth day of July, eighteen hundred and seventy-four, the said Lemuel H. Tupper did by a certain deed or instrument of assignment in writing sell, assign, transfer, and convey unto the said James Knibbs one-eighth interest in said patent, the same being a reassignment of the interest in said patent conveyed to him by said Knibbs on the twenty-third day of August, eighteen hundred and sixty-seven.

And the said plaintiffs further aver and say that thereafter, on the nineteenth day of March, eighteen hundred and seventy-seven, the said Marcus P. Norton did by a certain deed or instrument of assignment in writing sell, assign, transfer, and convey unto Helen M. Ingalls, then of the city of Troy, in the county of Rensselaer and State of New York, all his right, title, and interest in and to said letters patent and invention, being one undivided half thereof.

8 And the said plaintiffs further aver and say that the said James Knibbs, on the tenth day of October, eighteen hundred and seventy-seven, did by a certain deed or instrument of assignment in writing sell, assign, transfer, and convey unto Christopher C. Campbell, then of East Chatham, in the county of Columbia and State of New York, and now residing at Chester, county of Hampden and Commonwealth of Massachusetts, as aforesaid, all his right, title, and interest in said invention, improvements, and letters patent and all his right and claim against any and every person or persons, city, corporation, company, or government for the past or present use of the said invention and improvements under the said letters patent or for any infringement of or upon the said letters patent dated as aforesaid, to wit, the twenty-fourth day of May, eighteen hundred and sixty-four, and numbered 42920.

And the said plaintiffs further aver and say that on the tenth day of October, eighteen hundred and seventy-seven, the said Helen M. Ingalls did by a certain deed or instrument of assignment in writing sell, assign, and transfer unto Christopher C. Campbell, as assignee in trust, his heirs, assigns, and lawful representatives, all of the right, title, and interest which she then had or ever had in, to, or for the said invention, improvement, and letters patent, and of any and every reissue thereof, and all right, title, interest, claim, or demand against any and every person, city, corporation, company, or government for the past use, manufacture, or sale of said invention and letters patent, and all and every of her right, title, interest, claim, and demands for the entire present and future use, sale, or manufacture of said invention, improvement, and letters patent so dated and numbered as aforesaid; also the entire invention, improvement, and letters patent aforesaid, as well as her right to sue for and recover any and all past infringements upon the said letters patent.

And the said plaintiffs further aver and say that thereafter or about the thirtieth day of October, eighteen hundred and seventy-nine, the said Helen M. Ingalls did by a certain deed or instrument of assignment in writing sell, assign, and transfer unto the said Marcus P. Norton, trustee and assignee in trust for Mrs. Minnie D. Norton, Miss Ada Lavinia Norton, Miss Helen Grace Norton, Miss Estelle May Norton, Miss Helen M. Ingalls, all her right, title, and interest in and to said letters patent and invention, being one undivided moiety or half thereof.

And the plaintiffs further aver and say that on the twentieth day of December, eighteen hundred and eighty, the said Christopher C. Campbell, as assignee in trust, and the said Marcus P. Norton, as trustee and assignee in trust, did by a certain deed or instrument of assignment in writing sell, assign, and transfer unto one Benjamin Richardson, of the city, county, and State of New York, one-fourth part of all their right, title, and interest in and to said letters patent, dated and numbered as aforesaid.

And the plaintiffs further aver and say that on the thirteenth day of February, eighteen hundred and eighty-two, the said Christopher C. Campbell did by a certain deed or instrument of assignment in writing sell, transfer, and convey unto the said James Knibbs one equal undivided eighth part of said letters patent and invention, and a like interest in all claims for damages for infringement of the same.

9 And the plaintiffs further aver and say that on the tenth day of July, eighteen hundred and eighty-two, the said Christopher C. Campbell did, by a certain deed or instrument of assignment in writing, sell, assign, and transfer unto the said Marcus P. Norton, as trustee, and in trust for Mrs. Minnie D. Norton, Miss Ada L. Norton, Miss H. Grace Norton, Miss Estelle M. Norton, and Miss Helen M. Ingalls, and each of their heirs, assigns, and legal representatives, each and every right, claim, privilege, action, or causes of action or demands for infringement in or upon or in violation of the said letters patent by anybody, person or persons, company, corporation, town, village, city, or government for the past or present use of the said improvements and inventions under and by virtue of said letters patent that *was* obtained by the said Campbell from the said James Knibbs on the tenth day of October, eighteen hundred and seventy-seven, and all and each his right, title, interest, demands, or claims for the entire past use for the said improvements, invention, and letters patent so issued, dated, and numbered as aforesaid arising from or growing out of, from, or by reason of any manufacture, sale, or use of the improvement and invention so patented as aforesaid since the twenty-fourth day of May, eighteen hundred and sixty-four, the full right and power in his name as trustee or assignee in trust, or both, or in their names to sue for, to collect, or adjust or settle any and all infringements of or upon or in violation of said letters patent by any person or persons, company, corporation, village, town, or city or by any officer or department thereof.

And the plaintiffs further aver and say that on the tenth day of July, eighteen hundred and eighty-two, the said Christopher C. Campbell, by his deed or instrument of assignment in writing, did convey and reassign unto the said Helen M. Ingalls all that part of said invention and letters patent and all claims for infringement of the same, being one-half thereof, acquired by said Campbell by deed or instrument of assignment from said Helen M. Ingalls, dated the tenth day of October, eighteen hundred and seventy-seven.

And the plaintiffs further aver and say that on the twentieth day of May, eighteen hundred and eighty-four, the said Marcus P. Norton, as trustee, Minnie D. Norton, Helen M. Ingalls, Ada D. Norton, H. Grace Norton, Estelle M. Norton, and Marcus P. Norton did, by a certain deed or instrument of assignment in writing, sell, transfer, and convey unto Ruel Philbrook, of Boston, county of Suffolk and Commonwealth of Massachusetts, all their right, title, and interest in said invention and letters patent and all demands and actions for infringement from the date thereof, to be held in trust for the purpose specified in said instrument; which said instrument is in words and figures as follows, to wit:

Be it known that we, Marcus P. Norton, of Boston, county of Suffolk and State of Massachusetts, as patentee, assignee and assignee in trust, and Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle M. Norton and Helen M. Ingalls, all of said Boston, county and State aforesaid, for and in consideration of one dollar and of other good and valuable considerations received by us from Ruel Philbrook, of said Boston, have sold, assigned, transferred and conveyed, and by these presents do hereby sell, assign, transfer and convey, unto said Ruel Philbrook all of our own right, title and interest, and the entire right, title and interest of each of us, and to letters patent of the United States granted to James Knibbs and Marcus P. Norton, for an improvement in steam-fire-engine and other engine pumps,
10 numbered 42920, and of date May 24, 1864, and in and to the invention and improvements therein shown and described, and the exclusive rights and privileges thereby secured, and in and to all claims, debts, dues and demands, actions and causes of action against any and all persons, firms or corporations, bodies politic or corporate, arising or growing out of any and all infringements upon said letters patent, and the exclusive rights and privileges thereby secured by each and every of such persons, firms, corporations, bodies politic or corporate, from the date of the grant of said letters patent to the termination thereof, hereby giving and granting unto said Ruel Philibrook full power and authority to ask, demand, sue for, collect and receive the damages for each and all infringements upon said letters patent in the same manner, and to the same extent that we might and could have done had this assignment not been made.

To have and to hold the same unto the said Ruel Philbrook, his heirs and assigns in trust, to and for the following uses and purposes, that is to say,—

Out of the proceeds derived from the collections of money by said Philbrook, from a person or corporation, for and in settlement of damages for the infringements of said letters patent, first, to satisfy and pay for any and all necessary and proper expenses then already incurred by him in collecting and obtaining settlements and payments as aforesaid, including herein his own personal expenses, moneys paid out and expended by him for legal services, counsel and attorney fees, witnesses and the expenses of their attendance, models and exhibits, and any and all other necessary and proper expenses incurred in and about the collection of damages for the infringements of said letters patent: second, as often as there shall be a balance remaining over in the hands of said Philbrook from such collections, after deducting the expenses as aforesaid, then to apply to the sole use and benefit of said Philbrook, his heirs and assigns, one-fourth part of said balance, and to pay over to said John L. S. Roberts, of said Boston, one-fourth part, and the remainder to the parties in interest, as their several interests now stand, they giving proper receipts therefor.

In witness whereof, we have hereto, and to another assignment of like tenor and date, this twentieth day of May, 1884, set our hands and seals.

MARCUS P. NORTON, *Trustee*. [SEAL.]
MINNIE D. NORTON. [SEAL.]
HELEN M. INGALLS. [SEAL.]
ADA L. NORTON. [SEAL.]
H. GRACE NORTON. [SEAL.]
ESTELLE M. NORTON. [SEAL.]
MARCUS P. NORTON. [SEAL.]

In presence of—
JOSEPH P. DAY.
F. J. DONOVAN.
LEWIS C. LILLIE.

Rewitnessed April 5, 1886, as to all but Marcus P. Norton.
JAS. B. LOCKWOOD.

11 COMMONWEALTH OF MASSACHUSETTS, } *ss:*
Suffolk County. }

I, Marcus P. Norton, as trustee and in my individual capacity, hereby admit, acknowledge, and declare that on the twentieth day of May, 1884, I signed, sealed, and delivered the within and foregoing instrument for the uses and purposes therein mentioned and contained; that said instrument is genuine and valid for all the uses and purposes mentioned therein, and I hereby confirm the same and acknowledge it to have been and to be my free act and deed.

MARCUS P. NORTON, *Trustee*.
MARCUS P. NORTON.

COMMONWEALTH OF MASSACHUSETTS, } *ss:*
Suffolk. }

BOSTON, *January* 30, 1885.

Subscribed and acknowledged by the said Marcus P. Norton, as trustee and in his individual capacity, as his voluntary act and deed.

Before me—

JOHN T. KENNERK,
Justice of the Peace.

STATE OF NEW YORK, } ss:
City and County of New York, }

On this fifth day of April, 1886, before me personally came Minnie Norton, Helen M. Ingalls, Ada L. Norton, H. Grace Norton, and Estelle M. Norton, to me known and known to me to be the same persons described in and who executed the foregoing instrument, and they severally acknowledged to me that they executed the same as their free act and deed and as the free act and deed of each of them for the uses and purposes therein mentioned.

JAMES H. FITCH,
Notary Public, N. Y. City and County, No. 11.

And the said plaintiffs further aver and say that the said improvements and invention so as aforesaid patented *was* of very great utility and value, and that the same have been and now are extensively introduced into public use, and but for the wrongful acts of said defendant, The City of Haverhill, from the thirtieth day of May, eighteen hundred and sixty-four, to the twenty-fourth day of May, eighteen hundred and eighty-one, the aforesaid-named plaintiffs, who were owners in the patent during the time aforesaid, would have derived many valuable advantages and would have received large sums of money from the sale, license, and use of said improvements and invention, but by wrongful acts the said plaintiffs aforesaid have heretofore been and now are wronged, 12 injured, and prevented from making such gains and receiving such sums of money and are damaged to the extent and full sum and amount of five hundred dollars per year by the said defendant.

And the said plaintiffs further aver and declare that the said improvements and invention, with the letters patent thereon so granted, were, and during their use by the defendant have been, of great value to the defendant, to wit, of five hundred dollars per year, as plaintiffs are informed and verily believe, but the said defendant, well knowing the premises, rights, and privileges secured as aforesaid, but continuing to wrong, injure, and damage the aforesaid-named plaintiffs and to deprive them of the benefits and advantages which might and otherwise would accrue to them from the said invention, improvements, and letters patent, did, on the thirtieth day of May, eighteen hundred and sixty-four, and on divers other days and times since then and continuously therefrom and until the twenty-fourth day of May, eighteen hundred and eighty-one, and during all the time intervening, as said plaintiffs are informed and verily believe, without the license or consent of and without compensation of any kind paid to said plaintiffs or any of them and in violation of and infringement upon the said exclusive rights and privileges so secured to the plaintiffs and in violation of and infringement on the said letters patent so dated and numbered as aforesaid, did wrongfully manufacture and cause to be manufactured the aforesaid invention and improvements and to put the same into public use and cause the same to be put in general use in and by the fire department of the said city of Haverhill, attached to and combined with steam fire-engines and other engines owned by the said defendant, and used by said defendant in its said fire department for the purpose of extinguishing fires within the limits of said defendant corporation and for the benefit, profit, gain, and advantage of said defendant and to the injury and damage of the said plaintiffs to the sum and amount of five hundred dollars per year, as hereinbefore alleged and stated.

And the said plaintiffs further aver and declare that the said defendant, during all the time as aforesaid, did use and did continue to use the aforesaid named and described invention and improvements, and the said invention and improvements on the steam fire-engines and other fire-engines so by them used and which they continued to use in their said fire department until the twenty-fourth day of May, eighteen hundred and eighty-one, and are now using embrace in their construction and mode of operation the same or substantially the same features as are described in the said letters patent and secured to the plaintiffs as aforesaid, and the said use was an infringement upon the said letters patent and was in violation of the rights and privileges of the said plaintiffs, for which no compensation of any kind has yet been made to the plaintiffs by said defendant, though often requested so to do, and to the damage of the said plaintiffs in the sum of five hundred dollars each year during the time of the infringement thereof by defendant, substantially as hereinbefore specified and set forth.

And the said plaintiffs further aver and declare that the aforesaid acts of infringement of and upon said letters patent by the defendant were to the great injury, damage, and loss of the 13 said plaintiffs, and still are to the great injury, damage, and loss of the said plaintiffs, by means of which they have been and now are deprived of great gains, advantages, profits, and money payments which they might and otherwise would have received, had, and obtained, but which have been received and enjoyed by said defendant by and through *their* unlawful and unjust acts as aforesaid mentioned and set forth, to the extent and full and just sum of five hundred dollars each year during the continuation of said acts of wilful violation of and infringement upon the said letters patent, substantially as herein stated and set forth, all of which profits, gains, and advantages and all of which rights, titles, and interests therein and thereto have become the property of plaintiffs, and they are fully authorized and empowered to sue for, collect, or compromise and receipt for the same in full satisfaction of said infringements and for all debts, dues, demands, claims, and rights of action arising thereunder, whereby and by means of which grievances the said plaintiffs have been greatly injured and deprived of great gains, profits, sales, and advantages which they might and otherwise would have derived from said invention and said letters patent described as aforesaid, and have sustained by said acts of infringement aforesaid actual damages to the amount of six thousand dollars.

Wherefore and by force of the statutes of the United States and by reason of the assignments aforesaid a right of action has accrued to the said plaintiffs to recover the said actual damages and such additional amount, not exceeding in the whole three times the amount of such actual damages as the court may see fit to adjudge and order, besides costs.

Yet the said defendant, though often requested so to do, has never settled or paid the same nor any part thereof, but has refused and still refuses so to do, to the damage of the said plaintiffs, as they say, in the sum of ten thousand dollars.

The writ in this cause, dated the twentieth day of May, A. D. 1887, as aforesaid, was duly entered at the October term of this court, A. D. 1887, when and where the parties appeared by their respective attorneys.

At the said October term, A. D. 1887, the following answer and plea was filed:

Answer and Plea of the Defendant.

(Filed November 14, 1887.)

1. And the said defendant comes and defends the wrong and injury, when, &c., and says that it is not guilty of the supposed grievances laid to its charge in the plaintiffs' declaration or of any or either of them or any part thereof in manner and form as the said plaintiffs have thereof complained against it, and of this it puts itself upon the country.

2. And the said defendant for answer denies each and every allegation, item, and amount in the plaintiffs' declaration set out or contained.

14 3. And the defendant, for further answer, alleges that the subject-matter of the letters patent named in plaintiffs' declaration did not at the date of said letters patent constitute or embody invention which was patentable under the laws of the United States under which said letters patent purported to be issued.

4. And for further answer the defendant says that the cause of action mentioned in the plaintiffs' declaration did not accrue within six years before the suing out of the plaintiffs' writ.

By its attorneys, LIVERMORE & FISH.

At the said October term the following motion to amend was filed and allowed by the court, the Honorable Le Baron B. Colt, circuit judge, sitting:

Motion to Amend Answer and Plea.

(Filed and allowed April 18, 1888.)

And now comes the defendant and moves to amend its answer and plea in the above-entitled case by adding the following:

5. And for further answer the defendant says that neither the patentee nor the plaintiffs have marked the pumps or relief valves containing the invention patented in letters patent mentioned in plaintiffs' declaration with the word "patented" and the date of said patent, as provided by the statute, and that this defendant received no notice that said invention was patented, or that this defendant was infringing the same.

6. And the defendant, further answering, says that James Knibbs, in said declaration named, was not the original or first inventor or discoverer of the invention patented in the patent in said declaration named, and that prior to his supposed invention thereof the same or material and substantial parts thereof — patented in and by letters patent of the United Kingdom of Great Britain and Ireland, No. 10612, dated April 25, 1845, granted to William Wylam, and the French patent, No. 9330, dated January 13, 1850, granted to Provin, and this defendant will prove the same on trial of said case; and this defendant, further answering, says that said invention, prior to the supposed invention thereof by said Knibbs, was known and used by the Amoskeag Manufacturing Company, James Batchelder, Henry Ritner, and Nehemiah S. Bean, all of Manchester, in the State of New Hampshire, at said Manchester, and Lowell and Boston, in the State of Massachusetts; John Ray, Charles H. Hersey, Harrison Loring, Calvin E. Wilson, of and at Boston, in the State of Massachusetts; Henry A. Chase, of Lynn, in the State of Massachusetts, at said Boston; Joseph L. Parry, Jacob G. Neafie, Reany, Neafie & Co.; George Kurtz, Richard M. Warren, and Hunsworth, Akins & Co., all of Philadelphia, in the State of Pennsylvania, at said Philadelphia, and Baltimore, in the State of Maryland, and by the city of Baltimore, Murray & Hazelhurst, Poole & Hunt, Robert Poole, John A. Ivers, German H. Hunt, Michael Dunn, 15 the First Baltimore Hose Company, the Vigilant Fire Company, all of said Baltimore, at said Baltimore; by N. V. B. Darling, of and at Providence, in the State of Rhode Island, and by Silsby, Winders & Co., of and at Seneca Falls, in the State of New York; by the fire department of the city of Boston, Theodore Hutchings, James S. Young, Clark W. Doten, Josiah S. Battis, Calvin C. Wilson, Henry A. Chase, and Freeborn Adams, all of said Boston, at said Boston; by the city of Providence, at Providence, in the State of Rhode Island; the city of Hartford, in the State of Connecticut, and Albert W. Roberts and Henry J. Eaton, of said Hartford, at said Hartford; by said city of Philadelphia, at said city, and Alexander M. Rankin, William E. Knight, George Boston, William P. Kennedy, Andrew B. Linker, and Richard M. Warren, all of and at said Philadelphia; by the fire department of the city of Portland, in the State of Maine, and John H. James, of said Portland, at said Portland; by the Hinckley locomotive works and the Boston locomotive works, in said Boston; by Henry W. Fitch and William G. Buelah, officers of the United States Navy and the United States of America, on the steamship Narragansett, at said Boston, and in Portsmouth, in the State of New Hampshire; Charlestown, in the State of Massachusetts; Brooklyn, in the State of New York, and

Washington, in the District of Columbia; and this defendant hereby gives notice to the plaintiff that it will prove the aforesaid allegations on the trial of said case.

7. And the defendant, further answering, says that said invention and steam fire-engines and relief valves containing the same were purchased, sold, on sale, and used in public more than two years prior to the application of said Knibbs for said patent by the persons and corporations above named and the United States of America, at the places above named, and by the Amoskeag Manufacturing Company and Nehemiah S. Bean, of Manchester, in the State of New Hampshire, at said Manchester, and at Chelsea, Lawrence, New Bedford, Boston, Fall River, and Medford, in the State of Massachusetts; at Troy, New York, and Brooklyn, in the State of New York; at Halifax, N. S.; at Newark, in the State of New Jersey; at Detroit, in the State of Michigan; at Chicago, in the State of Illinois; at Philadelphia, Pittsburgh, and Harrisburg, in the State of Pennsylvania; at Norwich, New Haven, and Hartford, in the State of Connecticut; at Milwaukee, in the State of Wisconsin; at Alexandria, in the State of Virginia, and at Concord, in the State of New Hampshire, and by said cities in said cities, respectively; and the defendant gives notice that it will prove said allegations on the trial of said case.

By its attorneys, LIVERMORE & FISH.

This cause was thence continued from term to term to the October term, A. D. 1888, when, on the fourteenth day of November, all the plaintiffs, except the said Christopher C. Campbell, come and by leave of court discontinue.

Issue having been joined as aforesaid, this cause, after a full hearing, is committed to a jury sworn according to law to try the issue, who, after hearing all matters and things concerning the same, return their verdict therein and upon oath say:

16 The jury find for the defendant.

This cause was thence continued to this present May term, A. D. 1887, and now, to wit, September 24, 1889, it is considered by the court, the Honorable George M. Carpenter, district judge of the United States for the district of Rhode Island, duly assigned by the Honorable Le Baron B. Colt, circuit judge, to hold said circuit court, sitting, that the said Christopher C. Campbell take nothing by his said writ and that the said City of Haverhill, defendant, recover of the said Christopher C. Campbell, plaintiff, its costs of suit, taxed at —.

The following bill of exceptions was presented by the plaintiff and allowed as of the day of trial and before the jury left the bar:

Bill of Exceptions.

UNITED STATES OF AMERICA:

Circuit Court of the United States, District of Massachusetts, *ss.*,
October Term, A. D. 1888.

RUEL PHILBROOK, Trustee, *et al.*
vs.
CITY OF HAVERHILL.

Be it remembered that at a term of the circuit court of the United States within and for the first circuit, begun and holden at Boston, within and for the district of Massachusetts, on the fifteenth day of October, in the year of our Lord one thousand eight hundred and eighty-eight, this action came on for trial in said court before the Honorable Thomas L. Nelson, United States district judge for the district of Massachusetts, presiding in said court, and a jury of said court duly empanelled to try the issues involved in said action. The pleadings are made a part of this bill of exceptions.

The defendant corporation admitted, for the purposes of the trial, that the defendant had used steam fire-engines containing the invention claimed in the patent in suit from May 24, 1864, to May 24, 1881, and that the plaintiff's witnesses would testify in the above case that plaintiff was damaged by such use to the amount of five thousand and one dollars.

The plaintiff, to maintain the issue on his part, introduced evidence to show that Philbrook, by assignments, copies of which are hereto annexed and marked Exhibits A, B, C, D, E, F, G, H, I, J, K, had received all the title, as assignee, held by the several assignors to him during the life of said patent and claimed the right to proceed in one suit in the name of all his prior assignors.

17 The court ruled that the action could not be maintained, and that Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties who held the entire title to the patent in suit for the time being.

To this ruling the plaintiff excepted, and his exceptions were then and there allowed; and thereupon, by leave of court, the plaintiff, for the purposes of this trial, discontinued as to all the plaintiffs named in his writ, except Christopher C. Campbell, and proceeded in the name of Christopher C. Campbell.

The plaintiff also, by leave of court, amended his declaration by striking out all the allegations that related to Benjamin Richardson and the name of Benjamin Richardson wherever it occurred.

The plaintiff then put in evidence the original letters patent, dated May 24, 1864, issued to James Knibbs and Marcus P. Norton, a copy of which is hereto annexed, marked "Exhibit A," and an assignment from James Knibbs to Lemuel H. Tupper, dated August 23, 1867, a copy of which is hereto annexed, marked "Exhibit B," and an assignment from Lemuel H. Tupper to James Knibbs, dated July 20, 1874, a copy of which is hereto annexed, marked "Exhibit

C," and an assignment from Marcus P. Norton to Helen M. Ingalls, dated March 19, 1877, a copy of which is hereto annexed, marked "Exhibit D," and an assignment from James Knibbs to Christopher C. Campbell, a copy of which is hereto annexed, marked "Exhibit E," and an assignment of Helen M. Ingalls to Christopher C. Campbell, dated the 10th day of October, 1877, a copy of which is hereto annexed, marked "Exhibit F," and also an assignment from Helen M. Ingalls to Marcus P. Norton, dated the 30th day of October, 1879, a copy of which is hereto annexed, marked "Exhibit G."

The plaintiff then offered in evidence an assignment of Christopher C. Campbell to Marcus P. Norton, dated July 10, 1882, a copy of which is hereto annexed, marked "Exhibit H," and assignments from Christopher C. Campbell to Helen M. Ingalls, dated respectively July 10, 1882, and Sept. 27, 1882, copies of which are hereto annexed, marked, respectively, "Exhibits I and J."

The plaintiff then offered in evidence the assignments of Marcus P. Norton, Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle May Norton, and Helen M. Ingalls to Ruel Philbrook; dated May 20, 1884, a copy of which is hereto annexed, marked "Exhibit K."

The plaintiff then testified that he was the Ruel Philbrook named in the instrument in writing of May 20, 1884; that he accepted the trust created by said instrument and that he had prosecuted the suit to recover for the infringement of said letters patent; that he had never been removed from his said trust, and that he had done everything under said instrument of May 20, 1884, incumbent upon him as trustee.

The plaintiff's counsel then said:

"It is admitted for the purposes of this trial that the entire title in the patent vested in Christopher C. Campbell individually or as trustee from the tenth day of October, 1877, to the 20th day of December, 1880, and for the purposes of this trial no claim for damages is made in behalf of said Campbell after the 20th of December, 1880."

The defendant's counsel replied: "That saves the issue properly, it seems to me."

18 The defendant then asked the court to direct a verdict for the defendant on the ground that the action is barred by the statute of limitations of the Commonwealth of Massachusetts, as all claims for action under the admission terminated Dec. 20, 1880, and the writs were dated May 20, 1887, and were served on the 23rd day of said May, so that more than six years had elapsed.

Thereupon the court instructed the jury as follows:

"GENTLEMEN OF THE JURY: The court has settled this question of law which arose here, and it is decided that the statute of limitations of the Commonwealth of Massachusetts is a defence to this suit, as all claim for damages by the plaintiff is limited to infringements which took place more than six years before the commencement of this suit; therefore you will return a verdict for the defendant."

And thereupon to the foregoing instruction the plaintiff excepted and his exceptions were then and there allowed. The jury, in accordance with the instruction, returned a verdict for the defendant.

And inasmuch as the several matters as produced on the part and in behalf of said plaintiff and insisted upon as being admissible and the rulings of the said presiding judge thereon and *as* the instruction of the said presiding judge, to which said plaintiff excepted, and the several admissions made do not appear by the record of the case and the verdict aforesaid, the plaintiff did then propose his exceptions to the rulings, instruction, and opinions of the said presiding judge, and requested said judge to sign said bill of exceptions containing the said several matters so produced on the part and in behalf of the said plaintiff as aforesaid and the rulings, instructions, and opinions of the said presiding judge excepted to as aforesaid, according to the established practice in the courts of the United States and the form of the statutes in such case made and provided, so that said exceptions may be made a part of the record of said court.

And thereupon the presiding judge, at the request of said plaintiff, did put his name to the bill of exceptions, pursuant to the practice of said court and the statutes of the United States in such case made and provided, and directed that the same be filed as of the fourteenth day of November, in the year of our Lord one thousand eight hundred and eighty-eight, before the jury left the bar after rendering their verdict.

The foregoing exceptions, being duly presented, have been by me duly examined, approved, and allowed.

THOMAS L. NELSON, *Judge.*

19 EXHIBIT A.

UNITED STATES OF AMERICA:

To all to whom these letters patent shall come:

Whereas James Knibbs, of Troy, New York, has alleged that he has invented a new and useful improvement in pumps (he having assigned his right, title, and interest in said improvement to himself and Marcus P. Norton, of same place), which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty-five dollars and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for that purpose:

These are, therefore, to grant, according to law, to the said Knibbs and Norton, their heirs, administrators, or assigns, for the term of seventeen years from the twenty-fourth day of May, one thousand eight hundred and sixty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the words of the said James Knibbs in the schedule hereunto annexed and is made a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this twenty-fourth day of May, in the year of our Lord one thousand [SEAL.] eight hundred and sixty-four, and of the Independence of the United States of America the eighty-eighth.

J. P. USHER,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.

D. P. HOLLOWAY,
Commissioner of Patents.

Specifications forming part of Letters Patent No. 42920, dated May 24, 1864, assigned by James Knibbs to self and Marcus P. Norton.

To all whom it may concern:

Be it known that I, James Knibbs, of the city of Troy, county of Rensselaer, and State of New York, have invented new and useful improvements in pumps for steam fire and other engine pumps, and I do hereby declare that the following is a full, clear, and exact description thereof, reference being hereby had to the accompanying drawings and to the letters of reference marked thereon, which said drawings make a part of this specification. Like letters represent and refer to like or corresponding parts.

Fig. 1 is a front view of the pump and showing my invention and improvements hereinafter described and set forth.

Fig. 2 is a vertical and sectional side view, showing the discharge pipe or tube and other parts hereinafter described and set forth.

Fig. 3 is also a vertical and sectional side view, showing the suction or supply pipe or tube and other parts connected therewith and hereinafter described and set forth.

The nature of my invention and improvements consists in the employment of a pipe or tube or its equivalent, by means of which the force or discharge part of said pump is connected to and with the suction or supply part of said pump, so that one, two, three, or more discharge pipes or hose may throw streams of water at the same time and stroke of the piston or operation of said pump without any waste of water by the opening of a valve or discharge pipe to enable the pump to work successfully and without injury in the throwing of streams of water at fires, &c., &c. Heretofore in steam-fire-engine pumps constructed for the purpose of throwing two, three, four, or more streams of water at one and the same stroke of the piston there has been a great difficulty attending the practical and successful working of the same whenever it has been desirable to throw but one or two or perhaps three streams of water when the pump is constructed to throw four or more streams of water, for the suction or supply of water would in that case be greater than the discharge through the hose pipe or tubes, as the case may be, in which one of the remaining discharge pipes, with the hose pipe disconnected, or else a waste-water valve would have to be kept open during the operation of the pump, so as to make the discharge of water the same in quantity as that received through and by means of the supply or suction part of the pump, for if the discharge be not the same or nearly so as that of the supply the pump would become somewhat strained and flooded and would not after awhile work or operate. The boiler would also become somewhat flooded and the engine would cease to work. By the opening of a discharge pipe or waste-water valve the discharge would become more equal to that of the supply; but here is a great waste of water, as well as the flooding of the street, when such engine is used, which is not only very inconvenient to those who operate the said engine at fires, &c., but is also to some extent injurious to such steam fire-engine.

By my said invention or improvement all these difficulties are fully obviated. The force part or suction of the said pump being connected to and with the suction or supply part or section in the manner and by the means substantially as herein described and set forth, no discharge pipe or water valve *are* required to be open during the operation of the engine throwing but one or two
21 streams of water at one operation or stroke of the piston. The extra quantity of water thrown into the force or discharge part or section of the pump from the suction or supply part or section and not discharged through the discharge or hose pipes connected therewith, because the same are closed with one or more exceptions, is conducted by the means hereinafter described from the said force part or section of the said pump back into the supply or suction tube or pipe connected to and with the said suction or supply part or section of the said pump, and that the force or discharge part or section of the pump is relieved from any excessive quantity of water and the waste of water and the flooding of the street prevented, while at the same time the engine and the said pump perform all their respective functions in the most perfect and satisfactory manner without hindrance or obstruction, and the said pump will throw one, two, three, four, or more streams of water at the same time, the same being regulated by means of a valve hereinafter described and set forth.

To enable others skilled in the art to which my said invention and improvements relate to make and use the same, I will here proceed to describe the construction and operation of the same, which is as follows, to wit: (A) is the pump cylinder. (A′) is the lower cylinder head. (A″) is the upper cylinder head. (B) is the suction or supply valve. (C) is a screw-cap, which must be removed when the main hose pipe leading from the hydrant is to be connected herewith for the purpose of supplying the pump and engine with water. The said supply hose pipe will be of the required capacity to supply water sufficient for all the discharge hose pipes, be the number thereof more or less. (D) is a tube connecting the force or discharge section of said pump to the vertical valve tube (E). (F) is a discharge tube, to which the discharge hose pipe is connected, which is done in the same manner as described in relation to the said suction or supply pipe or hose. (G G) is a tube or pipe connecting the force or discharge part or section to and with the suction or supply part or section of the said pump for the purposes herein described and set forth. (H) is the valve to regulate the excessive quantity of water to be returned from the force section through the said tube (G G) to the said suction or supply pipe (B). If all the hose pipes are discharging water at the same time this valve will remain closed. If, however, but one, two, or three of the hose pipes are discharging water at the same time or stroke of the piston, then this valve must be open sufficient to allow of the return of the excessive quantity of water which cannot be discharged by reason of some one or more of said discharge hose pipes being closed because not required in use. (B′) is an air chamber. (*e*) is the handle by which the water is shut off or from the discharge pipe (F) in the usual manner and means. (*g*) is a valve to let water out at (H), if desirable, in the cleaning of the engine.

Having thus described my said invention, what I claim and desire to secure by letters patent is—

The returning of any excessive water in the force part or section of a steam fire or other engine pump to the suction part or section thereof, substantially as herein described and set forth.

I also claim the connecting of the discharge or force part or section of a steam fire or other engine pump to and with the
22 suction or supply section thereof by means of the tube (G G)
and the regulating valve (H) or any equivalent therefor, substantially as and for the purposes herein described and set forth.

In testimony whereof I have on this 27th day of April, A. D. 1864, hereto set my hand.

JAMES KNIBBS.

Witnesses:
C. E. PATTERSON.
D. MacGREGOR.

Exhibit B.

Whereas letters patent of the United States of America were duly granted to James Knibbs and Marcus P. Norton of the city of Troy, county of Rensselaer and State of New York for and upon certain new and useful "improvements in pumps" which said letters patent bear date the twenty-fourth day of May A. D. 1864 and to which reference is hereby had for a more full description of the invention herein and hereby assigned. And whereas the said James Knibbs is now the lawful owner and possessor of one-half part or moiety of the invention and improvements contained in the letters patent issued and dated as aforesaid.

And whereas Lemuel H. Tupper of the said city of Troy, county and State aforesaid is desirous of purchasing and has purchased of and from the said Knibbs one-quarter or fourth part of all my right, title, and interest in, to, and for the invention aforesaid or one-eighth of the entire invention contained in the letters patent dated and issued as aforesaid.

Now therefore this indenture of assignment witnesseth that for and in consideration of the sum of one dollar and other valuable consideration to me in hand paid the receipt whereof ia hereby acknowledged I have sold, assigned, and transferred and do hereby sell, assign, and transfer unto the said Lemuel H. Tupper, his heirs, administrators or assigns one-quarter or fourth part of all my right, title, and interest in, to, and for the invention and letters patent aforesaid or one-eighth of the entire letters patent dated and issued as hereinbefore set forth, the same to be held and enjoyed by the said Lemuel H. Tupper for his own use and behoof and for the use, benefit and behoof of his legal representatives to the full end of the term for which said letters patent are granted, as fully, freely and entirely as the same would have been held and enjoyed by me had this part assignment and sale not been made.

In testimony whereof I have hereunto set my hand and seal this 23rd day of August, A. D. 1867.

JAMES KNIBBS. [L. S.]

Signed and sealed in presence of—
MARCUS P. NORTON.
CHARLES D. KELLUM.

23 CITY OF TROY,
County of Rensselaer and State of New York, } *ss:*

On this 20th day of December, A. D. 1873, personally came before me James Knibbs, of the said city of Troy and to me personally known, and duly acknowledged that he signed and sealed the above and foregoing deed of assignment for the purposes therein named and set forth, and that he duly delivered the same to Samuel H. Tupper, the person therein named as his assignee of a certain specified interest and right in the letters patent on "steam-fire-engine pump," as and in the manner therein named and as witnessed on the 23rd day of August, A. D. 1867, by Marcus P. Norton and Charles D. Kellum, the letters patent therein named bearing date the 24th day of May, A. D. 1864, and upon "steam fire and other engine pumps," and issued to James Knibbs and Marcus P. Norton, of the city of Troy aforesaid.

JAMES LANSING,
Commissioner of Deeds, Troy, N. Y.

EXHIBIT C.

Whereas letters patent of the United States of America were duly granted to James Knibbs of the city of Troy, county of Rensselaer and State of New York for and upon certain new and useful improvements in pumps which said letters patent bear date the twenty-fourth day of May A. D. 1864 and to which reference is hereby had for a more full description of the invention herein and hereby assigned and whereas Lemuel H. Tupper is now the lawful owner and possessor of one-eighth part of the invention and improvement in the letters patent issued and dated as aforesaid.

And whereas James Knibbs of the city of Troy, State of New York is desirous of purchasing and has purchased of me the said Tupper the one-eighth of said patent held by me and all my right title and interest in and to the same invention aforesaid contained in the letters patent dated and issued as aforesaid.

Now therefore this indenture of assignment witnesseth that for and in consideration of the sum of one dollar and other valuable considerations to me in hand paid the receipt whereof is hereby acknowledged I have sold, assigned and transferred and do hereby sell, assign and transfer unto the said James Knibbs his administrators and assigns the one-eighth part of the said patent held by me which I previously purchased of the said Knibbs the same to be held by the said Knibbs for his own proper use and benefit or his legal representatives to the full end and term for which the said letters patent are granted as fully and freely and entirely as the same would have been held and enjoyed by me.

In testimony whereof I have hereunto set my hand and seal this twentieth of July, A. D. 1874.

LEMUEL H. TUPPER. [L. S.]

24 Signed and sealed in the presence of—
CHAS. M. SAULSON.
JAMES R. TORRANCE.

Exhibit D.

Whereas, the letters patent of the United States of America, were duly granted to James Knibbs and Marcus P. Norton of the city of Troy, county of Rensselaer and State of New York, for and upon certain new and useful improvements in pumps for steam fire-engines, which bear date the twenty-fourth day of May, A. D. 1864, to which reference is now and hereby had for a more full description of the invention herein and hereby sold, assigned and transferred.

And whereas the said Marcus P. Norton is now the lawful owner and holder of one-half or moiety part of the said letters patent and of the invention therein contained, the same never having been sold, assigned, or transferred prior to the date hereof. The said letters patent are dated as aforesaid and numbered.

And whereas Helen M. Ingalls of the said city of Troy, county and State is desirous of having and acquiring all the right, title and interest which I now have, or ever had in, to or for the said invention, improvements and letters patent, and of any and every reissue of the same; also any and every claim I now have, or ever had for the past use of the same, or for the sale or manufacture of the said invention and improvements.

Now, therefore this indenture and assignment and transfer witnesseth, that for and in consideration of the sum of one hundred dollars, to me the said Marcus P. Norton in hand paid, the receipt of which is now and hereby acknowledged, and in the further and other valuable considerations, the receipt of which is also hereby duly acknowledged, I have sold, assigned and transferred, and I do now and hereby sell, assign, and transfer unto the said Helen M. Ingalls, her heirs, assigns, and lawful representatives, all the right, title, and interest which I now have, or ever had in, to or for the said invention, improvements, and letters patent, and of any and every reissue thereof; and I also now and hereby sell, assign, transfer, and convey unto the said Helen M. Ingalls, her heirs, assigns and lawful representatives, all the right, interest, or claim I now have or ever had against any and every person, city, corporation, company, or government for the past and present use of the said invention and improvements, under the said letters patent, intending herein and hereby to sell, assign and transfer unto the said Helen M. Ingalls and her lawful representatives all my right, title, interest or claim for the entire past and for the future use of the said invention and letters patent so dated and numbered; and also the entire invention, improvements, and letters patent aforesaid, and all and every reissue of the same as well as full right, liberty and power to reissue the said letters patent whenever it shall be deemed best so to do, each and every of which is to be and shall be held and 25 enjoyed by her, the said Helen M. Ingalls, for her own use, benefit and behoof and for the use benefit and behoof of her legal representatives, to the full end of the term for which the said letters patent were granted and issued, as fully, freely, and entirely as the same would have been held and enjoyed by me, if this sale, assignment and transfer had not been made in the manner so as aforesaid.

Hereby selling, assigning, and conveying unto the said Helen M. Ingalls, her heirs and lawful representatives, all and every right, interest, privilege, title, or claim whether pending by suit in court or otherwise, which I now have or ever have had in any way or manner or form under the said letters patent, and any and every reissue of the same, to the full end of the term of seventeen years for which said letters patent were granted, on and commencing the 24th day of May, A. D. 1864, with full right, power, and authority to enforce, settle and adjust the same for any and every manufacture, sale, or use of the said invention, improvements and letters patent.

In testimony whereof I have on this 19th day of March, A. D. 1877, hereunto set my hand and seal.

MARCUS P. NORTON. [L. S.]

Signed, sealed, and delivered in presence of—

JOHN W. SMITH.

TOWN OF CANAAN, } ss.:
County of Columbia and State of New York. }

On this 20th day of March, A. D. 1877, personally came before me Marcus P. Norton, to me personally known to be the person named in and who executed the foregoing deed of assignment, and he acknowledged to *be* in due form of law that he executed said instrument or deed of assignment and for the purposes therein named and set forth.

JOHN W. SMITH,
Justice of the Peace.

EXHIBIT E.

Whereas, the letters patent of the United States of America, were duly granted to James Knibbs and Marcus P. Norton of the city of Troy, county of Rensselaer, and State of New York, for, and upon certain new and useful improvements in pumps for steam fire, and other engine pumps, which bear date the 24th day of May A. D. 1864, and which are numbered 42920, to which reference is now and hereby had for a more full description of the invention and letters patent herein and hereby sold, assigned, and transferred.

26 And whereas the said James Knibbs is now the lawful owner and holder of one-half or moiety part of the said letters patent and of the invention therein contained the said one-half part of all the right, title and interest in, to, or for the said letters patent and of said invention being at this time fully and entirely vested in the said James Knibbs; and whereas, Christopher C. Campbell of the town of Chatham, residing at the village of East Chatham in said town, county of Columbia, and State of New York, is desirous of having and acquiring all the right, title and interest aforesaid, which I the said James Knibbs now have or ever had, in, to, or for the said invention, improvements, and letters patent, and of any and every reissue of the same; also any right, claim or demand which I now have, or ever had to or for the past use of the same or for the sale, manufacture, or use of the said invention, improvements, or letters patent.

Now therefore, this indenture or deed of assignment and transfer, witnesseth that for and in consideration of the sum of one hundred dollars to me, the said James Knibbs, in hand this day paid by the said Christopher C. Campbell, the receipt of which is now and hereby acknowledged, and in the further and other valuable considerations the receipt of which is also now and hereby duly acknowledged, I have on this day sold, assigned, and transferred, and I do now and hereby sell, assign and transfer unto the said Christopher C. Campbell, his heirs, assigns and lawful representatives, all the right, title, and interest, aforesaid named, which I now have or ever had in, to, or for the said invention, improvements, and letters patent; and also of any and every reissue thereof; and I also, now and hereby sell, assign, and transfer and convey unto the said Christopher C. Campbell, his heirs, assigns, and lawful representatives all and every of the right, interest, claim or demand which I now have or ever had against any and every person, city, corporation, company, or government, for the past or present use of the said invention and improvements under the said letters patent, or for any infringement of or upon the said letters patent, dated so as aforesaid, to wit, the 24th day of May 1864 and numbered 42920, intending herein and hereby to sell, assign, and convey unto him, the said Campbell, his lawful representatives, all and every of any right, title, interest, claim or demand, for the entire past, present, and future use, manufacture, or sale of the invention and letters patent so dated and numbered; and also the entire invention, improvements and letters patent aforesaid, and each and every reissue of the said letters patent as well as full right, liberty and power to reissue the same whenever it shall be deemed best so to do, each and every of which is to be, and shall be held and enjoyed by him the said Campbell, for his own use, benefit and behoof, and for the use, benefit and behoof of his legal representatives to the full end of the term of seventeen years for which the said letters patent were granted and issued on the said 24th day of May A. D. 1864, as fully, freely, and entirely as the same would have been held and enjoyed by me, if the sale, assignment, and transfer had not been made in the manner so as aforesaid.

Herein and hereby selling, assigning, and conveying unto him the said Campbell, his assigns and lawful representatives, all and every right, title, interest, privilege, claim or demand of every name or nature, whether pending in court or otherwise, which
27 I now have or ever had under the said letters patent, and any and every reissue of the same, to the full end of the said term of seventeen years for which the said letters patent were granted, on, and commencing with the 24th day of May A. D. 1864, with the full right, power, and authority to sue for, to enforce, to settle and adjust the same as the said Christopher C. Campbell shall deem to be proper and advisable, for any and every manufacture, sale, or use of the said invention, improvements, and letters patent so dated and numbered.

And the said Christopher C. Campbell, as and for further and additional consideration in the sale, purchase, assignment and transfer of the said letters patent and invention so as aforesaid made, shall pay unto the said James Knibbs or his lawful representatives, the sum of ten thousand dollars out of any sales, settlement, collections, or recoveries had, or made, of or for the use, manufacture, or sale of the said invention and letters patent. The said sum of ten thousand dollars shall be paid to the said James Knibbs by the said Christopher C. Campbell, outof the money had or received from such settlements, collections, or recoveries hereinbefore stated, at the rate of ten per cent. upon all such settlements, collections, or recoveries for infringements upon the said letters patent, until the said sum of ten thousand dollars is paid, and after that no other or further payments are to be made, by said Campbell to said Knibbs.

In testimony whereof, I have on this 10th day of October A. D. 1877, hereunto set my hand and seal.

JAMES KNIBBS. [L. S.]

Signed, sealed, and delivered in presence of—
MARCUS P. NORTON.

City of Troy, } ss.:
County of Rensselaer, State of New York,

On this 11th day of October, A. D. 1877, personally came before me James Knibbs, to me personally known to be the person named in and who executed the foregoing deed of assignment and transfer, and he acknowledged to me in due form of law that he executed said instrument or deed of assignment and for the purposes therein named and set forth.

ISAAC W. CRESSEY,
Notary Public, Rens. Co., N. Y.

28 Exhibit F.

Whereas, the letters patent of the United States of America, were duly granted and issued to James Knibbs and Marcus P. Norton, of the city of Troy, county of Rensselaer, and State of New York, for and upon certain new and useful improvements in pumps for steam-fire-engines and other engine pumps, which bear date the 24th day of May A. D. 1864, and which are numbered 42920, to which reference is now and hereby had for a more full description of the invention herein and hereby sold, assigned, and transferred in the manner hereinafter stated; and whereas, the said Marcus P. Norton, did on or about the 19th day of March A. D. 1877, sell, assign, and convey unto Helen M. Ingalls, of the said city of Troy, county and State, each and every of his right, title and interest, in, to, or for the said invention and letters patent, so dated and numbered, which deed of assignment was duly of record in the Patent Office of the United States, on the 12th day of April, A. D. 1877, in Liber P. 21, page 181 of Transfer of Patents, to which said deed of assignments so dated and of record reference is now and hereby had; and whereas, I the said Helen M. Ingalls, am now the lawful owner and holder of one-half or moiety part of the said letters patent, and of the invention therein contained, as will more fully and at large appear from the said deed of assignment last above mentioned and described. And whereas Christopher C. Campbell of the town of Chatham, residing at the village of East Chatham in said town, county of Columbia, and State of New York, is desirous of having and acquiring all the right, title, and interest which I now have or ever had in, to, or for the said invention, improvements and letters patent, and of any and every reissue of the same; also any and every claim or demand I now have, or ever had for the past use, manufacture, and sale of the same, and conveyed to me by the said Marcus P. Norton by the said deed of assignment, dated as aforesaid, to wit: the 19th day of March A. D. 1877, and recorded in said Patent Office on the 12th day of April, A. D. 1877, in Liber P, 21, page 181, as aforesaid.

Now therefore, this indenture or deed of assignment and transfer, witnesseth, that for and in consideration of the sum of one hundred dollars to me the said Helen M. Ingalls, in hand paid, by the said Christopher C. Campbell, the receipt of which is now and hereby acknowledged, and in the further and other valuable considerations, the receipt of which, is also now and hereby acknowledged, I have sold, assigned, and transferred, and I do now and hereby sell, assign and transfer unto the said Christopher C. Campbell, his heirs, assigns, and lawful representatives, all the right, title and interest which I now have or ever had in, to, or for the said invention, improvements and letters patent, and of any and every reissue thereof; and I also, now, and hereby sell, assign, and transfer and convey unto the said Christopher C. Campbell, his heirs, assigns, and lawful representatives, all the right, title, interest, claim, or demand I now have, or ever had against any and every person, city, corporation, company or government, for the past use, manufacture, or sale of the said invention and letters patent: intending herein and hereby to sell, assign and convey unto the said Christopher C. Campbell, his lawful representatives, all and every of my right, title, interest, claim and demand for the entire past,
29 present, and future use, sale, or manufacture of the said invention, improvements, and letters patent, so dated and numbered as aforesaid; also the entire invention, improvements and letters patent aforesaid, and all and every reissue, as well as the full right, liberty and power to reissue of the said letters patent, as well as to sue for, and recover for any and all past infringements upon the said letters patent, each and every of which is to be and shall be held and enjoyed by him the said Campbell for his own use, benefit, and behoof and for the use, benefit and behoof of his legal representatives, to the full end of the term of seventeen years for which the said letters patent were granted and issued, as fully, freely and entirely as the same would have been held and enjoyed by me if this sale, assignment and transfer had not been made in the manner as herein stated and set forth.

Hereby selling, assigning and conveying unto him the said Christopher C. Campbell, his assigns, and lawful representatives all and every right, interest, title, privilege, claim or demand of every name and nature whatever; whether pending by suit in court or otherwise, which I now have, or ever had in any way, manner or form under the said letters patent, and any and every reissue of the same, to the full end of the term of seventeen years for which said letters patent were granted and issued, on and commencing with the 24th day of May A. D. 1864, with full right, power and authority to sue for any and all infringements of said letters patent; and to enforce, settle and adjust the same in court or otherwise for any and every manufacture, sale, or use of the said invention, improvement, and letters patent. And the said Christopher C. Campbell, as and for the further and additional consideration hereinbefore named or referred to, in and for the sale, purchase, assignment and transfer so as aforesaid made by me, the said Helen M. Ingalls, of the said invention and letters patent so dated and numbered, shall pay unto me, the said Helen M. Ingalls, my heirs, assigns, or lawful representatives, one-half or moiety part of any and all sums of money received or had for and on account of the said invention and letters patent from any source whatever, either for the use, manufacture, or sale of the said invention or letters patent, after deducting therefrom one-half of the actual and necessary expenses for settlement and collecting, for the use, sale, and manufacture, or for the infringement of the said letters patent. The said one-half part to be paid out of each and every sale, settlement or collection made for any use, or manufacture of the said invention and letters patent, either by or without a suit in court for the purposes hereinbefore stated; and any failure to perform according to the terms and conditions herein contained on the part of the said Christopher C. Campbell, his heirs, or assigns, or legal representatives, shall render this deed of assignment and transfer void and of none effect whatever, and the same shall thereafter be null and void and of no effect.

In testimony whereof I have on this 10th day of October A. D. 1877, hereunto set my hand and seal.

HELEN M. INGALLS. [L. S.]

Signed, sealed, and delivered in presence of—
MARCUS P. NORTON.

30 TOWN OF CANAAN, }
County of Columbia, State of New York. }

On this 12th day of October, A. D. 1877, personally came before me Helen M. Ingalls, to me personally known to be the person named in and who executed the foregoing deed of assignment, and she duly acknowledged to me in due form of law that she executed said instrument or deed of assignment and for the purposes therein named and set forth.

JOHN W. SMITH,
Justice of the Peace in and for the
County of Columbia, State of New York.

EXHIBIT G.

Whereas the letters patent of the United States of America were granted, issued, and delivered to James Knibbs and Marcus P. Norton of the city of Troy, county of Rensselaer and State of New York, for and upon new and useful improvements in pumps for steam fire and other engine pumps bearing date the 24th day of May A. D. 1864, numbered 42920, to which reference is now and hereby had for a more perfect understanding as to the invention and letters patent herein sold, assigned, and conveyed, and whereas, Marcus P. Norton, of the city of Troy, county and State aforesaid, now desires to become fully vested with, and to have vested in him, in trust for his wife Mrs. Minnie D. Norton, and daughters, Miss Ada Lavinia

Norton, Helen Grace Norton, and Estelle May Norton, all the right, title and interest and ownership which I now have, or ever had, in, to, or for the said invention and letters patent; also of and every claim and all claims for past use of said invention, or infring-ments upon the said letters patent so dated and numbered, and from the date of the same, to wit, the 24th day of May A. D. 1864, and to the present time.

Now, therefore, this deed of assignment, in trust witnesseth: that for and in consideration of the sum of one hundred dollars to me in hand paid, the receipt whereof is now and hereby duly acknowledged; and in the further and other valuable considerations, the receipt whereof is also hereby duly acknowledged, I, the said Helen M. Ingalls have sold, assigned, and conveyed, and I do now and hereby sell, assign, and convey to the said Marcus P. Norton, in trust so as aforesaid, all the right, title, interest, claims, or demands of whatever name, — nature that I have, or ever had, or ever could have, in, to, or for the said invention and letters patent; and in like manner in trust for the said Minnie D. Norton, Ada Lavinia Norton, Helen Grace Norton, and Edith May Norton, I, also, sell, assign, and convey unto him the said Norton, all the rights, interests, claims or
demands, of every name, kind, or nature, for and to the past
31 use, by anybody, of the said invention and improvements
under the said letters patent; and to or for any and all infringements upon the said letters patent by anybody since the said 24th day of May A. D. 1864, to the present time intending herein and hereby to sell, assign, and convey in trust, and hereby selling, assigning and conveying in trust to the said Norton, his heirs, assigns, and lawful representatives, all my right, title, interest, claims or demands for the past or future use of said invention and letters patent, by any person, or persons, or any city, village or town; or by any corporation, company, or partnership, or for any infringement upon the said letters patent by such person, or persons, city, village, town, corporation, company, or partnership since the said 24th day of May A. D. 1864, to the present time; and also in like manner, the entire invention, improvements, and letters patent so dated numbered, and issued.

The same to be held in trust, in the manner and for the purposes, and for the benefit of each of the persons herein named and as herein specified and set forth; and also intending herein and hereby to sell, assign and convey, and herein selling, assigning and conveying any and all actions, causes of action, or suits at law or in equity, for and on account of the said letters patent or any and all infringements thereof, or for past or future use of said invention, improvements, and letters patent in trust so as aforesaid; and including also, all my claims and rights to compensation for the past use of said invention and of said letters patent from the said 24th day of May A. D. 1864, to the present time; and authorizing him, the said Norton, to sue for, and to collect, and to receipt for the same. Hereby selling and conveying unto him, the said Norton, his heirs, assigns, and lawful representatives, all and every right, title, interest, privilege, claim or demand, which I now have, or ever had, or ever could have had in any way, manner or form, under the said letters patent to the full end of the term of seventeen years for which said letters patent were granted, on, and commencing the said 24th day of May A. D. 1864, with full right, power, and authority to sue for, to enforce, to settle, and to adjust the same for the past as well as for the future use of the said invention, improvements, and letters patent, or for any and all infringements of said letters patent, during the past or in the future. To have and to hold the same and every thereof in trust so as aforesaid, for himself and his heirs, assigns and lawful representatives, as fully, freely, and entirely as the same and every thereof would or could have been held and enjoyed by me had this sale, assignment, and conveyance not been made by me in the manner and form aforesaid.

In testimony whereof I have on this 30th day of October A. D. 1879, hereunto set my hand and seal in presence—

HELEN M. INGALLS. [L. S.]

MARCUS P. NORTON,
GEO. H. WILLIAMS.

32 STATE OF NEW YORK, }
City of New York, County of New York, } *ss:*

On this 28th day of September, in the year of our Lord one thousand eight hundred and eighty, before me personally came Helen M. Ingalls, to me personally known and known to be the person described in and who executed the foregoing deed of assignment and transfer, and she in due form acknowledged that she executed the same in the manner and form therein stated and set forth at the time of the date thereof and in the presence of Marcus P. Norton and George H. Williams, subscribing witnesses to the said deed or instrument in writing, having first read the same and each and all thereof, and hereupon and thereupon, on this 28th day of September, A. D. 1880, as above stated, she duly acknowledged the execution thereof and the signature and seal thereto to be hers.

[L. S.] FREDERICK G. KING,
Notary Public in and for County of N. Y.

EXHIBIT H.

Whereas, letters patent of the United States of America, were duly and lawfully granted, issued and delivered unto James Knibbs and Marcus P. Norton then of the city of Troy, county of Rensselaer, and State of New York for and upon certain new and useful improvements in "steam fire-engines and other engine pumps," and more especially upon and in that part known as the water-main suction and force pump, and the several connections thereof, for steam fire or other engine main water pump, substantially as described, set forth and claimed in said letters patent bearing date the 24th day of May A. D. 1864, numbered 42920 by the United States Patent Office, to which reference is now and hereby had for a more full and perfect description of the improvements and invention herein and hereby sold, assigned and conveyed in part as hereinafter stated and set forth, and

Whereas, on or about the 10th day of October A. D. 1877, the said James Knibbs by an instrument in writing did sell, assign, and convey to Christopher C. Campbell, then residing at East Chatham, county of Columbia, and State of New York and to his heirs, assigns, and lawful representatives all the right, title and interest of every name, nature and description which he, the said James Knibbs, then or ever had in, to or for the said letters patent and invention and improvements therein contained, including all actions or causes of action, or claims, or demands on account of any use or infringement upon said letters patent by any person, persons, or corporations or by anybody past, present, and future, of the said letters patent; which said deed of assignment and transfer was duly of record in said U. S. Patent Office on or about the 19th day of October A.D. 1877, in Liber G. 22, page 85 of Transfers of Patents, to which deed of assignment and record thereof, reference is now
33 and hereby had, for a more full, clear and perfect knowledge or information as to the letters patent and invention and claims, and actions, and causes of action, and the like, that was then sold, assigned and conveyed by said James Knibbs to the said Christopher C. Campbell in the manner as therein stated and set forth; and whereas, on or about the 13th day of February A. D. 1882, for good and sufficient cause and reason, the said Knibbs and the said Campbell entered into an agreement in writing by which the said Campbell sold, assigned, and conveyed unto the said Knibbs for the consideration therein stated and set forth, a certain and fixed part and interest in that part of the said letters patent, invention and claims, action, and causes of action, sold, assigned and conveyed to the said Campbell by the said Knibbs on or about the said 19th day of October A. D. 1877, and hereinbefore mentioned by date as well as by the record thereof, to which written instrument signed by the said Christopher C. Campbell, and by the said James Knibbs, and dated as aforesaid the 13th day of February, A. D. 1882, and of record in said United States Patent Office the 4th day of March, A. D. 1882, in Liber A. 28, page 17, of Transfers of Patents, reference is now and hereby had for a more correct and thorough understanding as to what was on that occasion sold, assigned and conveyed to the said James Knibbs, and the terms and considerations thereof; and whereas, Marcus P. Norton, now of the city of Boston, county of Suffolk, in the Commonwealth of Massachusetts, as trustee and in trust for Mrs. Minnie D. Norton, Miss Ada L. Norton, Miss H. Grace Norton, Miss Estelle M. Norton, and Miss Helen M. Ingalls formerly residing at Troy, N. Y., but now of said city of Boston, although at the present time, and for nearly two years past they and each thereof have been residing temporarily in the city of Stuttgart, Germany, is desirous of having and acquiring for them and each of them, all and every of my right, title, or interest, or claim, action or causes of action that I now have in the said letters patent, invention, and all rights or claims thereunder, so dated and numbered, and sold, assigned, and transferred in man-

ner and form so as aforesaid, and including therein all rights or claims to any and all past infringements upon or violations of said letters patent, and also all claims, rights, actions or causes of actions of any and every name, and description arising out of, or in consequence of said letters patent and the invention therein contained, or either of them, including all and every right, interest, claim, action or causes of action, or privilege or whaever the same may be that was reserved or retained by me on the 13th day of February 1882, when I sold, assigned and conveyed to James Knibbs certain rights and interest by an instrument in writing of that date which was signed by Christopher C. Campbell and the said James Knibbs jointly, and which is now and hereby made a part hereof and which I the said Campbell now have the full and the lawful right to sell, assign, and convey in, and by this deed, or instrument as and for the purposes herein contained and set forth.

Now therefore this deed of assignment or instrument in writing, hereby witnesseth: that for and in consideration of the sum of two thousand and five hundred dollars ($2,500,) and other good and sufficient considerations to me in hand paid, the receipt whereof is now and hereby acknowledged, and in the further considerations
of value, the receipt of which is also hereby duly ac-
34 knowledge, I have sold, assigned and conveyed and I do
hereby sell, assign and convey unto the said Marcus P. Norton, trustee and in trust as aforesaid, each and every right, claim, privilege, action or cause of action, or demand or infringement of or upon, or in violation of the said letters patent, by any person or persons or company, corporation, town, village or city, or government for the past and present use of said improvements and invention under and by virtue of said letters patent that *was* obtained by me from the said James Knibbs, on the said 10th day of October, A. D. 1877, by deed of assignment and transfer duly of record in said Patent Office in Liber G 22, page 85 of Transfer of Patents on the 19th day of October, A. D. 1877 as hereinbefore stated, and not reconveyed or reassigned to him by me on the said 13th day of February, A. D. 1882, by an instrument in writing, which has several times hereinbefore been referred to, intending herein to sell, assign and convey, and I do herein and hereby sell, assign and convey unto the said Norton, trustee and in trust as aforesaid, all and each of my right, title and demand or claims for the entire past use of the said improvements invention and letters patent so issued dated and numbered and hereinbefore stated in detail and at large, and of whatever name or nature arising from or growing out of or from or by reason of any manufacture, sale, or use thereof by anybody, and since the 24th day of May A. D. 1864, with the full right and power in his name, as trustee or assignee in trust or both, or in their name to sue for, to collect, and to adjust or settle any and all infringements of or upon said letters patent, by any person, company, corporation, town or city or of or by any office or department thereof, as will also more fully and at large appear by reference to the aforesaid named and described deeds of assignment hereinbefore mentioned and described by the date of each thereof and also by the

date and record of each thereof namely, the 10th day of October, 1877, and recorded in said Patent Office on the 19th day of October, 1877, in Liber G, page 85 of Transfers of Patents; and the 13th day of February, 1882, and recorded in said Patent Office on 4th day of March, 1882, in Liber A, 28, page 17 of the Transfers of Patents, and each of which is made a part *of* hereof for the purposes aforesaid of knowing the improvements; the invention and the letters patent to which this deed or instrument of transfer is intended to apply, and to which it does apply for any use or purpose herein suggested for explanation hereof or for any other use or purpose, the same and each and every whereof to be held and enjoyed by the said Norton assignee in trust and trustee as aforesaid, for the sole use, benefit and behoof of the said Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle M. Norton, and Helen M. Ingalls, and for the use, benefit and behoof of their and each of their heirs, assigns and legal representatives, from the beginning of the said letters patent, namely the 24th day of May, 1864, as fully, freely, and entirely as the same would or could have been held, used and enjoyed by me if this sale, assignment and transfer had not been made in the manner and for the purpose herein stated and set forth. Having heretofore reassigned and reconveyed to the said Helen M. Ingalls in and by a separate deed or instrument in writing, all that part of said invention and letters patent, and any and all claims arising from or growing out of any infringement of said letters patent as by said paper or deed, will
35 fully appear, conveyed and transferred to me by her, in and by said deed of assignment from herself to myself, dated so as aforesaid the 10th day of October, 1877, and recorded in said Patent Office, on the 19th day of October, 1877, in Liber G 22 page 85, of Transfers of Patents, and that said deed of assignment or written instrument of transfer having been duly cancelled, annulled, revoked, set aside and forever made void, this deed of assignment and transfer does not apply to that part of said invention and letters patent or in anywise relate thereto, but it does relate to, and only to that part of said invention and letters patent purchased by me of and from said James Knibbs on or about the said 10th day of October, 1877, and the deed of assignment thereof now of record in said Patent Office under date of October 19th, 1877, in Liber G, 22, page 85 of Transfers of Patents, and it also relates to said instrument in writing dated as aforesaid February 13th, 1882, and recorded as aforesaid on the fourth day of March, 1882, in said Patent Office.

In testimony whereof I have on this 10th day of July, A. D. 1882, hereunto set my hand and seal in the presence of—

CHRISTOPHER C. CAMPBELL. [L. S.]

H. W. BOSWORTH.
WM. R. WHITE.

CITY OF SPRINGFIELD, } ss:
County of Hampden and State of Massachusetts, }

On this 27th day of September, A. D. 1882, before me, the undersigned, a notary public, personally came Christopher C. Campbell, known to me and to me known to be the person who signed and sealed the foregoing instrument, and he in person duly acknowledged to me the making and sealing of said deed of assignment or instrument, and that he did the same of his own free will for the purposes and uses therein stated, and being requested by him I also became a witness to his said signature and seal.

HENRY W. BOSWORTH.
[L. S.] *Notary Public in and for said County of Hampden.*

EXHIBIT L.

Whereas letters patent of the United States of America, were duly and lawfully granted, issued, and delivered unto James Knibbs and Marcus P. Norton, then of the city of Troy, county of Rensselaer and State of New York, for and upon certain new and useful improvements in "steam-fire-engines and other engine pumps" and more especially upon and in that part known as the water-main suction and force pumps and the several connections thereof for
36 steam fire or other engine main water pumps substantially as described, set forth and claimed in said letters patent bearing date the 24th day of May A. D. 1864, and numbered 42920, by the United States Patent Office, to which reference is now and hereby had for a more full and perfect description of the improvements and invention herein and hereby sold, assigned and conveyed in part as hereinafter stated and set forth; and whereas, the said Marcus P. Norton on or about the 19th day of March A. D. 1877, by an instrument in writing bearing date as aforesaid, and thereafter duly recorded in the United States Patent Office to wit; on or about the 12th day of April, 1877, in Liber P 21, page 181, of Transfers of Patents did by a certain deed of assignment or instrument in writing and for a valuable consideration, sell, assign, and convey unto Helen M. Ingalls all his right, title, interest, and ownership in, to and for the said letters patent and the invention therein contained, also any and all claims and demands, or rights, actions, or causes of action growing out of any and all infringements of or upon the said letters patent wherever or by whomsoever committed the same being one equal undivided half or moiety thereof, which said deed of assignment and transfer or conveyance in writing was duly recorded in the Patent Office of the United States on or about the 12th day of April A. D. 1877, in Liber P 21, page 181, of Transfers of Patents, as hereinbefore stated and set forth; all of which will more fully and at large appear by reference to the said deed of assignment and of the record of the same, to which reference is hereby made for such purposes now and at all times, and whereas, the said Helen M. Ingalls on or about the 10th day of October, 1877, by an instrument in writing bearing date as aforesaid and thereafter duly recorded in the United States Patent Office, to wit: on or about the 19th day of

October, 1877, in Liber G 22, page 89 of the Transfers of Patents did in trust and on certain conditions sell, assign, and convey unto said Campbell all her rights, title, interest and ownership in to and for the said invention and letters patent, including all and every claim, demand, right, title or ownership action, or cause of action growing out of any and all infringements of or upon the said letters patent wheresoever or by whomsoever committed the same being one-half or moiety of the whole thereof, which said deed of assignment and transfer in writing was duly recorded in the Patent Office of the United States, on or about the 19th day of October, 1877, in Liber G 22, page 89, of the Transfers of Patents, as hereinbefore stated and set forth, all of which will more fully and at large appear therein and in the record thereof, to each of which reference is now and hereby had for the purpose of showing what was so assigned in trust to the said Campbell by the said Helen M. Ingalls on or about the day and date aforesaid, and whereas, the said Helen M. Ingalls is desirous of having and repossessing all that part of the said invention and letters patent, of each and every claim or demand, right, title, interest, ownership, of every name and nature, and all actions or causes of action in anywise arising upon or growing out of any and every infringement of or upon, or violation of said letters patent at any time or place or by whomsoever committed and covered by and embraced in the said deed of assignment and transfer made by her aforesaid to the said Christopher C. Campbell on or about
the said 19th day of October, A. D. 1877, such repossession
37 the said Helen M. Ingalls desires to obtain from the said
Campbell, by a deed of assignment and transfer reassigning and reconveying the same invention property, letters patent, rights, claims, actions and causes of action mentioned and set forth in her said deed of assignment to said Campbell, stated and recorded so as last aforesaid.

Now therefore this deed of assignment and transfer and of reassignment and retransfer, witnesseth: That for and in consideration of the sum — one dollar to me in hand paid, the receipt of which is now and hereby duly acknowledged, and in the other and further valuable considerations, the receipt of which is also hereby duly acknowledged, I, the said Christopher C. Campbell have sold, assigned, conveyed, and I do now and hereby sell, assign and convey unto the said Helen M. Ingalls, her heirs, assigns and lawful representatives all that part of said invention and letters patent, also all and every right, privilege, demand, claim, action or rights of action, arising in consequence of or growing out of any and all infringements of or upon, or in violation of said letters patent, whenever or by whomsoever committed, and which are embraced in and covered by the said deed of assignment and conveyance aforesaid by the said Helen M. Ingalls to me the said Campbell, intending herein and hereby to reassign and retransfer and reconvey unto the said Helen M. Ingalls and her lawful representatives aforesaid all the right, title, ownership, interests, demands, claims for the past use of the said invention and letters patent that were conveyed to me by the said Ingalls on or about the said 19th day of

October, A. D. 1877, by deed of assignment and transfer in writing and dated on or about that day, and duly of record in said Patent Office in Liber G 22, page 89, of Transfers Patents as hereinbefore several times stated, the same and each and every thereof, to be held and enjoyed by the said Ingalls, for her own use, benefit and behoof and for the use, benefit and behoof of her heirs, assigns and legal representatives from the date of the said letters patent, namely, the 24th day of May, A. D. 1864, and until the 24th day of May A. D. 1881, the date of the expiration of the term for which said letters patent were granted and issued covering and embracing a period or term of time fixed by law, namely, seventeen years from and after the said 24th day of May, 1884, as freely, fully, and entirely as the same would have been held and enjoyed by me if this sale, assignment, reassignment and reconveyance to her the said Helen M. Ingalls had not been made by me the said Campbell, in the manner aforesaid. Having herein and hereby reassigned and reconveyed to the said Ingalls all of the invention, letters patent, claims for infringements, demands, rights, privileges, title, actions, and causes of action of every name and description, growing out of or arising under said letters patent because of any infringements of or upon said patent mentioned or contained in her aforesaid-named deed of assignment to me dated and recorded in the Patent Office so as aforesaid thereby leaving and placing her in possession of the said letters patent and invention and all claims and rights, actions and causes of action, the same as she was at once before her said deed of assignment to me as aforesaid. I now and hereby cancel, rescind, set aside, vacate, and destroy, annul and make void forever the said deed of assignment of the 19th day of
38 October, 1877, signed by me and Helen M. Ingalls and delivered
to me as stated therein, and ever hereafter the said assignment and the record thereof shall forever be without force or effect in law or in equity, the same is now and hereby surrendered by me to her and cancelled so as aforesaid as is also the record of the same.

In testimony whereof I have on this 10th day of July A. D. 1882, hereunto set my hand and seal in the presence of—

CHRISTOPHER C. CAMPBELL. [L. S.]

WM. R. WHITE.
HENRY W. BOSWORTH.

CITY OF SPRINGFIELD,
County of Hampden and State of Massachusetts, } *ss:*

On this 27th day of September, A. D. 1882, before me, the undersigned, notary public, personally came Christopher C. Campbell, known to me and to me known to be the person who signed and sealed the foregoing instrument, and he in person duly acknowledged to me the making and sealing of said deed of assignment, and that he did the same of his own free will for the uses and purposes therein stated, and being requested by him I also became a witness to his said signature and seal.

HENRY W. BOSWORTH.
[L. S.] *Notary Public in and for said County of Hampden.*

EXHIBIT J.

Whereas: the letters patent of the United States of America, were duly granted and issued to James Knibbs and Marcus P. Norton of the city of Troy, county of Rensselaer, and State of New York, for and upon certain new and useful improvements in pumps for steam-fire-engine and other engine pumps, which bear date the 24th day of May A. D. 1864, and which are numbered 42920, to which reference is now and hereby had for a more full description of the invention herein and hereby sold, assigned and transferred, in the manner hereinafter stated: and

Whereas: the said Marcus P. Norton did on or about the 19th day of March, A. D. 1877, sell, assign and convey unto Helen M. Ingalls, of the said city of Troy, county and State, each and every of his right, title and interest in, to or for the said invention and letters patent so dated and numbered, which deed of assignment was duly of record in the Patent Office of the United States on the 12th day of April A. D. 1877, in Liber P 20, page 181, of Transfers of Patents, to which said deed of assignment so dated and of record reference is now and hereby had: and

Whereas, I the said Helen M. Ingalls am now the lawful owner and holder of one-half or moiety part of the said letters patent and of the invention therein contained, as will more fully and at
39 large appear from the said deed of assignment last above mentioned and described.

And whereas Christopher C. Campbell of the town of Chatham, residing at the village of East Chatham in said town, county of Columbia, and State of New York, is desirous of having and acquiring all the right, title, and interest which I now have or ever had in, to, or for the said invention, improvements or letters patent, and of any and every reissue of the same; also any and every claim or demand I now have, or ever had, for the past use, manufacture and sale of the same, and conveyed to me by the said Marcus P. Norton by the said deed of assignment, dated as aforesaid, to wit, the 19th day of March A. D. 1877, and recorded in said Patent Office, on the 12th day of April A. D. 1877, in Liber 21, page 181 as aforesaid.

Now, therefore, this indenture or deed of assignment and transfer, witnesseth, that for and in consideration of the sum of one hundred dollars to me the said Helen M. Ingalls, in hand paid by the said Christopher C. Campbell, the receipt of which is now and hereby acknowledged, and in the further and other valuable considerations the receipt of which is, also, now and hereby acknowledged, I have sold, assigned and transferred and I do now and hereby sell, assign and transfer unto the said Campbell, his heirs, assigns and lawful representatives, all the right, title and interest which I now have or ever had in, to or for the said invention or letters patent, and of any and every reissue thereof, and I also now and hereby sell, assign and transfer and convey unto the said Campbell, his heirs, assigns and lawful representatives, all the right, title, and interest, claim or demand, I now have or ever had against any and every person, city, corporation, company or government, for the past use, manufacture, or sale of the said invention and letters patent; intending herein and hereby to sell, assign and convey unto the said Christopher C. Campbell, his lawful representatives, all and every of my right, title, interest, claim or demand for the entire past, present and future use, sale, or manufacture of the said invention, improvements, and letters patent, so dated and numbered as aforesaid; also the entire invention, improvements and letters patent aforesaid, and all and every reissue of the same as well as the full right, liberty and power to reissue the said letters patent as well as to sue for and recover, for any and all past infringement upon the said letters patent, each and every of which is to be, and shall be, held and enjoyed by him the said Campbell for his own use, benefit and behoof, and for the use, benefit and behoof of his legal representatives, to the full end of the term of seventeen years from which the said letters patent were granted and issued, as fully, freely and entirely as the same would have been held and enjoyed by me, if this sale, assignment and transfer had not been made in the manner as herein stated and set forth.

Hereby selling, assigning, and conveying unto him the said Campbell, his assigns and lawful representatives, *and* all and every right, interest, title, privilege, claim or demand of every name and nature, whatsoever; whether pending by suit in court or otherwise, which I now have or ever had in any way, manner or form, under the said letters patent, and any and every reissue of the same, to the full extent of the term of seventeen years for which said
40 letters patent were granted and issued on and commencing with the 24th day of May A. D. 1864, with full right, power and authority to sue for any and all infringements of said letters patent, and to enforce, settle, and adjust the same in court or otherwise for any and every manufacture, sale or use of the said invention, improvements and letters patent.

And the said Christopher C. Campbell as and for the further and additional consideration hereinbefore named or referred to, in and for the sale, purchase, assignment, and transfer so as aforesaid made by me the said Helen M. Ingalls of the said invention and letters patent so dated and numbered shall pay unto me the said Helen M. Ingalls, my heirs, assigns or lawful representatives, one-half or moiety part of any and all sums of money received or had for and on account of the said invention and letters patent from any source whatever, either for the use, manufacture or sale of the said invention or letters patent, after deducting therefrom one-half of all the actual and necessary expenses for settlement and collecting for the use, sale or manufacture, or for the infringement of the said letters patent. The said one-half part to be paid out of each and every sale, settlement or collection, made for any use or manufacture of the said invention and letters patent, either by or without a suit in court for the purposes hereinbefore stated, and any failure to perform according to the terms and conditions herein contained on the part of the said Christopher C. Campbell, his heirs, or assigns or legal representatives, shall render this deed of assignment and transfer void and of none effect whatever, and the same shall thereafter be null and void and of no effect.

In testimony whereof, I have on this 10th day of October, A. D. 1877, hereto set my hand and seal:

HELEN M. INGALLS. [L. S.]

Signed, sealed, and delivered in presence of—
MARCUS P. NORTON.

TOWN OF CANAAN,
County of Columbia, State of New York.

On this 12th day of October, A. D. 1877, personally came before me Helen M. Ingalls, to me personally known to be the person named in and who executed the foregoing deed of assignment, and she duly acknowledged to me in due form of law that she executed said instrument or deed of assignment and for the purposes therein named and set forth.

JOHN W. SMITH,
Justice of the Peace in and for the County of Columbia, State of New York.

41 Cancellation, revocation, and vacation of the within deed of assignment and transfer by consent dated September 27th, 1882.

This instrument and deed of assignment and transfer is now and hereby cancelled, revoked, annulled, and made void and of none effect or operation, in law or in equity, and it is hereby vacated and set aside by mutual consent of the parties on the day first above written.

CHRISTOPHER C. CAMPBELL.
ELIZABETH L. CAMPBELL.

Witnesses:
MARCUS P. NORTON.
FRANCIS L. WELLMAN.

EXHIBIT K.

Be it known: That we, Marcus P. Norton, of Boston, county of Suffolk and State of Massachusetts, as patentee, assignee and assignee in trust, and Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle M. Norton and Helen M. Ingalls, all of said Boston, county and State aforesaid, for and in consideration of one dollar, and of other good and valuable considerations received by us from Ruel Philbrook, of said Boston, have sold, assigned, transferred and conveyed, and by these presents do hereby sell, assign, transfer and convey unto the said Ruel Philbrook all of our right, title and interest, and the entire right, title and interest of each of us, in and to letters patent of the United States, granted to James Knibbs and Marcus P. Norton, for an improvement in steam-fire-engine and other engine pumps, numbered 42920, and of date May 24th, 1864, and in and to the invention and improvements therein shown and described, and the exclusive rights and privileges therein secured, and, in and to all claims, debts, dues and demands, action and causes of action against any and all persons, firms or corporations, bodies politic or corporate, arising and growing out of any and all infringements upon said letters patent and the exclusive rights and privileges therein secured by each and every of such persons, firms, corporations, bodies politic or corporate, from the date of the grant of said letters patent to the termination thereof, hereby giving and granting unto said Ruel Philbrook full power and authority to ask demand, sue for, collect and receive the damages for each and all infringements upon said letters patent, in the same manner, and to the same extent that we might and could have done, had this assignment not been made.

To have and to hold the same unto the said Ruel Philbrook, his heirs and assigns in trust to and for the following uses and purposes, that is to say:

Out of the proceeds derived from the collections of money by said Philbrook, from any person or corporation, for and in settlement of damages for the infringement of said letters patent, first to satisfy and pay for any and all necessary and proper expenses,
42 then already incurred by him, in collecting and obtaining settlements and payments as aforesaid, including herein his own personal expenses, moneys paid out and expended by him for legal services, counsel and attorney fees, witnesses and the expenses of their attendance, models and exhibits, and any and all other necessary and proper expenses incurred in and about the collection of damages for infringements of said letters patent; second, as often as there shall be a balance remaining over in the hands of said Philbrook from such collections after deducting the expenses as aforesaid, then to apply to the sole use and benefit of said Philbrook, his heirs and assigns, one-fourth part of said balance, and to pay over to John L. S. Roberts of said Boston, one-fourth part, and the remainder to the parties in interest, as their several interests now stand, they giving proper receipts therefor.

In witness whereof we have hereto and to another assignment of like tenor and date, this 20th day of May, 1884, set our hands and seals.

MARCUS P. NORTON, Jr. [L. S.]
MINNIE D. NORTON. [L. S.]
ADA L. NORTON. [L. S.]
H. GRACE NORTON. [L. S.]
ESTELLE M. NORTON. [L. S.]
HELEN M. INGALLS. [L. S.]
MARCUS P. NORTON. [L. S.]

In presence of—
JOSEPH P. DAY.
F. J. DONOVAN.
LEWIS C. LILLIE.

Rewitnessed April 5, 1886, as to all but Marcus P. Norton.
JAS. B. LOCKWOOD.

COMMONWEALTH OF MASSACHUSETTS, }
Suffolk County. }

I, Marcus P. Norton, as trustee and in my individual capacity, hereby admit, acknowledge, and declare that on the 20th day of May, 1884, I signed, sealed, and delivered the within and foregoing instrument for the uses and purposes therein mentioned and contained, and said instrument is genuine and valid for all the uses and purposes mentioned therein, and I hereby confirm the same and acknowledge it to have been and to be my free act and deed.

MARCUS P. NORTON, *Trustee.*
MARCUS P. NORTON.

COMMONWEALTH OF MASSACHUSETTS, } *ss:*
County of Suffolk. }

BOSTON, *January* 30, 1885.

Subscribed and acknowledged by the said Marcus P. Norton, as trustee and in his individual capacity, as his voluntary act and deed, before me—

JOHN T. KENNERK,
Justice of the Peace.

43 STATE OF NEW YORK, } *ss:*
City and County of New York. }

On this 5th day of April, 1886, before me personally came Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle M. Norton, and Helen M. Ingalls, to me known to be the same persons described in and who executed the foregoing instrument, and they severally acknowledged to me that they executed the same as their free act and deed and as the free act and deed of each of them for the uses and purposes therein mentioned.

JAMES H. FITCH,
Notary Public, N. Y. City & Co., No. 11.

A true record.
Attest: JOHN G. STETSON, *Clerk.*

The following is the assignment of errors filed by the plaintiff:

Assignment of Errors.

(Filed Oct. 2, 1890.)

First. It was error in the circuit court to rule that the action could not be maintained by Ruel Philbrook as brought, and to hold that said Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties who held the entire title to the patent in suit for the time being.

Second. It was error in the circuit court to instruct the jury in these words: "The court has settled this question of law which arose here, and it is decided that the statute of limitations of the Commonwealth of Massachusetts is a defence to this suit, as all claims for damages by the plaintiff are limited to infringements which took place more than six years before the commencement of this suit; therefore you will return a verdict for the defendant."

Third. It was error in the circuit court to direct a verdict for the defendant on the ground that the action was barred by the statute of limitations of the Commonwealth of Massachusetts.

44 *Clerk's Certificate.*

UNITED STATES OF AMERICA, } *ss:*
Massachusetts District, }

I, John G. Stetson, clerk of the circuit court of the United States for the first circuit and district of Massachusetts, certify that the foregoing is a true copy of the record of said circuit court in the cause entitled, No. 2925, law docket, Christopher C. Campbell, plaintiff, *v.* The City of Haverhill, defendant, lately determined in said circuit court, and of all proceedings therein and of the assignment of errors filed therein.

Seal of the Circuit Court, Massachusetts.

In testimony whereof I hereunto set my hand and affix the seal of said circuit court, at Boston, in said district, this first day of October, in the year of our Lord one thousand eight hundred and ninety, and of the Independence of the United States the one hundred and fifteenth.

JOHN G. STETSON, *Clerk.*

45 *Bond on Writ of Error.*

Know all men by these presents that we, Ruel Philbrook, of Boston, in the State of Massachusetts, suing in the name of Christopher C. Campbell in the suit hereinafter named, principal, and Daniel S. Goodell, of Searsport, in the State of Maine, as surety, are held and firmly bound unto The City of Haverhill, a corporation created and existing in due form of law in the county of Essex and Commonwealth of Massachusetts, in the full and just sum of three hundred dollars, to be paid to the said City of Haverhill, its certain attorneys or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated the thirtieth day of September, in the year of our Lord one thousand eight hundred and ninety.

Whereas lately, at a circuit court of the United States within and for the district of Massachusetts, in a suit depending in said court between said Ruel Philbrook, suing in the name of Christopher C. Campbell, of Chester, in the county of Hampden, in the said Commonwealth, assignee in trust, plaintiff, and the said City of Haverhill, defendant, judgment was rendered against the said plaintiff, and the said plaintiff having procured a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said defendant, citing and admonishing it to be and appear at a Supreme Court of the United States to be holden at Washington on the second Monday of October next:

Now, the condition of the above obligation is such that if the said plaintiff shall prosecute his said writ of error to effect and answer all damages and costs if he fail to make his plea good, then the above obligation to be null and void; otherwise to remain in full force and virtue.

RUEL PHILBROOK. [L. S.]
DANIEL S. GOODELL. [L. S.]

Signed, sealed, and delivered in presence of—
A. H. TROWBRIDGE.

Approved.
LIVERMORE & FISH,
Attorneys for Defendant.

A true copy of the bond taken by the judge at the time of allowing the writ of error named in said bond, which bond is on file in the office of the clerk of the circuit court of the United States for the first circuit and district of Massachusetts.

Attest:
——— ———,
Clerk U. S. C. C., Mass. Dist.

Endorsed on cover: Case No. 14,478. Massachusetts C. C. U. S. No. 383. Christopher C. Campbell, plaintiff in error, *vs.* The City of Haverhill. Filed February 11, 1891.

155-610

Office Supreme Court, U. S.
FILED
NOV 20 1894
JAMES H. McKENNEY,
Clerk.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1894.

Term No. 87.

CHRISTOPHER C. CAMPBELL,
Plaintiff in Error,
v.
THE CITY OF HAVERHILL.

BRIEF FOR PLAINTIFF IN ERROR.

HARVEY D. HADLOCK,
of Counsel.

Supreme Court of the United States,

OCTOBER TERM, 1894.

No. 87.

CHRISTOPHER C. CAMPBELL,
Plaintiff in Error,

v.

THE CITY OF HAVERHILL.

BRIEF FOR PLAINTIFF IN ERROR,

By Harvey D. Hadlock.

FIRST.

Statement of the Case.

On the twenty-fourth day of May in the year A. D. 1864, letters patent of the United States were granted to James Knibbs and Marcus P. Norton for an invention by James Knibbs, whereby steam fire and other engine pumps were improved.

The invention consisted in connecting the discharge or force side of the main water pump of a steam fire engine with the suction or receiving side of it (Record, pp. 18, 19, 20).

The connection was by a conduit controlled by a valve by which the pressure of water in the pump could be regulated so that when the valve was removed from off its seat, the pressure on the force side would be reduced in proportion to the distance the valve might be raised, and when raised one fourth of an inch from off its seat, no water would be forced from the pump, but the water would pass from one side to the other, or, in the express language of firemen, "churn in the pump."

The invention went into general use throughout the United States, and since 1864 all steam fire engines have been constructed with such a connection, or by an aperture in the partition of the main water pump controlled by a valve, the face of which rests on a seat in the partition of the pump, the stem of the valve passing out through its shell to which a wheel for its manipulation is attached.

James Knibbs assigned one moiety of the patent to Marcus P. Norton before the letters were issued, and when issued, the patent was granted to James Knibbs and Marcus P. Norton (Record, p. 17).

Subsequently James Knibbs assigned a one-fourth interest in said invention to one Lemuel Tupper (Record, Exhibit B., pp. 20, 21). Tupper reassigned to Knibbs all the interest which Knibbs had conveyed to him (Record, Exhibit C, pp. 21, 22). Marcus P. Norton, on the nineteenth day of March, 1877, assigned all of his interest in the patent and claims for the entire past and future use of said invention, to one Helen M. Ingalls (Record, Exhibit D, pp. 22, 23).

James Knibbs, on the tenth day of October in the year 1877, assigned all of his interest or claim for the entire past and future use of said invention to Christopher C. Campbell (Record, Exhibit E, pp. 24, 25, 26).

On the tenth day of October, in the year 1877, Helen M. Ingalls assigned all of her interest in said invention, together with all claims for past infringements, to Christopher C. Campbell, and on that day Campbell held title to the entire invention (Record, Exhibit F, pp. 26, 27, 28).

On the thirtieth day of October, in the year 1879, Helen M. Ingalls conveyed all of her interest to Marcus P. Norton in trust for Mrs. Minnie D. Norton, Miss Ida L. Norton, Miss H. Grace Norton, Miss Estelle M. Norton and Miss Helen M. Ingalls, together with all claims for infringements (Record, Exhibit H, pp. 30, 31, 32, 33)

On the tenth day of July, A. D., 1882, Christopher C. Campbell conveyed all his interest in said invention to Miss Helen M. Ingalls; this assignment included all claims for past infringements (Record, Exhibit I, pp. 34, 35, 36).

On the twenty-seventh day of September, A. D., 1882, the assignment from Helen M. Ingalls to Christopher C. Campbell, dated October 10, A. D., 1877, was cancelled by said Campbell, said cancellation being also signed by Elizabeth L. Campbell, wife of said Campbell (Record, Exhibit J, pp. 37, 38, 39).

The title for all claims for past infringements then stood in Marcus P. Norton, trustee for Minnie D. Norton, Ada L. Norton, H. Grace Norton, Estelle M. Norton and Helen M. Ingalls.

On the twentieth day of May, 1884, Marcus P. Norton, as trustee, and the above-named persons for whom he held his trust, joining with him, conveyed to Ruel Philbrook all their right, title and interest, and the entire right, title and interest of each of them in and to all claims, debts, dues and demands, actions and causes of action, against any and all persons, firms, or corporations, bodies politic or corporate, arising and growing out of any and all infringements upon, said letters patent, from the date of the grant of said letters patent to the termination thereof, giving and granting unto said Ruel Philbrook full power and authority to ask, demand, sue for and collect said damages for each and all infringements upon said letters patent in the same manner and to the same extent that they might and could have done had said assignment not been made (Record, pp. 39, 40).

By reason of this last assignment, Mr. Philbrook, as trustee, brought suit in the name of all assignors through whom he claimed against the defendant corporation, and eleven other cities of Massachusetts; which by agreement are to abide the decision of this court in the suit at bar and sought in a single action to recover for all infringements by the defendant corporation during the life of the patent (Record, pp. 3, 4, 5, 6, 7, 8, 9, 10, 11, 12).

The defendant corporation admitted, for the purposes of the trial, that the defendant had used steam fire engines containing the invention claimed in the patent in suit from May 24, 1864, to May 24, 1881 (Record, p. 15).

The Court ruled that the action could not be maintained as brought, and that Mr. Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties who held the entire title to the suit for the time being. To this ruling the plaintiff Philbrook excepted (Record, p. 15).

Mr. Philbrook then discontinued as to all the plaintiffs named in his writ, except Christopher C. Campbell, and proceeded in his name. The declaration, by leave of court, was further amended by striking out all the allegations that related to Benjamin Richardson, and the name of said Richardson wherever it occurred (Record, p. 15).

It was also admitted for the purposes of the trial, that the entire title in the patent vested in Christopher C. Campbell, individually, or as trustee, from the tenth day of October, 1877, and for the purposes of the trial, no claim for damages was made in behalf of said Campbell after the twentieth day of December, 1880 (Record, p. 16). The defendant's counsel then asked the court to direct a verdict for the defendant, on the ground that the action was barred by the statute of limitations of the Commonwealth of Massachusetts (Record, p. 16.)

The court decided that the statute of limitations of the Commonwealth of Massachusetts was a defence, and instructed the jury to return a verdict for the defendant (Record, p. 16).

SECOND.

ASSIGNMENT OF ERRORS.

The errors apparent in the record, and relied upon by the plaintiff in error, as stated in the record, pp. 41, 42, are as follows :

First.—It was error in the Circuit Court to rule that the action coald not be maintained by Ruel Philbrook as brought, and to hold that said Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties in whom the entire title to the patent in suit vested for the time being.

Second.—It was error in the Circuit Court to instruct the jury in these words:

> "The court has settled this question of law which arose here, and it is decided that the statute of limitations of the Commonwealth of Massachusetts is a defence to this suit, as all claims for damages by the plaintiff are limited to infringements which took place more than six years before the commencement of this suit; therefore, you will return a verdict for the defendant."

Third.—It was error in the Circuit Court to direct a verdict for the defendant on the ground that the action was barred by the statute of limitations of the Commonwealth of Massachusetts.

First Specification.

The Circuit Court should have ruled that, as Ruel Philbrook held all the rights which had accrued to the several assignors by reason of past infringements by the defendant, with the possible exception of Lemuel H. Tupper and Benjamin Richardson; as trustee, he could maintain the suit in his own name.

Second Specification.

The Circuit Court should have held that the statute of limitations of the Commonwealth of Massachusetts had no application to the case at bar.

Third Specification.

The Circuit Court should not have directed a verdict for the defendant on the ground that the action was barred by the statute of limitations of the Commonwealth of Massachusetts.

THIRD.

OUTLINE OF ARGUMENT.

First. Ruel Philbrook held all claims for infringements during the life of the patent as trustee, with power to sue for and collect them.

Second. Mr. Philbrook was an assignee of a *chose in action*, and was proceeding by his suit to reduce the same into his possession, and proceeded against the defendant in one action in order to avoid a multiplicity of suits.

Third. The defendant could not be prejudiced by the form of action.

Fourth. The action should have proceeded in the name of Ruel Philbrook, trustee.

Fifth. The statute of limitations of the Commonwealth of Massachusetts has no application to suits brought in the Circuit Court of the United States founded upon Letters Patent.

Sixth. The action should have been submitted to the jury; and directing a verdict for the defendant on the ground that the action was barred by the statute of limitations of the Commonwealth of Massachusetts, was a misapplication of law.

ARGUMENT.

First Point.

A.

The Revised Statutes of the United States, sec. 4919, provides that—

> "Damages for the infringement of any patent may be recovered by action on the case in the name of the party interested either as patentee, assignee, or grantee."

In *Moore* v. *Marsh*, 7 Wall., 515, Mr. Justice CLIFFORD, speaking for the court, said,—

> "Assignees and grantees, as well as the patentee, may under some circumstances maintain an action on the case in their own name, as appears by the express words of the act of Congress.
>
> "An assignee is one who holds under a valid assignment in writing the whole interest of a patent, or any undivided part of such whole interest, throughout the United States."

Mr. Philbrook had received the entire right to sue for damages sustained by infringements of the patent from its date to its expiration.

I have been unable to find an authority bearing directly upon the question involved in the first assignment of error; but, conceding the claims for past infringements to be a *chose in action* as to each claim, then, as the patent had expired and Mr. Philbrook had acquired all the rights that the several owners had in the invention during its existence, he was in a position to proceed in one suit against the defendant to recover all that was then due him by reason of its infringements (Record, p. 15).

The reason for five separate suits in order to enforce a single *chose in action* is not readily apparent, when all the rights of both plaintiff and defendant could be determined in a single action. Why should the defendant be put to the expense and inconvenience of defending several suits when one suit will present all the issues involved in the several suits? And why should the plaintiff, by bringing several suits, be obliged to subject himself to the provision contained in section 977 of the Revised Statutes of the United States, which is as follows:—

> "If several actions or processes are instituted in a court of the United States or one of the Territories, against persons who might legally be joined in one action, or process touching the matter in dispute, the party pursuing the same shall not recover, on all of the judgments therein which may be rendered in his favor, the costs of more than one action or process, unless special cause for said several actions or processes is satisfactorily shown on motion in open court."

Mr. Philbrook, as the holder of claims against the defendant, covering the entire period of the patent's existence, was, I submit, entitled to sue for his own benefit and use, in the name of all of the several assignors, from whom he derived, through his immediate assignors, title to all claims for infringements by the defendant from May 24, 1864, to May 24, 1881 (Record, p. 15).

By the supplement to Revised Statutes of the United States, page 612, suits for damages for infringement may be brought by patentee, assignee, or grantee.

Mr. Justice Clifford, speaking for this court in *Moore* v. *Marsh*, 7 Wall., on p. 520, said,—

> "Assignees and grantees, as well as the patentee, may, under some circumstances, maintain an action on the case for an infringement in their own name, as appears by the express words of the act of congress."

The circumstances in the case at bar are such as the learned justice must have contemplated, for the right to maintain a suit against the defendant vested in Mr. Philbrook, and none of the persons who had held title during the period of infringement could maintain an action against the defendant. They had parted with their right to sue, and could only be made nominal plaintiffs by Mr. Philbrook, who could sue in their name for his own benefit.

They could not exercise control over the action brought by Mr. Philbrook, and had no independent standing in court.

Welch v. *Mandeville*, 1 Wheat., 235.

Mr. Justice Story, in speaking for this court in *Welch* v. *Mandeville*, 5 Wheat., on page 629, said,—

"It has been long since settled that, where a

> *chose in action* is assigned by the owner, he shall not be permitted fraudulently to interfere and defeat the rights of the assignee in the prosecution of any suit to enforce those rights."
>
> "The law permits the owner of a patent who has been injured by its infringement, to assign his right of action for such injury in conjunction with an assignment of the patent, and thus to transfer to the assignee not only the monoply itself, but also the power to recover compensation for its past infringement."
>
> Robinson on Patents, Vol. 3, Sec. 943.

> "An assignee of this character may maintain an action in his own name for these infringements under the former owner either during the life of the patent or after it has expired."
>
> Robinson on Patents, Vol. 3, Sec. 943, pp. 132, 133.

In *Adams v. Bellaire Stamping Co.*, 25 Fed. Rep. 270, SAGE, J., said.

> "It is my opinion that the plaintiff in these actions, by virtue of his title as assignee, has the right to sue in his own name for all infringements, including those of date prior to the assignments under which he claims. This opinion is based upon the provisions of Section 4919, Rev. St., that damages for infringements may be recovered in the name of the party interested. In cases where the assignment does not include prior claims for infringement, the holder of the patent at the time of the prior infringement should be joined as plaintiff, but only for the

> reason that the assignment of a patent does not carry with it claims for prior infringements."

Lemuel H. Tupper, who held title from the twenty-third day of August, 1867, to the twentieth day of July, 1874, may so have assigned for prior infringements as not to confer upon Mr. Philbrook the right to sue in his own name as assignee and trustee during the period that Tupper held title: and if so, then Lemuel H. Tupper was properly joined as a co-plaintiff.

The declaration in the case at bar contains separate and distinct counts, in which each owner in the invention during the period he was such owner, is made plaintiff, and the declaration alleges in substance that by reason of the rights which the several parties had, and which they assigned to Mr. Philbrook as trustee, he was entitled to recover for all infringements by the defendant corporaton during the life of the patent.

MR. JUSTICE FIELD, in the opinion of this Court in *Stark* v. *Starr*, 94 U. S., on page 485, said:

> "It is undoubtedly a settled principle that a party seeking to enforce a claim, legal or equitable, must present to the Court, either by the pleadings or proofs, or both, all the grounds upon which he expects a judgment in his favor. He is not at liberty to split up his demand and prosecute by piecemeal, or present only a portion of the grounds upon which special relief is sought, and leave the rest to be presented in a second suit, if the first fail. There would be no end to litigation if such a practice were

> permissible. But this principle does not require distinct causes of action—that is to say, distinct matters—each of which would authorize by itself independent relief, to be presented in a single suit, though they exist at the same time and might be considered together."

In this connection it should not be overlooked that Mr. Philbrook was the only party who had the right to sue, and that his right was complete against the defendant corporation as to all the infringements during the life of the patent; therefore I submit it was incumbent upon him to bring the suit in the case at bar for his own use in the names of those through whom he claimed. Mr. Philbrook did not join his several assignors because they had an interest in the patent jointly with him; but as the persons through whom he claimed, and for the purpose of giving the defendant specific notice of his claim, so that it might, if it had a defence as to some one of the assignors through whom he claimed, have an opportunity to make it (Record, pp. 3, 4, 5, 6, 7, 8, 9, 10, 11 and 12).

While the several assignors were not, during their respective ownership in the invention, so interested with each other as to enable them to join in a suit with each other for their own benefit and use against the defendant, when they assigned their rights of action for past infringements to Mr. Philbrook, then all their several rights merged in him, and what in their possession had been several and distinct rights, in him became a single cause of action against the defendant for his own use and benefit. This right he could only enforce in the courts of the United States, as the Federal courts have exclusive jurisdiction over the subject matter of the suit. He, as the only party in interest, brought suit in his own name, and joined all parties who had held title to the patent during the period of its infringement. By so doing, I submit he complied with the rules of law in relation to suits by assignees.

When the defendant pleaded to the merits of the suit, it admitted the capacity of the plaintiffs to sue in manner and form as they had declared.

Childress v. *Emory*, 8 Wheat., 642.
Kane v. *Paul*, 14 Pet., 33.
The Society for the Propagation of the Gospel in Foreign Parts v. *The Town of Pawlet and Ozias Clarke*, 4 Pet., 480.

B.

That Mr. Philbrook could maintain an action in the name of a person who held title at some period of the infringement is admitted.

Hayward v. *Andrews*, 106 U. S., pp. 224, 130.

But the ruling of the Court that, for such period as a person, who became his assignor, held title, the suit must be brought in said person's name, and that he, as assignee, after the patent had expired, and he held the entire title for all past infringements, could not bring an action and join with himself such person as co-plaintiff, or proceed alone in his own name, stating the source of his title imposed, an unreasonable requirement.

In *Pritchard* v. *Norton*, 106 U. S., 424, 130, Mr. Justice MATHEWS, delivering the opinion of this Court, said—

> "Whether an assignee of a *chose in action* shall sue in his own name or that of his assignor, is a technical question of mere process, and determinable by the law of the forum."

What is the *lex fori* in a case where a suit, after the expiration of a patent, is instituted to recover for infringement during the term of its existence? The federal courts have exclusive jurisdiction of such a suit, and the rule that has been observed in federal courts in actions where the state courts have a concurrent jurisdiction can have no application in such a suit.

Mr. Justice BRADLEY, speaking for this court in *Guarantee & Indemnity Co.* v. *Water Co.*, 107 U. S., on page 214, said,—

> "We have lately decided, after full consideration of the authorities, that an assignee of a *chose of action* on which a complete and adequate remedy exists at law cannot, merely because as such assignee his interest is an equitable one, bring a suit in equity for the recovery of the demand.
>
> *Hayward* v. *Andrews*, 106 U. S., 672.
>
> "He must bring an action at law in the name of the assignor to his own use. This is true of all legal demands standing in the name of a trustee, and held for the benefit of a *cestui que trust*."

In *May* v. *County of Logan*, 30 Fed. Rep., 250, JACKSON, J., said,—

> "Under the Ohio Code of Procedure, an assignee of a '*chose of action*,' being the real party

> in interest, may sue in his or her own name without joining the assignor."

The above-quoted language indicates that the assignee may be plaintiff even when he joins his assignors with him, as was done in the case now under consideration.

Did Mr. Philbrook by his writ and declaration do more than sue and declare in the name of all the assignors who had conveyed their title in the invention to Campbell through whom he claimed, for his own benefit?

If not, then he should have been allowed to proceed with the trial, in the name of all the assignors named in his writ and declaration. The entire declaration when read discloses Mr. Philbrook's interest in the suit, and also that he instituted it for his own use and benefit as trustee, but in the name of all persons who held title to the patent during its legal existence, and through whom he held his title to the *chose in action* in suit.

C.

It is true, that by the laws of Massachusetts, the assignee of a *chose in action* must sue in the name of his assignor; but I most respectfully urge for the consideration of this court, that the provisions of section 914 of the Revised Statutes of the United States are not applicable to the case at bar.

This section provides that—

> "The practice, pleadings, and forms, and modes of proceeding in civil causes, other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms, and modes of proceeding existing at the time in like causes in the courts of record of the State within which such circuit or district courts are held, any rule of court to the contrary notwithstanding."

The above-quoted section contains words of restriction, which I deem very important in consideration of the peculiar circumstances attached to suits for the infringement of patents.

The words "existing at the time in like causes in the courts of the State," limit the effect of that section to suits within the jurisdiction of State courts. The exclusive jurisdiction over suits to recover for infringements being in the Federal courts, "like causes" cannot exist in the courts of the State, and therefore the words of restriction used in the statute withdraws the practice, pleadings and forms, and mode of proceeding from suits over which the State courts have no jurisdiction.

The *lex fori* in this suit must be found in the Federal courts untrammelled by rules of procedure in vogue in the State courts.

The remedy for the infringement of patents is exclusively within the jurisdiction of the Federal courts, and therefore, under the provisions of section 914, the practice, forms, pleading, and proceedings in the State courts cannot be invoked to control proceedings in suits for infringements based on patents granted by the United States.

D.

An examination of the pleadings in the suit at bar discloses issues not within the jurisdiction of the State courts.

In *Sanford* v. *Portsmouth*, 6 Central Law Journal, 148, BROWN, J., said,—

> "We are required by the act of 1872, Revised Statutes, section 914, to conform our practice, pleadings, and forms and modes of proceedings only 'as near as may be' to those of the State court, or, as the Supreme Court has expressed it, 'as near as may be practicable.' This leaves the act to a certain extent mandatory or directory, and vests in this Court a limited discretion to reject methods of procedure which are inconsistent with the established and well-recognized usages of the Federal courts.
>
> As observed by the Supreme Court in *The Indianapolis & St. L. R. R. Co.* v. *Horst*, 93 U. S., 301, this indefiniteness may have been suggested for a purpose. It devolved upon the judges to be affected the duty of construing and deciding, and gave them the power to reject, as Congress undoubtedly expected they would do, any subordinate provisions in such State statutes which, in their judgment, would unwisely encumber the administration of the law, or tend to defeat the ends of justice in their tribunals. This discretion had been repeatedly recognized."

I also cite in this connection—

Tobey v. *Claflin et al.*, 2 Wall. 389.
Nudd v. *Burrows*, 91 U. S. 426.
Erstein v. *Rothschild*, 22 Fed. Rep. 61, 64.

Mr. Justice MATTHEWS, in *Erstein* v. *Rothschild*, 22 Fed. Rep. 61, 64, in considering Section 914, said :

> "The purpose of this provision, as was said in *Nudd* v. *Burrows*, 91 U. S. 426, 441, was to bring about uniformity in the law of procedure in the Federal and State Courts of the same locality, having reference to the Code enactments of many of the States ; yet, as was said in *Indianapolis & St. L. R. R. Co.* v. *Horst*, 93 U. S. 291, 300, 'the conformity is required to be' as near as may be, 'not as near as may be possible, or as near as may be practicable.' . . . .
>
> "The act of congress, at any rate, does not require the adoption with the local statute of the local interpretation which may have been put upon them, or which may from time to time be enforced. It must be held that the body of the local law thus adopted in the general, must be construed in the courts of the United States in the light of their own system of jurisprudence, as defined by their own constitution as tribunals, and of other acts of Congress on the same subject. It can hardly be supposed that it was the intent of this legislation to place the courts of the United States in each State, in reference to their own practice and procedure, upon the footing merely of subordinate State courts, required to look from time to time to the Supreme Court of the State for authoritative rules for their guidance in those details."

By SEC. 1., c. 167, p. 964, Pub. St. of Massachusetts, it is provided that there shall be only three divisions of personal actions. The second division is as follows :

> "Actions of tort shall include those heretofore know as actions of trespass, trespass on the case, trover, and all other actions for penalties."

This division, I submit, can only apply in the Federal courts when the subject matter of the suit is one within the concurrent jurisdiction of the State court, and the practice of the Federal court in this particular has not been provided for by the rules of the Federal courts or by congressional action.

In the case now under consideration, Congress has by Section 4919, Revised Statutes of the United States, provided for such an action as Mr. Philbrook brought against the defendant :

> "Damages for infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee."

With this provision for suits to recover damages for infringements, the State forms of pleading and practice are not applicable. The rules of State practice and State laws in relation thereto cannot in this case be invoked, as Congress has prescribed the practice and the form of action in such cases.

I now submit that the courts of Massachusetts have no jurisdiction in causes like the one now under consideration, and it may well devolve upon this Court to direct by its opinion in this case the course of pleading, forms, and proceedings in this and similar suits.

That the Federal courts are not bound to a blind adherence to forms of practice in the State courts is evident from the authorities cited. That the words "in like causes" relate to the subject matter of the suit, and not the mere name of the action. The State court may have jurisdiction in a suit for trespass on the case when the subject matter of the suit is within its jurisdiction; but when the subject matter of the suit is such that the State court cannot exercise jurisdiction in the premises, then it is a *cause unlike causes in the courts of record in the State*, and section 914, Revised Statutes of the United States, is not applicable to it. The purpose of section 914, as was said in *Nudd* v. *Burrows, supra*, was to bring about uniformity in the law of procedure in the Federal and State coarts of the same locality.

That is, it was intended by this provision that the practice in actions that could be tried in a State or Federal court, over which both courts might entertain jurisdiction, should be the same.

But the reason for that uniformity in the law of procedure ceased when the subject matter of the suit was not within the jurisdiction of the State courts, and, *a fortiori*, when Congress has provided by section 4919, Revised Statutes of the United States, a form of action in suits for infringements. *Cessante ratione legis cessat ipsa lex.*

It will be observed, on inspection of the writ, that suit was brought within six years after the expiration of the patent, and the declaration filed four days before the Federal statute of limitations contained in the patent act of July 9, 1870, had expired (Record, p. 3); and if Mr. Philbrook could not include the rights of the owners of the patent which had been assigned to him for infringements prior to the repeal of the United States statute of limitations by act of July 22d, 1874, then he has no remedy during that period of time, as the six years since the expiration of the patent have long since elapsed.

And now, in concluding my first point, I most respectfully submit, that the Circuit Court erred in ruling that the action could not be maintained, and that Mr. Philbrook could not sue in the name of all the assignors, but only in the name of the party, or parties, who held the entire title to the patent in suit for the time being.

Second Point.

I now come to a very important question, one that has not as yet been passed upon by this court, and it arises under the second and third assignments of error (Record, pp. 41, 42).

A.

I shall endeavor to demonstrate by argument sustained by authority that it was error in the Circuit Court to instruct the jury in these words:

> "The court has settled this question of law which arose here, and it is decided that the statute of limitations of the Commonwealth of Massachusetts is a defence to this suit, as all claims for damages by the plaintiff are limited to infringements which took place more than six years before the commencement of this suit; therefore you will return a verdict for the defendant."

This ruling was based on the opinion of Circuit Judge Lowell, of the First Circuit, in *Hayden* v. *The Oriental Mills*, 15 Fed. Rep. 605, who, commenting upon the numerous decisions which hold that the State statute of limitations has no application to patent rights, said,—

> "No reason is given in any decision for excepting one class of cases out of section 721. Some argument upon the general question has been made which we shall revert to. There is no such exception in the statute itself, and none in its intent and purpose. Exclusive jurisdiction is given to reasons which are apart from this question. For instance, in patent cases the Federal courts have this control in order that the construction of the law and of the patents granted under it may be as nearly uniform as possible, not that the remedies of a patent shall be of uniform duration."

Equity is a uniform system in the Federal courts throughout the United States, but the remedies are barred in those courts by the State statute of limitations in certain cases. I wish to invite attention of this court to the fact that in no instance has a patent suit in equity been controlled by a State statute of limitations, and that the statute can legally be applied only in cases in which the State court has concurrent jurisdiction with the Federal courts.

The statute of limitations affects the remedy to be pursued in the State court, and, under section 721, cases which may be removed from the State to the Federal courts would be governed by the provisions of that section; but when the State court has no jurisdiction, its remedies cannot be enforced in relation to causes over which State courts have no jurisdiction.

But the learned judge, proceeding in his opinion, said,—

> "Suppose Congress chooses to give assignees in bankruptcy or national banks an exclusive right to sue in the courts of the United States,

> can any one maintain that their debtors have no protection by the lapse of time unless a special statute of limitations is passed by the national authority?"

Here the learned judge bases his interrogatory upon an exclusive personal right supposed to be given to a certain class of persons, irrespective of the subject matter of the suit.

I think that inquiry can be answered in the negative, as the nature of the suit must govern, and the giving a class of individuals an exclusive right to select a forum when the State has jurisdiction of such controversies between all other persons, would not deprive a defendant of the right to invoke the State statute of limitations, and I submit that such supposed legislation would be against public policy and constitutional law.

And the learned judge, in his opinion, also said,—

> "This theory of the dependence of section 721 upon concurrent jurisdiction seems to be an echo of the rule that courts of equity, and perhaps even courts of admiralty, are bound by the State statutes of limitations in cases of concurrent jurisdiction; but it is not concurrent jurisdiction of the State courts, but that of courts of common law, State or national, which decides the point. Besides, what is the concurrent jurisdiction? There are very few cases in which the jurisdiction is really concurrent. In nearly all, the defendant has an absolute and conclusive right to make the jurisdiction of the Federal courts exclusive by a removal of the cause."

What did the learned judge mean by saying, "It is not concurrent jurisdiction of the State courts, but that of courts of common law, which decides the point"?

In order that common law courts may entertain jurisdiction, the subject matter of the suit must be such as can be tried as a common law action in a common law court. The courts of Massachusetts are common law courts, deriving their source of common law jurisdiction from the mother country.

The Federal courts are not common law courts only so far as the Constitution and Congress have conferred jurisdiction in accordance with the common law upon them, and the common law can be made a part of the Federal system only by legislative adoption.

Wheaton v. *Peters*, 8 Pet. 591.

By section 721 of the Revised Staules of the United States it is provided that—

> "The laws of the several states, except where the Constitution, treaties, or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law in the courts of the United States in cases where they apply."

By section 4919 Revised Statutes of the United States, Congress has provided for suits to recover damages on account of infringement of patents. This certainly takes such suits out of the provisions of section 721.

The learned judge, in his opinion, said:

> "There are very few cases in which the jurisdiction is really concurrent. In nearly all the defendant has an absolute and conclusive right to make the jurisdiction of the Federal courts exclusive by a removal of the cause."

If the State court had not jurisdiction over the subject matter, how could it take and retain jurisdiction of it until removed? The removal in most instances is made to depend on diverse citizenship, and the defendant may, under the statutes for removal, remove a cause from a State court to a Federal court; but in order to remove a cause it must be pending in a court of competent jurisdiction.

The theory of removal is such, that in a case of improper removal the cause must be remanded to the State court if the supposed jurisdictional question upon which the removal was granted, on inspection is found not to exist: then the State court resumes jurisdiction at the point where its control of the suit was interrupted; therefore, in order to remove a cause from a State to a Federal court, the subject matter of the suit must be such as to confer jurisdiction on both the State and Federal Courts, and it is a necessary sequence that the State and Federal courts have concurrent jurisdiction over the subject matter of the suit.

The jurisdiction of a court can never depend upon its decision upon the merits of a case brought before it but upon its right to hear and decide it at all.

Ex-parte Watkins, 7 Pet. 568.

The State and Federal courts have concurrent jurisdiction over all actions known to the common law, when it became the law of the several States, whenever proper parties in relation to citizenship exist. The jurisdiction of the Federal courts is not made to depend alone on the subject matter of the suit, but in most instances upon the citizenship of the parties to it.

Article 3 of the Constitution of the United States, section 2, in relation to civil action, is as follows:—

> "The judicial powers shall extend to all Cases in Law and Equity arising under this Constitution, the law of the United States and Treaties made or which shall be made under their authority; to all Cases affecting Ambassadors, other public Ministers, and Consuls; to all Cases of Admiralty and maritime jurisdiction; to Controversies between two or more States; between a State and Citizens of another State; between Citizens of different States; between Citizens of the same State claiming lands under Grants of different States, and between a State, or the Citizens thereof, and foreign States, Citizens, or subjects. In all Cases affecting Ambassadors, other public Ministers, and Consuls, and those in which a State shall be party, the Supreme Court shall have original Jurisdiction. In all the other Cases before mentioned, the Supreme Court shall have appellate Jurisdiction, both as to Law and Fact, with such Exceptions and under such Regulations as the Congress shall make."

The jurisdiction of the Federal courts is made to depend on the amount in controversy. In actions at common law the amount involved must exceed two thousand dollars in order to remove a cause from a State Court when the necessary diversity of citizenship exists, and only when suits involving that sum are pending in a State court is removable possible; therefore the statement that "there are few cases in which the jurisdiction is really concurrent is without foundation in law. In nearly all the defendant has an absolute and exclusive right to make the jurisdiction of the Federal courts, exclusive by a removal of the cause," is not warranted, when the condition precedent for jurisdiction in the Federal courts, is taken into consideration. I submit that very few of the great number of cases litigated in the courts of Massachusetts are subject to removal into the Federal courts for that district.

The late Mr. Justice MILLER, in his lectures on Constitutional Law, on page 331, Miller on the Constitution of the United States, said,—

> "We now come to controversies between citizens of different States. Here is, as has turned out, the largest source of the jurisdiction of the Federal courts.
>
> "In the previous part of this section the right to sue in the Federal courts was granted in any action arising under the constitutional laws and treaties of the United States without regard to the citizenship or residence of the parties thereto; but here it is the character of the party which gives the right to sue without reference to the nature of the matter at issue.
>
> "A class of persons is here designated who can bring suits in the Federal courts, no matter what may be the cause of action."

While it is true that a statute of limitations is the law of the forum, and operates upon all who submit themselves to its jurisdiction, it does not follow that matters not cognizable by the State courts are a part of that law, as the law of the forum is, bestowed upon the courts of the State in relation to matters within their jurisdiction, and cannot be construed to extend to suits over which the State courts have no jurisdiction. The fact that the courts of the United States, in the absence of legislation upon the subject by Congress, recognize the statutes of limitation of the several States, and give them the same construction and effect as given by the local tribanals, does not make such statutes applicable to suits over which the local tribunals have no jurisdiction, because, for want of jurisdiction over the subject matter of the suit, the tribunals are powerless to give the State statutes of limitation any effect in relation to it. The State statutes of limitation undoubtedly apply to that class of suitors mentioned by Mr. Justice **Miller** whenever a controversy arises between citizens of different states.

By the 4th paragraph sec. 1, c. 197, p. 1115, Pub. Stat., of Massachusetts, "all actions of tort except those hereinafter mentioned, shall be commenced within six years next after the cause of action accrued, and not otherwise." By the division of actions in Massachusetts, actions of tort only include actions heretofore known as actions of trespass, trespass on the case, trover, and all actions for penalties. The words "heretofore known" must, I submit, be held to mean actions heretofore known in Massachusetts. I do not suppose it will be claimed that actions on the case to recover for infringements were referred to by these words.

In *McClung* v. *Silliman*, 3 Pet. 270, Mr. Justice **McLean**, speaking for this court in construing the Statute of Limitations of Ohio, said,—

> "Where the statute is not restricted to particular causes of action, but provides that the action by its technical denomination shall be barred if not brought within a limited time, every cause for which the action may be prosecuted is within the statute. If the statute required the action of debt for rent to be brought within six years from the time the cause of action arose, the bar could extend to no other action of debt. But if the statute

> provided that all actions of debt should be prosecuted within six years, then it would operate against the action for whatever cause it was brought."

The above decision makes it clear that the statute bar has no application beyond its express terms of limitation, and those cases in which it may be invoked are such as come within the jurisdiction of the common law of the State.

But actions for damages based upon the infringement of a patent are within the jurisdiction of the Federal courts, differing from common law actions, and not dependent upon a sum in controversy in order to confer jurisdiction.

The proceedings and pleadings in such suits have been provided for by sections 4919, 4920, Revised Statutes of the United States, and are not made conformable to State practice.

This is a remedy afforded by an act of Congress, to be enforced only in the courts of the United States, and therefore I submit that State statutes of limitation cannot affect it.

Mr. Chief Justice FULLER, in *City of New Orleans* v. *Louisiana Construction Company*, 129 U. S., 45, 47, in speaking for this Court, said,—

> "The rule is thoroughly settled that remedies in the courts of the United States are at common law or in equity, according to the essential character of the case, uncontrolled in that particular by the practice of the State courts."

In the year 1624 (21 James I.), it was enacted by the Parliament of England that all actions of account, and all actions on the case other than such accounts as concern the trade of merchandise between merchant and merchant, or actions of debt for rent due, should be commenced and sued within six years next after the cause of such actions should accrue.

The above in nearly all of its essentials, coupled with Lord Tenterden's act of 1828, has been widely adopted in the United States. The statute of limitations applies only to such remedies as are enumerated and to be affected by it, and cannot by force of construction be extended to causes of action not included in its enumeration and over which State courts have no jurisdiction.

Mr. Justice Swayne in *Hauenstein* v. *Lynham*, 10 Otto, 483, in the opinion of the court, said,—

> “The provision as to time in the earlier treaty is in effect a statute of limitations. It applied with procrustean sameness in all the States and in all the cantons. In the latter treaty this limitation was dropped and the time was to be such ‘as the law of the State or canton would permit.’ In other words, it was left to the laws of the several States and cantons respectively to fix the limitation in this as in other cases. This was consonant to the policy of our judiciary act of 1789, 1 Stat. at Large, which gave to the State statutes of limitations the same effect in the local courts of the United States which they had in the courts of States respectively that enacted them. The procrustean uniformity prescribed by the former treaty was thus abandoned, and it is fair to presume that the harmonious results in this respect which must

> necessarily follow everywhere within the territory covered by the treaty, both at home and abroad, were the considerations by which those who made the change were animated. If a State or canton had a law which imposed a limitation in this class of cases, nothing more was necessary. If it had not such a law, it was competent to enact one, and until one exists there can be no bar arising from the lapse of time. A party entitled can sue whenever he chooses to do so, and he is clothed with all the rights of any other litigant asserting a claim where there is no statute of limitation applicable to the case."

Tho only statute that has ever existed applicable to the case now under consideration was limited to the 1st of December, 1873; by the Act of June 22, 1874, and since then, the rule stated by Mr. Justice SWAYNE, that "a party entitled can sue whenever he chooses to do so," applies, and, therefore, the Circuit Court should not have directed a verdict for the defendant on the ground that the suit was barred by the State statute of limitations.

The State statute of limitations affects the remedy to be sought in the State courts, and depends upon its courts for enforcement. It has no force outside of the territory of Massachusetts, and within that territory is limited to actions within the jurisdiction of its courts. The courts of the Commonwealth of Massachusetts are powerless in a case like the one now under consideration to enforce the rights of the plaintiff, even if suit should be brought in one hour after the infringement; yet it is contended, in the opinion in *Hayden v. Oriental Mills, supra*, that the State can pass a law limiting the time when suit may be brought in such a case. The statutes of limitations differ, as to time, in the various States of the Union, and the several States have power to make the period of limitation as long or short as they see fit.

If some States of the Union should be opposed to the protection given to patentees, and desire to have some patented implements or machines go into use without liability on the part of its citizens for infringement, it could enact a statute of limitations restricting the right to sue for such infringements to twenty-four hours after each and every act of infringement, making each use of the patented machine a distinct and separate cause of action, and by so doing destroy the grant which the United States had bestowed as an award for inventive genius.

Is it within the province of State legislature to pass a law the effect of which will be to deprive a holder of a patent of any benefit in it?

Can a State by its legislative power enact laws to be enforced in the Federal Courts when its own courts cannot enforce such laws?

Can the States by legislative enactment destroy the grants of the United States when the construction as to the scope of such grants rests exclusively in the courts of the United States? If not, then the State statutes of limitations have no application to suits on the law side of the Circuit Courts brought to recover damages for infringement of patents.

With all due respect for the learned judge who drew the opinion in *Hayden v. Oriental Mills, supra*, for whom I entertain the highest esteem, I am constrained to urge that the reasons given by him in favor of allowing State statutes of limitation as a bar to suits for damages for infringement of patents, brought under the provisions of sections 4919, 4920, do not support the proposition for which he contended.

B.

I now invite this court to a consideration of the authorities in support of my contention that the State statute of limitations of Massachusetts was not applicable to the case at bar when before the Circuit Court of the United States for the district of Massachusetts.

The 2 Banning & Arden Patent Cases, page 195, contains an opinion by Circuit Judge SHEPLEY in *Anthony* v. *Carroll*, delivered in the district of Massachusetts in December, 1875, in which he said,—

> "The defendant has demurred generally to this bill, and in support of his demurrer relies upon the bar of the statute of limitations of the Commonwealth of Massachusetts, and also upon the character of the claim alleged in the bill. The limitation in cases of tort in this Commonwealth is six years (Gen. Stat. of Mass. c. 197, sec. 1).
>
> "As a general rule, the laws of the State in which a national court sits must be the rule of decision in such court. The thirty-fourth section of the judiciary act provided that the laws of the several States, except when the Constitution, treaties or statutes of the United States shall otherwise require or provide, shall be regarded as rules of decisions in trials at common law in the courts of the United States in cases where they apply.
>
> "It is too well settled to require the citation of authorities that, in ordinary actions at common law, the statute of limitations of the State where the suit is brought

may be pleaded in bar under this provision of the judiciary act. The question presented is whether this rule applies to actions the subject matter of which is now under exclusive control of the national legislature and judiciary. Mr. Justice SWAYNE held, in the case of *Collins* v. *Peebles*, 2 Fish. 541, that the State statutes could not limit the time in which actions for the infringement of letters patent might be brought in courts of the United States; that, Congress having failed to legislate upon this subject, there was no limit to the time for bringing such actions; and Mr. Justice GRIER is reported in a note to the above case, 2 Fish. 543, to have so decided in the case of *Parker* v. *Halleck*. To the same effect is the decision in *Read* v. *Miller*, 3 Fish. 310. In the case of *Parker* v. *Hawk*, 2 Fish. 58, the learned judge of the southern district of Ohio decided that the limitation act of Ohio applied to an action on the case in the Circuit Court of the United States for an infringement of a patent. It is stated, in a note to that, that the decision was affirmed by Mr. Justice McLEAN. *Parker* v. *Hawk* was decided on the authority of *McClung* v. *Silliman*, 3 Pet. 270. But *McClung* v. *Silliman* is by no means decisive of the question. That was an action on the case against the defendant as register of a land office in Ohio for nonfeasance in refusing, at the request of the plaintiff, to enter his application for the purchase of certain government lands as required by an act of Congress. Such an action against an officer for nonfeasance could have been prosecuted in the State as well as the Federal courts. The cause of the action was one over which the national and State courts had concurrent jurisdiction. Such a case clearly falls within the provisions of the judiciary act. It is one of the cases where the laws of the State apply. But how can it be contended that the laws of the State apply to an action for the infringement of a patent, when the right of an action is exclusively under the Constitution and laws of the United States, when the form of the remedy is prescribed by Congress, and when the Circuit Courts of the United States are clothed by the statute with exclusive jurisdiction over the whole subject matter? Should the legislature of a State pass an act in express terms limiting the time for bringing an action in the Federal courts for infringement of patent rights, there can be no reasonable doubt that such a statute would be unconstitutional and void. The policy of the government to provide a uniform system of rights and remedies throughout the United States upon the whole subject matter of patents for new and useful inventions and discoveries, by placing it under the control of congress and the Federal courts, would be frustrated if such State legislation could directly or indirectly limit, restrict, or take away the remedy. For these reasons I think no State statutes of limitations can be pleaded in bar to this action."

Mr. Justice HARLAN, in *Sayles v. Lake Shore & Michigan Southern Ry. Co.*, 9 Fed. Rep. 515, decided, purely upon the weight of authority, that the State statute of limitations of Illinois of February 4, 1849, had no application.

In *Sayles v. Dubuque & Sioux City R. Co.*, 9 Fed. Rep. 516, DILLON and LOWE concurring, said,—

> "We are of the opinion that a State statute of limitations has no application to suits in respect of the rights granted by letters patents for inventions.

In *Hayward et al. v. City of St. Louis et al.*, 11 Fed. Rep., 427, TREAT, D. J., said :

> "The defendant pleads the statute of the State which requires suit to be brought within five years from the date of cause of action accrued. That State statute does not apply, iuasmuch as Congress had fixed the date in patent cases whereof the Federal government has exclusive jurisdiction."

In *Wood v. Cleveland Rolling Mills Co.*, 4 Ban. & A., 550, on page 556, tried before Mr. Justice SWAYNE and SHERMAN, J., Mr. Justice SWAYNE, in the opinion of the Court, says :

> "When these suits were commenced there was no act of Congress limiting the time within which a suit must be prosecuted either at law or in equity for the infringement of a patent. The act of 1870 does not affect them."

In *May v. County of Logan*, 30 Fed. Rep., 250, heard by Circuit Judge JAACKSON and District Judge WALKER, JACKSON, C. J., in the opinion of the Court, in considering the State statute of limitations pleaded as a bar to the suit, said :

> "Counsel for defendants, however, rely chiefly upon the statute of limitation of the State of Ohio, which bars suits for tort in six years after cause of action accrued. But, as a Federal

statute of limitations in force and applicable to the present suits, or the cause, of action they are brought to enforce, it is clear, under the authorities, that the State statute cannot be invoked to displace the Federal statute, or shorten the period of limitations prescribed by the latter. If there was no national statute of limitation applicable to plaintiff's case, this Court would still hold that the State statute of limitations would not constitute a bar to the suit. The Supreme Court of the United States has not directly and in an authoritative way passed upon this question, as to whether the State statute of limitations can be interposed as a bar to suits for the infringement of patents; but the point has been often presented in the United States Circuit Courts, and, while the decisions of those courts are in conflict on the question, the decided weight of authority and reason is against the proposition that the State statute of limitations can be successfully interposed as a defense in such suits."

"It is not deemed necessary to review the cases on this subject, which is discussed in the valuable work of Walker on Patents, section 477, and some of the conflicting decisions cited in notes. Instead of four decisions (as stated by Walker) favoring the proposition that the State statute of limitations may be interposed as a defense in such actions, there are five cases to that effect, as follows: *Parker* v. *Hawk*, 2 Fish. Pat. Cas., 59, decided in 1857 by Judge LEAVITT; *Parker* v. *Hall*, 2 Fish. Pat. Cas., 62, note (decided by Judges MCLEAN and LEAVITT shortly afser decision in *Parker* v. *Hawk*); *Rich* v. *Ricketts*, 7 Blatchf. (decided by Judge HALL in 1870); *Sayles* v. *Oregon Cent. Ry. Co.*, 6 Sawy., 31 (decided by Judge Deady in 1879); and *Hayden* v. *Oriental Mills*, 15 Fed. Rep. 605 (decided in 1883 by Judge Lowell).

“In support of the contrary proposition, there may be cited ten decisions, instead of six, as follows:

“*Collins* v. *Peebles*, 2 Fish. Pat. Cas. 541 (decided by Justice Swayne in 1865);
“*Parker* v. *Halleck*, 2 Fish. Pat. Cas. 543 (by Justice Grier in Pennsylvania);
“*Read* v. *Miller*, 6 Biss. 12 (by Judge McDonald in 1867);
“*Wetherell* v. *New Jersey*, 1 Ban. & A. 105 (by Judge McKennan in 1874);
“*Anthony* v. *Carroll*, 2 Ban. & A. 195 (by Judge Shepley in 1875);
“*Sayles* v. *Lake Shore & M. S. Ry. Co.*, 9 Fed. Rep. 515 (by Mr. Justice Harlan in 1879);
“*Sayles* v. *Dubuque & S. C. Ry. Co.*, 9 Fed. Rep. 516 (by Judges Dillon and Love in 1879);
“*Hayward* v. *City of St. Louis*, 11 Fed. Rep. 427 (by Judge Treat in 1882);
“*Wood* v. *Cleveland Rolling-mill*, 4 Fish. Pat. Cas. 550 (by Judges Swayne and Sherman in 1871);
May v. *County of Fond du Lac*, 27 Fed. Rep. 691 (July 6, 1886, by Judge Dyer).

“In addition to these authorities, this Court has on two occasions had this question before it, and, after full consideration of the subject and a careful review of the decisions, reached the conclusion that State statutes of limitation have no application to actions arising out of infringement of a patent, even in the absence of a Federal statute of limitations on the subject.

"Subsequent reflection and examination have only served to confirm this view of the question. The process and procedure acts of Congress, as embodied in section 34 of the Judiciary Act of 1789, and in section 721, Rev. St., which seem to have controlled the opinions to the contrary, have their full operation when applied and confined to civil actions or suits at common law, in which there is concurrent jurisdiction in the State and Federal Courts."

"Letters patent, together with the rights of action and remedies given for the infringement of the same, are matters under the exclusive control of the Federal legislature and Federal judiciary."

"In *Schreiber* v. *Sharpless*, 17 Fed. Rep. 589, Judges McKENNAN and BUTLER had occasion to consider section 721, Revised Statutes, in its application to an action for the penalty provided by section 4965, Revised Statutes, for infringement of a copyright, which in most respects stands upon the same footing as patent rights, and they hold that said section refers to cases where the Federal Courts obtain jurisdiction by reason of the citizenship of the parties, and has no application to those cases in which the jurisdiction of the court arises out of the cause of action, and consequently involves rights over which the State legislature can exercise no authority except in so far as the same may relate to the method of proceeding and practice."

In *McGinnis* v. *Erie County*, 45 Fed. Rep. 91, before McKENNAN and ACHESON, JJ., *Per Curiam*:

Held, that State statute of limitations have no application to patent cases by virtue of section 721 of the Revised Statutes of the United States.

In *California Artificial Stone Paving Co.* v. *Starr, et al.*, 48 Fed. Rep., 560, Hawley, J., said:

> "This is a suit at law to recover damages for alleged infringement of a patent. Defendants, in their answer, plead the statute of limitations of the State of California. Plaintiff demurs to this portion of the answer, and also moves to strike out the plea setting up the statute of limitations. The judiciary act provides that the Circuit Court shall have original jurisdiction 'of all suits at law or in equity arising under the patent or copyright laws of the United States.' Revised States U. S., sec. 629, subsec. 9. It also provides that the laws of the several States, except where the Constitution, treatise or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law in the courts of the United States in cases where they apply.' Revised Statutes U. S., sec. 721. Under this section is the State statute of limitations applicable to patent cases? This question, it seems, has never been decided by the Supreme Court of the United States. There are, however, numerous decisions in the several circuit courts, but they are not uniform upon the subject. The greater number of the decided cases, and in my opinion the weight of reason, is to the effect that the State statutes have no application to such cases.

In *Read* v. *Miller*, 2 Biss. 14, McDonald, J., said:

“The Constitution of the United States has given to the national government exclusive control of the whole subject matter of patent rights for new and useful inventions. No State, therefore, can pass any valid law concerning them. It is not any state law, or even the common law, that authorizes the action under consideration. It is given by the Act of Congress of July 4, 1836. And this act, as I construe it, gives the United States Circuit Courts exclusive jurisdiction over the whole subject matter. No State court can adjudicate upon the question of a violation of a patent right. Questions touching these rights may incidentally arise in the State courts, and be decided by them. But, I repeat, no State court can try a case like the one now under consideration. The policy of the national government in thus putting the whole subject matter for new and useful improvements and inventions under the control of Congress and the United States courts, evidently was to provide a uniform rule concerning the same throughout the United States, so that patentees shall everywhere have the same rights and the same remedies. And this is eminently proper, for the whole subject is not one of local, but of national, concern. But no such policy is deducible from section 34 of the judiciary act. Indeed, that section plainly indicates a contrary policy, for, in regard to the matters which it embraces, it destroys the uniformity of the rules of decision in the national courts, and requires them to conform to the laws of the respective States, however various and contradictory those laws may be. Since then no State has any power to legislate concerning patent rights, and no State court has jurisdiction to adjudicate concerning a violation of them, it can hardly be supposed that a State may nevertheless pass statutes of limitation concerning them which shall control National Courts concerning their infringement. It ought not to be presumed that the State legislature, in passing a statute of limitations, ever intended it to extend to patent-right litigations, since such litigation cannot arise in a State Court. Nor ought the presumption to be indulged that section 34 of the Judiciary Act could have been intended to authorize State legislatures to pass statutes of limitation on subjects over which the States have no control. Moreover, it should be noted that section 34 of the Judiciary Act only makes the laws of the several States rules of decision in the National Courts 'in cases where they apply.' Now it appears to me that these State laws do not apply in cases over which the State governments have no control whatever, and which are under the exclusive control of the general government."

In *Brickell et al.* v. *City of Buffalo et al.*, 49 Fed. Rep., 371, Coxe, D. J., said,—

"The only question argued is whether the State statute of limitations applies to actions for the infringement of patents. This question has been examined now, as well as on former occasions, with the result that, in my judgment, the weight of precedent and reason is in favor of the proposition that the State statutes do not apply."

In *Brickell et al.* v. *City of Hartford et al.*, 49 Fed. Rep., 372, Shipman, D. J., said,—

"That as the subject of Letters Patent, and

> authorizing actions to be brought for the protection of rights thus created, is wholly without State control, the general statute of limitations of a State does not, *ex proprio vigore*, apply thereto, and not applying, is not made a rule of decision governing the United States Courts by the provisions of section 721."

In *May v. Buchanan Co.*, 29 Fed. Rep., 469, SHIRAS, J., on page 470, said,—

> "The petition avers more than one act of infringement, and as to those committed after June 22, 1874, the question is whether the action to recover for these is or is not subject to the limitation of the State statute. This question has not been finally settled by the Supreme Court of the United States, and the decisions of the Circuit Court are not in harmony.
>
> "See Walker on Patents, section 477, where the cases are cited and commented upon.
>
> "Where, as in this case, the action is based upon the rights conferred by the statute of the United States, then the better rule seems to be that the State statute of limitations, *ex proprio vigore*, does not apply. The right to a patent, and to exclusive use of the rights conferred thereby, is wholly of Federal creation, and the State cannot either extend or limit the time within which an action for the protection of these rights may be brought under the Federal statutes.
>
> "It is, however, within the power of Congress to declare that actions brought under the provisions of the United States laws shall be subject to the limitations enacted in State statutes and make the same applicable to actions for the enforcement or protection of rights

wholly created by Federal legislation, and of which actions jurisdiction is exclusively in the Federal Courts.

* * * * *

"But the laws of the State cannot constitute rules of decision binding and obligatory upon courts of the United States in matters or rights which are wholly without State control and wholly within Federal control, and the true construction of section 721, therefore, is that it makes applicable as rules of decisions in the Federal courts those laws of the States which, dealing with subjects within State control, create and define rights in or to property, and provide the mode of protecting or enforcing these rights.

"When the State legislature adopted a State statute of limitations, it was intended to apply to proceedings brought to enforce causes of action cognizable in the courts of the State; and when the cause of action lies without the jurisdiction of the State, then the State statute of limitations cannot be made applicable thereto by any declaration, express or implied, of the State legislature.

"If the laws of congress on the subject of patents were repealed, there would not exist any right to a patent; or, in other words, the inventor would not have any enforceable right of property in his invention, or the fruits thereof. This right of property is created by the acts of congress, and State legislation does not deal therewith. Thus, it is clear that the State legislature could not legally enact that none of its citizens should apply for and obtain a patent for an invention, unless he should apply for the same within six months, or any other time; and

> the right to protect the property created by the patent laws, by bringing an action at law or in equity, conferred by the act of Congress, cannot be limited or affected by State legislation. When, therefore, the State adopted its statute of limitations, it did not have the right, nor can it be supposed that it was the intent of the legislature to attempt, to limit the time within which actions might be brought, under the provisions of the act of Congress, for the protection of the patent rights created by the laws of the United States. To make the State statute of limitations, therefore, applicable to an action to recover damages for an infringement of a patent, it must appear that Congress has, by law, adopted and made applicable the State statute; and this is not the effect of section 721, if the view expressed of that section is correct, to-wit, that it includes only the laws of the State which deal with subjects within State control."

In *May* v. *Cass Co.*, 30 Fed. Rep., 762, SHIRAS, J., said,—

> "This action is brought to recover damages for infringement of a patent. The demurrer presents two questions: (1) Is the action barred by the lapse of five years, under the provisions of the statute of Iowa? * * * Upon the first question it is held that the State statute of limitations is not applicable to the class of actions for infringement of patent rights."

Mr. Justice BREWER, then Circuit Judge, and Judge LOVE concurred with Judge SHIRAS.

In *Wells* v. *Graves*, 41 Fed. Rep., 458, SHIRAS, J., said,—

> "The question of when and under what circumstances the State statute of limitations is available as a defense in actions in the courts of the United States was considered by this court in *May* v. *County of Buchanan*, 29 Fed. Rep. 469, and the conclusion therein reached is, it seems to me, decisive of the present case. When the cause of action is created by a statute of the United States, the provisions of the State statute of limitations do not apply thereto, unless Congress has so declared."

The last case bearing upon the State statutes of limitations and their application to suits for infringements is the case of *Brickell* v. *The City of Baltimore*, 52 Fed. Rep 737, Morris, J.; and while the court held that the statute of the State did not apply, Judge Morris, in his opinion, among other things, said :—

> "This question of the applicability of the statute of limitations of the several States to actions for infringement of patents has been frequently raised in the Circuit Court of the United States, and has been variously decided. There has as yet been no authoritive decision by any appellate court. In the present condition of the adjudications on this question eminent judges and careful text writers have declared that the weight of judicial opinion is that the State statutes are not applicable, and it has been so held in the Circuit Court of the United States for the district of Connecticut, in a case now pending there, for infringement on this same patent, between the plaintiffs and the City of Hartford, 49 Fed. Rep. 372. The question has been fully argued before me, and I have been

> assisted by the briefs of counsel, and particularly by the unusually able and exhaustive brief filed by the counsel who then represented the City of Baltimore; but, in view of that fact that the question has been already so often passed upon and discussed by the Circuit Court, it would be useless to enter into a discussion of the authorities. The settlement of the question must wait for its authoritative decision by an appellate tribunal. I am free to say, however, that I find myself unable to concur in the reasoning by which the decisions adverse to the applicability of the State statutes are sustained. There are, it is quite true, many reasons why Congress should enact a statute of limitations expressly applicable to this peculiar character of property; but this of itself is no reason why, in the absence of such legislation, suits rising out of patents should not be governed by the same rules as govern similar actions."

The last case, while it falls in with the weight of authority on this question, follows the reasoning of BILLINGS, District Judge, in *Copp* v. *Louisville & N. Ry. Co.*, 50 Fed. Rep. 164. The opinions in these last-mentioned cases fail to grapple with or answer the reasoning stated in the numerous decisions of the Circuit Court cited in my brief in support of my contention, and, I most respectfully submit, fail to disclose a comprehension of the line of demarcation between causes at common law and actions created by the United States, and for which it has provided a special remedy and designated the pleadings applicable thereto. Judge Billings in his citations failed to cite a single authority in point. The first cited is that of *Hanger* v. *Abbott*, 6 Wall., 532. This was an action of assumpsit, in which J. & E. Abbott of New Hampshire were plaintiffs, and Hanger defendant, in the Circuit Court. The latter pleaded the statute of limitation of Arkansas, which limits such actions to three years. This was a common law action, over which the State courts had jurisdiction, and, by reason of the diversity of citizenship existing between the parties, the Federal courts for the district of Arkansas also had jurisdiction.

And I have yet to learn of an authority emanating from a Federal court which holds, that in actions over which the Federal and State courts have concurrent jurisdiction, that the State statute of limitations was not applicable to such actions. The next case cited is that of *Townsend* v. *Jennison*, 9 How., 414. This case decided nothing more than that statutes of limitation which affect the remedy are laws of the forum only; consequently a statute of limitations of a foreign country or another State where the contract was made cannot be pleaded in bar. This seems to be quite foreign from the question involved.

The case of *McIver et al., Lessees*, v. *Ragan, et al.*, 2 Wheat., 25, cited by Judge Billings, was an action of ejectment brought in the Circuit Court of the United States for the district of West Tennessee, for five thousand acres of land in possession of defendant Ragan. It is obvious that this was a case over which the Federal and State courts had concurrent jurisdiction.

The case of *McCluney* v. *Silliman*, 3 Pet., 270, cited in the case of *Copp* v. *Louisville & N. Ry. Co., supra*, has already been commented on in extracts from opinions contained in my brief, and I only desire to repeat that it was an action over which the Federal and State courts had concurrent jurisdiction.

The case of *Michigan Ins. Bank* v. *Eldred*, 130 U. S., 693, was one of concurrent jurisdiction in the Federal and State courts, and in such cases there is no contention against the application of State statutes of limitations.

The case of *Ross et al.* v. *James S. Duval*, *et al.*, 13 Pet., 45. This case came before the court on the question of the State statutes of limitation in its application to a writ of *scire facias*, which was issued on a judgment on the 10th of January, 1822, and which was never returned. No other execution was issued on the judgment until the 11th of August, 1836. A *capias ad satisfaciendum* was then sued out and executed on the body of Ross, who gave up property in discharge of his body, and entered into a bond with King as surety for the forthcoming of the property on the day and at the place of sale. This bond was forfeited, and the court gave judgment for the plaintiff for the amount of the bond. Mr. Justice MacLean in the opinion of the court held that the Act of 1826 passed by the State of Virginia was applicable to the case, and said:

> "If the plaintiffs in the Circuit Court had brought an action of debt, or issued a *scire facias* on the original judgment, or issued an execution [an execution having been issued within the year of the rendition of the judgment, but not returned] within ten years from the passage of the Act of 1826, they would not have been barred if they could have shown that up to the passage of that act they were within the saving clause of the act of 1792."

This act of 1792 applied to non-residents. The defendants failing to bring themselves within the saving clause, the Court held the statute of limitations to apply. The action was one over which both the Federal and State courts at the time when brought (1821), in which defendants in error, as plaintiffs in the Circuit Court, alleged that they were citizens of Pennsylvania, had jurisdiction. This case only adds one more authority to the well-established rule that the laws of a State are rules of decision in cases in which the Federal courts held in such State have concurrent jurisdiction with the State Courts.

The cases cited by Judge Morris, in *Brickell* v. *The City of Baltimore*, in addition to those cited by Judge Billings in *Copp* v. *Railway Co.*, *supra*, are as follows: *Bank* v. *Dalton*, 9 How., 522. The facts in this case are these: On the 7th of February, 1843, the president and directors of the Bank of the State of Alabama recovered a judgment against Robert H. Dalton for $1,844, with interests and costs, in the County Court of Tuscaloosa County and State of Alabama. On the 24th of February, 1844, the State of Mississippi passed an act which provided, amongst other things, that judgment rendered before the passage of the act in any other State of the Union should be barred unless suit was brought thereon within two years from the passage of the act. On the 10th of November, 1846, the president and directors of the bank brought a suit against Dalton in the District Court of the United States for the Northern District of Mississippi. It was an action of debt brought upon the judgment recovered in the court of Alabama. The writ was served on Dalton the same day it was issued. The defendant pleaded the statute of limitations of Mississippi; the plaintiff filed a replication to defendant's plea. Defendant demurred; the Court sustained the demurrer, and this Court affirmed the judgment. It was a case of concurrent jurisdiction, and the *lex fori* governed.

The case of *Leffingwell* v. *Warren*, 2 Black., 599–606, was an action of ejectment in the court below, instituted by Warren, the defendant in error. Judgment was entered in his favor. The land in controversy had been sold for taxes and a tax deed given. The statute of limitations was invoked, and Mr. Justice Swayne, when the case came into this Court on writ of error, said:

> "The courts of the United States, in the absence of legislation upon the subject of congress, recognizes the statute of limitations of the several States, and give them the same construction and effect which are given by the local tribunals. They are a rule of decision under the 34th section of the Judiciary Act of September 24, 1789, c. 20 (1 Stat. at L., 73)."

This action related to real estate, and was a common law action over which the Federal court had concurrent jurisdiction with the State court.

In the case of *Amy* v. *Dubuque*, 98 U. S., 470, the plaintiff in error brought suit in the Circuit Court of the United States for the District of Iowa, upon certain bonds for the instalments of interest represented by certain undetached coupons. A demurrer to the declaration was sustained on the ground that the statute of limitations had run against the coupons. The plaintiff thereupon sued out his writ of error. This was a common law action, and the Federal court had jurisdiction by reason of diverse citizenship concurrent with the State court, and therefore the *lex fori* governed as to the State statute of limitations.

The cases of *Vance* v. *Campbell et al.*, 1 Black, 427, and *Hausshuecht* v. *Claybrook*, 1 Black, 431, relate solely to rules of evidence prescribed by the laws of the State in all civil cases at common law not within the exception therein mentioned.

The principle of construction upon which these two cases rested is stated in section 858, Revised Statutes of the United States, in these words:

> "In the courts of the United States no witness shall be excluded in any action on account of color, or in any civil action because he is a party to or interested in the issue tried; provided, that in actions by or against executors, administrators, or guardians, in which judgment may be rendered for or against them, neither party shall be allowed to testify against the other as to any transaction with or statement by the testator, intestate, or ward, unless called to testify thereto by the opposite party, or required to testify thereto by the court. In all other respects the laws of the State in which the court is held shall be the rules of decision as to competency of witnesses in the courts of the United States in trials at common law and in equity and admiralty."

The only case in point supporting the reasons stated in his opinion, city by Judge Morris in *Brickell* v. *Baltimore, supra*, is that of *Hayden* v. *Oriental Mills*, 15 Fed., Rep., 605; and as to that case, I have heretofore said all that I desire concerning it.

I now come to an authority, which I submit, in concluding my discussion on this branch of the case, namely,—

Wood on Limitations, sec. 40*a*, c. 3, vol. 1, p. 94, is as follows:

> "*Patents, Application of Statutes to.*—The question whether the statute of limitations in several States apply to actions for the infringement of patents has never been decided by the Supreme Court of the United States, and the question has been variously decided in the different circuits (5).
>
> "The great weight of authority is to the effect that such statutes do not apply (6), and, in my judgment, this is the correct doctrine. At the common law no protection whatever is afforded to an inventor. The right and the remedy are both created by statute and given by act of Congress. Not only does the act provide what the remedy shall be, but it also gives exclusive jurisdiction over that remedy to the circuit courts; and no action for the infringement of the rights secured by letters patent can be maintained in the State courts or in any other court than the Circuit Court, as provided in the act. The rule which applies when there is a concurrent jurisdiction has no application, and it is quite evident that these statutes were never intended to be applied except to common law remedies and remedies which could be enforced in the State courts, and over which those courts had jurisdiction. It is preposterous to suppose that State legislatures would attempt even to limit or control a right given by congress and upon which congress itself has imposed no limitations. That it was not

intended by Congress that statutes of limitations should apply to actions for the infringement of patents is evident from the fact that the act passed by Congress limiting the time within which such actions should be brought was very soon afterwards repealed. Where a right is created by statute, and has no existence except as a creation of the statute, and a specific and exclusive remedy is given therefor, it is regarded as a specialty, and, in any event, if the State statute should be held applicable to this class of actions, it would only be subject to the statute which applies to specialty obligations: and in most of the States it is held that the statute of limitations has no application to actions predicated upon a statute, unless it is specially so provided (1)."

"REFERENCE NOTE TO SECTION 40*a*.

"(5) In the following cases it has been held to apply: *Parker* v. *Hawkes*, 2 Fish. Pat. Cas. 58; *Hayden* v. *Oriental Mills*, 15 Fed. Rep. 605; *Rich* v. *Ricketts*, 7 Blatch. (U. S. C. C.), 230; *Sayles* v. *Railroad Co.*, 6 Sawyer (U. S. C. C.), 31.

"(6) *May* v. *Buchanan*, 29 Fed. Rep. 469; *Wood* v. *Cleveland Rolling Mills*, 4 Fish. 550; *Collins* v. *Peebles*, 2 id. 541; *Parker* v. *Hallock*, 2 id. 543; *Witherill* v. *New Jersey*, 1 B. & A. (U. S. C. C.), 105; *Reed* v. *Miller*, 2 Biss. (U. S. C. C.), 12; *May* v. *Co. of Rails* 31 Fed. Rep. 473; *May* v. *Cass Co.*, 30 id. 762; *Sayles* v. *Louisville & C., R. R. Co.*, 9 id. 515; *May* v. *Buchanan Co.*, 29 id. 469; *Hayward* v. *St. Louis*, 11 id. 427; *May* v. *Fond du Lac*, 27 id. 691; *McGinnis* v. *Erie Co.*, 45 Fed. Rep. 91; *May* v. *Cass Co.*, 30 id. 762; *Witherill* v. *Zinc Co.*, 1 B. & A. (U. S. C. C.), 485.

"(1) See *ante*, p. 55, sec. 19, and notes thereto. See also sec. 36, p. 90; also secs. 38, 39, pp. 91-93, and authorities cited."

THIRD.

And now, in conclusion, I respectfully submit, that the reasons urged and the authorities cited, fully sustain the propositions for which I contend; and that the judgment of the Circuit Court should be reversed, and the cause remanded, with directions to set aside the verdict and award a new trial.

HARVEY D. HADLOCK,
Counsel for Plaintiff in Error.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1894.

No. 87.

CHRISTOPHER C. CAMPBELL,
Plaintiff in Error,
v.
THE CITY OF HAVERHILL,
Defendant in Error.

BRIEF FOR DEFENDANT.

FREDERICK P. FISH,
W. K. RICHARDSON,
of Counsel.

Supreme Court of the United States,

OCTOBER TERM, 1894.

No. 87.

CHRISTOPHER C. CAMPBELL,
PLAINTIFF IN ERROR.
v.
THE CITY OF HAVERHILL,
DEFENDANT IN ERROR.

BRIEF FOR DEFENDANT.

STATEMENT OF THE CASE.

This case comes before this court upon writ of error to the Circuit Court of the United States for the District of Massachusetts. The action was begun by writ dated May 20, 1887, and is an action of trespass on the case (p. 3) to recover damages for the alleged infringement by the defendant of patent to James Knibbs, No. 42,920, which was granted May 24, 1864, and expired on May 24, 1881.

The declaration, in which eight persons were joined as plaintiffs, sets out the issue of the patent, upon the application of Knibbs, to James Knibbs and Marcus P. Norton, assignee, and the various subsequent assignments of interests in the patent, and alleges infringement during the term of the patent by the manufacture and use, by the fire department of the defendant city, of the patented invention in steam fire-engine pumps.

The answer makes a general denial, sets up prior use by a large number of persons, and especially pleads the statute of limitations in paragraph 4: "And for further answer the defendant says, that the cause of action mentioned in the plaintiff's declaration did not accrue within six years before the suing out of the plaintiff's writ."

As appears by the bill of exceptions (p. 15), the court ruled at the trial that the action could be maintained only in the name of such parties as held the entire title to the patent for the time being; whereas the writ and declaration had joined as plaintiffs all the successive owners of the patent or of any interest therein. "And thereupon, by leave of court, the plaintiff discontinued as to all the plaintiffs named in his writ except Campbell."

After putting in the various instruments of title, the plaintiff's counsel stated (p. 16) that "*no claim for damages is made in behalf of said Campbell after the 20th of December*, 1880," — this being just six years and five months before the action was commenced.

"The defendant then asked the court to direct a verdict for the defendant on the ground that the action is barred by the statute of limitations of the commonwealth of Massachusetts," which sets a limit of six years for beginning actions of tort; and the court upon this ground directed a verdict for the defendant, to which instruction the plaintiff excepted.

It is upon this exception that the case comes before this court, and thus a pure question of law is involved; namely, *is an action on the case brought in a circuit court of the United States to recover damages for infringement of letters patent barred by a state statute of limitations applying to actions upon the case?*

[The ruling of the court on the joinder of successive owners of the patent is also assigned as error; we shall touch upon this briefly at the close of the brief.]

SHORT SUMMARY OF DEFENDANT'S ARGUMENT.

Revised Statutes of the United States, sec. 721 (sec. 34 of the Judiciary act of 1789), provides that —

> **"The laws of the several states, except where the Constitution, treaties, or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in the courts of the United States, in cases where they apply."**

Defendant contends that, under this provision, the Massachusetts statute of limitations was clearly a bar to the action, and that the court, therefore, was right in directing the jury to return a verdict for defendant.

The Massachusetts statute of limitations applies to an "action on the case," like the present action. This point will not be disputed.

Such being the case, it would seem that only three questions arise under Rev. Stat. sec. 721:

1. *Is such a statute of limitations included in the phrase "the laws of the several states"?*

There can be no doubt on this point; for this court has constantly held that the state statutes of limitations are "laws of the several states" which are to be regarded as "rules of decision" by the United States courts.

2. *Do the Constitution, treaties, or statutes of the United States "otherwise require or provide"?*

It will be conceded that they do not; and in this connection we shall call attention to the fact, as bearing upon the decision of the case, that, if the state statute be not applied, there is no limitation whatever to actions at law for infringement of patents.

3. *Is this "a trial at common law in the courts of the United States, in a case where the state statute applies"?*

This point also is clear; for this is an action at common law, and it is an action on the case, to which form of action the state statute applies; and several decisions of this court hold that state statutes are to be enforced, under section 721, in actions for infringement of patents like the present action.

Although we regard the point under discussion as directly settled by this court, we shall, for the sake of completeness, further proceed to discuss the conflicting decisions of the circuit courts, and show what we believe to be the error of the reasoning by which some of the circuit judges have arrived at a contrary conclusion. So far as appears, the earlier cases at least were very inadequately presented.

ACTION ON THE CASE FOR INFRINGEMENT.

We will consider first the form of the present action; then the Massachusetts statute.

While it was doubtless in the power of Congress to provide some peculiar statutory remedy for the infringement of patents, it has not done so, but has left the owner of a patent, who desires to bring an action at law, to the common law remedy for this class of injuries, namely, an action of trespass on the case.

The earlier acts of February 21, 1793, sec. 5, and April 17, 1800, sec. 3, which provide for the payment of a forfeiture by way of damages for infringement of a patent, say that the sum may be recovered "by action on the case founded on this act:" the act of July 4, 1836, sec. 14, provides that the actual damages "may be recovered by action on the case;" and the act of July 8, 1870, sec. 59, provides that "damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States," etc.; and such is the provision of Rev. Stat. sec. 4919.

Now the action on the case is the old common law action which was appropriate to recover damages for the infringement of a patent, irrespective of any statute. 1 Chitty on Pleading, 142, says, "Case is in general the remedy for disturbing a party in the enjoyment of an easement. . . . It lies for disturbance, obstruction, or other injuries to offices, *franchises*, ferries, markets, or tolls," etc.; and, on page 139, "*Case lies . . . for the infringement of a patent.*"

The statute of monopolies, 21 Jac. 1, c. 3, of May 25, 1624, did away with the jurisdiction of the Star Chamber, and provided that all matters concerning letters patent, etc., "ought to be, and shall be forever hereafter, examined, heard, tried, and determined *by and according to the common laws of this realm*, and not otherwise." (Webster, Pat. Cas. 30.) There was no provision in the statute as to what the form of action should be; but it has been held by all the English authorities that action on the case was the obvious form. So Godson on Patents (p. 237) says, "When the king has granted a patent for the sole use of any invention, *the common law* gives a right of action against every person who infringes it. It is in form an action on the case."

So, also, Webster on Patents (p. 28) says, —

"*The action is in form an action on the case for damages*, and may be maintained by any person having a legal interest in the patent."

Goodeve's "Abstract of Patent Cases" contains a number of eighteenth century "*actions on the case*" for infringement of patents (pp. 4, 122, 217, 315).

The whole matter is well treated by Robinson on Patents (sec. 931), who points out that, after the act of James I., infringement of a patent "being a tort involving consequential damage only to the patentee, the form of action applicable to it was trespass on the case, through which, from that time to the present, the injured party has pursued his remedy at law."

Therefore the form of action pursued in the case now before the court is the old common law remedy for infringement of a patent, and not a peculiar form of remedy originated by any act of Congress.

THE STATUTE OF LIMITATIONS OF MASSACHUSETTS APPLIES TO ACTIONS ON THE CASE.

It will not be disputed that the statute of limitations of Massachusetts relied on by defendant in this case applies to actions on the case.

The Public Statutes of Massachusetts of 1882, c. 167, sec. 1 (the same provision being in General Statutes of 1860, c. 129, sec. 1), provide:

"There shall be only three divisions of personal actions:

"*First.* Actions of contract, which shall include those heretofore known as actions of assumpsit, covenant, and debt, except for penalties.

"*Second.* Actions of tort, which shall include those heretofore known as actions of trespass, *trespass on the case*, trover, and all actions for penalties."

"*Third.* Actions of replevin."

Pub. Stat. c. 197, sec. 1 (the provision being repeated from Gen. Stat. c. 155, sec. 1), provides:

"The following actions shall be commenced within six years next after the cause of the action accrues, and not afterwards. . . ."

"*Fourth. All actions of tort* except those hereinafter mentioned."

[The only actions of tort thereafter mentioned are actions against sheriffs for misconduct of their deputies, actions for assault, for false imprisonment, for slander and libel, and actions of trover against certain fiduciary officers.]

Of these statutes, the courts, on established principles, take judicial notice.

Fourth National Bank v. *Franklin*, 120 U.S. 747, 751.
Hanley v. *Donoghue*, 116 U.S. 1, 6.
Lamar v. *Micou*, 114 U.S. 218, 223.

A recent case where this court applied the Massachusetts statute to an action of tort is —

Bates v. *Preble*, 151 U.S. 149, 158.

Clearly, therefore, by the statutes of Massachusetts, any action of trespass on the case is barred by six years' lapse of time. The only question to be argued is whether *this* action upon the case is removed from the operation of the statute by the fact that it is brought for the infringement of United States letters patent; and we will proceed to show that Revised Statutes, section 721, renders it obligatory upon the United States courts to apply the state statutes of limitations in an action like the present.

WHAT IS MEANT BY "THE LAWS OF THE SEVERAL STATES," IN REV. STAT. SEC. 721?

Nothing is better settled than that this expression refers *pre-eminently* to state statutes of limitations: and such statutes have been applied by this court under the provisions of section 721 in cases too numerous to cite fully.

In *Bauserman* v. *Blunt*, 147 U.S. 647, 652, this court, in an opinion by Mr. Justice GRAY, applies the statute of limitations of Kansas to an action on a promissory note, and says, after quoting section 721,—

> **"No laws of the several states have been more steadfastly or more often recognized by this court from the beginning as rules of decision in the courts of the United States than statutes of limitations on actions real and personal, as enacted by the legislature of a state, and as construed by its highest court."**

To this point *eighteen* previous decisions by this court are cited, and many of them commented upon at length. This statement is repeated and affirmed in—

Balkam v. *Woodstock Iron Company*, 154 U.S. 177, 187.

So, also, in *Michigan Bank* v. *Eldred*, 130 U.S. 693, the action was by a Michigan corporation against a citizen of Wisconsin in the Circuit Court of Wisconsin, upon a judgment recovered ten years before in a state court in Michigan. It was held that the statute of limitations of Wisconsin was applicable, but upon the facts that the action had been commenced in time.

The court said, in an opinion by Mr. Justice GRAY (p. 696), —

> "But it has been settled by a series of decisions of this court that statutes of limitations, even in personal actions, including actions on judgments, were '*laws of the several states*' which, except where the Constitution, treaties, or statutes of the United States otherwise required or provided, must, under the Judiciary act of September 24, 1789, c. 20, sec. 34, 'be regarded as rules of decisions in trials at common law in the courts of the United States in cases where they apply.' 1 Stat. 92; Rev. Stat. sec. 721; *Beatty* v. *Burnes*, 8 Cranch, 98; *McCluny* v. *Silliman*, 3 Pet. 270, *Alabama Bank* v. *Dalton*, 9 How. 522; *Bacon* v. *Howard*, 20 How. 22; *Amy* v. *Dubuque*, 98 U.S. 470. *Statutes of limitation of personal actions are laws affecting remedies only, and not rights*, as is clearly shown by the decisions that the only statutes of limitations applicable to such an action are the statutes of the state where the action is brought, and not those of the state where the cause of action arose. *McElmoyle* v. *Cohen*, 13 Pet. 312; *Townsend* v. *Jemison*, 9 How. 407; *Walsh* v. *Mayer*, 111 U.S. 31. *It was thus established that statutes of limitations of the state governed personal actions in the courts of the United States. Otherwise, in the absence of congressional legislation, there would be no limitation of the time of bringing any personal action in a court of the United States.*"

In the case of *Leffingwell* v. *Warren*, 2 Black, 599, 603, this court said, —

"The courts of the United States, *in the absence of* *legislation upon the subject by Congress*, recognize the statutes of limitations of the several states, and give them the same construction and effect which are given by the local tribunals. They are a rule of decision under the 34th section of the Judiciary act of 1789."

See, to the same effect, —

Amy v. *Dubuque*, 98 U.S. 470.
Davie v. *Briggs*, 97 U.S. 628, 637.
Ross v. *Duval*, 13 Pet. 45.
Bell v. *Morrison*, 1 Pet. 351, 360.

In *Sayles* v. *R.F. & P. R.R. Co.*, 4 Ban. & Ard. 239, it is well said, —

"The 34th section of the Judiciary act of 1789 is the only general statute of limitations known in federal legislation. Congress virtually adopted the statute of limitations of each state as the limitation of actions brought in the United States courts held in that state."

The statutes of the states relating to rules of evidence constitute another class of "laws of the several states," which have been applied under this section by this court (including patent cases, as we show below, p. 19).

In *Conn. Life Insurance Co.* v. *Union Trust Co.*, 112 U.S. 250, 255, the Supreme Court, by Mr. Justice HARLAN, in applying the New York statute forbidding a physician to disclose information acquired by him professionally, said that the Circuit Court was required to enforce the New York statute; and, after quoting section 721, said, citing previous decisions, —

"*This has uniformly been construed as requiring the courts of the Union in the trial of all civil cases at common law not within the exceptions named to observe as rules of decision* *the rules of evidence prescribed by the laws of the states in which such courts are held.*"

See, to the same effect, —

Potter v. *National Bank*, 102 U.S. 163–165.
Ryan v. *Bindley*, 1 Wall. 66–68.
McNeil v. *Holbrook*, 12 Pet. 84.
Sims v. *Hundley*, 6 How. 1–6.

It may therefore be regarded as well settled, that among "the laws of the several states," which are to be "rules of decision" in the courts of the United States, are statutes of limitations, as also statutes concerning evidence and other state statutes.

"EXCEPT WHERE THE CONSTITUTION, TREATIES OR STATUTES OF THE UNITED STATES OTHERWISE REQUIRE OR PROVIDE."

It will not be contended that the Constitution, treaties, or statutes of the United States "otherwise provide" in this case.

1. There is nothing *unconstitutional* in reasonable statutes of limitation, as has been frequently held by this court (see *Terry* v. *Anderson*, 95 U.S. 628).

2. Nor is it "otherwise provided" in this case by any *statute* of the United States, for no congressional statute of limitations governing such actions has been in force since 1874.

Congress, in the year 1870, passed a statute of limitations governing such actions (act of July 8, 1870, sec. 55), providing that —

> "All actions shall be brought during the term for which the letters patent shall be granted or extended, or within six years after the expiration thereof."

This is the only statute of limitations relating to patent suits that has ever appeared in the statutes of the United States.

This act was uncertain in meaning, and also very unsatisfactory in that it made the limitation dependent upon the term of the patent instead of the time of the act of infringement, and thus the action might be brought many years after the alleged wrong. The statute was omitted in the revision of 1874, without any explanation; and inasmuch as the Rev. Stat. sec. 5596, repealed the act of 1870, there has been no statute of limitations as to actions on patents since June 22, 1874, unless the state statutes are to be applied.

It is well settled that, under section 721, the state statute of limitations applies unless Congress has made an *express* provision.

In *McCluny* v. *Silliman*, 3 Pet. 270, 277, this court says, —

> "Under this statute, the acts of limitations of the several states, *where no special provision has been made by Congress*, form a rule of decision in the courts of the United States, and the same effect is given to them as is given in the state courts."

Similarly, in *Barney* v. *Oelrichs*, 138 U.S. 529, 530, this court made it plain that the state statute of limitations governed an action against the collector of the port to recover duties paid under protest during a period when there was no national statute of limitations governing such actions.

Conversely, in *Potter* v. *National Bank*, 102 U.S. 163–

165, the rules of evidence prescribed by the state law were held not binding, because the statutes of the United States "otherwise provided," by *expressly* forbidding the exclusion of a witness upon the ground that he is a party to the case.

In the case at bar, the statutes of the United States do not "otherwise provide," and, consequently, the state statute of limitations is applicable.

In this connection, it may be noticed that Congress undoubtedly believed that when the limitation imposed upon actions for infringement of patents by the act of 1870 was repealed, the state statutes would again be applicable. It cannot be reasonably supposed that it was intended to have the right to bring an action on a patent subject to no limitation of time whatever.

Plaintiff's brief (p. 55) quotes a text-book *dictum*, that the fact that Congress repealed the *national* statute of limitations shows that it did not intend to have *state* statutes apply. It seems to us more reasonable to suppose the exact contrary to have been the intention of Congress.

IT IS A REASON FOR APPLYING THE STATE STATUTE OF LIMITATIONS THAT NO OTHER LIMITATION EXISTS.

Under the decisions of this court, it is a material consideration that if the state statute of limitations does not apply, there is no statute of limitations to bar an action at law in patent causes, and such an action may therefore be brought after any lapse of time, no matter how long; for a court of law has no such power as a court of equity to refuse to entertain a case upon the ground of laches, and, in the absence of a statute of limitations, the action, whenever brought, must be entertained.

Now it is well-settled law that statutes of limitations are statutes of repose, and are favored by the courts; and it will be a material consideration in guiding the judgment of this court, that if the state statute of limitations is not applicable, there is no statute of limitations at all to govern this class of actions.

In *Adams* v. *Woods*, 2 Cranch, 336, 342, the opinion by Chief Justice MARSHALL said, upon the question of applying a certain statute of limitations, —

> "In expounding this law, it deserves some consideration that if it does not limit actions of debt for penalties, *those actions might in many cases be brought at any distance of time. This would be utterly repugnant to the genius of our laws.* In a country where not even treason can be prosecuted after a lapse of three years, it could scarcely be supposed that an individual would remain forever liable to a pecuniary forfeiture."

So, also, in *Bell* v. *Morrison*, 1 Pet. 351, 360, Mr. Justice STORY, in delivering the opinion of this court, said, —

> "It has often been matter of regret in modern times that, in the construction of the statute of limitations, the decisions had not proceeded upon principles better adapted to carry into effect the real objects of the statute; that, instead of being viewed in an unfavorable light, as an unjust and discreditable defence, it had received such support as would have made it what it was intended to be, emphatically a statute of repose. *It is a wise and beneficial law, not designed merely to raise a presumption of payment of a just debt from lapse of time, but to afford security against stale demands after the true state of the transaction may have been forgotten, or be incapable of explanation by reason of the death or removal of witnesses.* It has manifest tendency to produce speedy settlements of accounts, and to suppress those prejudices which may arise up at a distance of time and baffle every honest effort to counteract or overcome them. . . .
> (P. 362:) It may be that in this manner an honest debt

may sometimes be lost, but many unfounded recoveries will be prevented; and, viewing the statute in the same light in which it was viewed by English judges at an early period, as a beneficial law on which the security of all men depends, we think its provisions ought not to be lightly overturned, and that no creditor has a right to complain of a strict construction, since it is only by his own fault and laches that it can be brought to bear injuriously upon him."

In *Hawkins* v. *Barney's Lessee*, 5 Pet. 457, this court held that the statute of limitations of seven years passed by Kentucky was not in violation of the compact between Kentucky and Virginia, providing that "all private rights and interests in lands within the said district shall remain valid and secure under the laws of the proposed state" [of Kentucky].

The court set forth most strongly the benefit of such statutes.

In *Lewis* v. *Marshall*, 5 Pet. 470, 477, this court said, in an opinion by Mr. Justice McLean, —

> "*Statutes of limitations have been emphatically and justly denominated statutes of repose. The best interests of society require that causes of action should not be deferred an unreasonable time.*"

In *Leffingwell* v. *Warren*, 2 Black, 599, 606, this court said, —

> "Statutes of limitation are now regarded favorably in all courts of justice. They are 'statutes of repose.' Usually they are founded in a wise and salutary policy, and promote the ends of justice."

In *Shepherd* v. *Thompson*, 122 U.S. 231, this court, in holding that a promissory note was not taken out of the statute of limitations by a certain writing subsequently signed by the maker, as not being an express promise to pay or an express acknowledgment of the debt as still existing, cited the earlier cases, and said, —

> "The principles of law by which this case is to be governed are clearly settled by a series of decisions of this court. The statute of limitations is to be upheld and enforced, not as resting only on a presumption of payment from lapse of time, but according to its intent and object as a statute of repose."

It is clear, therefore, that this court looks favorably upon statutes of limitations, and will endeavor to interpret the law so as to avoid the anomaly of allowing an action at law for an infringement of letters patent to be brought after the lapse of any period.

The facts of the case at bar are instructive as to the need of a statute of limitations. Philbrook, who brings this suit, never had any interest in the Knibbs patent during its life. He received an assignment of the right to damages on May 20, 1884, three years after the patent expired, on trust to collect damages from all the cities he could, and divide the proceeds among certain backers. (Record, pp. 39, 40.)

Accordingly he brought suit on May 20, 1887, against defendant and *eleven other cities of Massachusetts* (plaintiff's brief, p. 4). The patent had expired on May 24, 1881, and, furthermore, the defendant city had been using fire engines containing the alleged invention since *May, 1864*. (Record, p. 15.)

And now this association to exploit the Knibbs patent, long after its end, claims that it may bring suits against the defendant and every other town and city now or at any future time, and recover damages for infringement of a patent which *expired* in 1881, on the ground that there is no limitation whatever to an action of this class.

"IN TRIALS AT COMMON LAW, IN THE COURTS OF THE UNITED STATES, IN CASES WHERE THEY APPLY."

We have now shown that the state statutes of limitations (as also the rules of evidence) are pre-eminently included under the expression "laws of the several states," in section 721; and that in this case the Constitution, treaties, and statutes of the United States do not "otherwise require or provide." So far as this case is concerned, the statute may be read as if it expressly provided — "the statutes of limitations and the statutes regulating evidence of the several states shall be regarded as rules of decision in trials at common law in the courts of the United States in cases where they apply."

The present action is "a trial at common law in the courts of the United States;" and, under the language of section 721, there would seem no doubt that the Massachusetts statute of limitations must prevail, for it plainly "applies" to actions of trespass on the case, like that at bar.

The argument that the state statute is not to form a rule of decision because the action is founded "upon a right granted by the United States" (which is the only substantial argument heretofore advanced upon that side of the question), seems to us wholly inadmissible, as we more fully show hereafter. There is nothing whatever in the language of section 721 to suggest that an exception is to be made of such trials at common law in the United States courts as are founded upon some right granted by the federal government; and if there were any doubt as to the meaning of the language of this section, the intention of Congress must obviously have been to provide for the enforcement of state statutes of limitation in *all cases* where Congress had not chosen to provide a federal statute.

Our contention is that the appropriate state statute furnishes a rule of decision in any common law action in the United States courts, upon whatsoever right it may be grounded, if Congress has not passed a statute of limitations governing that action. The contention of our opponent is that there is *no* statute of limitations applicable to any action arising upon a right granted by Congress, if Congress has not chosen to provide a special statute of limitations governing such actions.

It seems to us plain that the former interpretation of the statute is the only permissible one, and that the language of the statute is plain. It unquestionably provides that the state statutes shall be rules of decision "in trials at common law," *not a certain class of trials, but all trials.*

The words "in cases where they apply" do not make any exception of actions arising under letters patent or any other right granted by the United States. The force of these words can best be seen by examples.

For instance, a state passes a statute of limitations providing that all actions of contract shall be brought within a certain period. In a trial at common law in the United States courts, the question is whether the action is an action of contract within the meaning of the state statute. If it is, it is a case where the statute "applies." So, also, in an action on the case for the infringement of letters patent. The question is whether the statute of limitations of the state where the action is brought applies to an action on the case. If it does, the statute is to be a rule of decision.

Most of the early arguments upon this question were hasty presentations upon demurrer; and it seems not to have been brought to the attention of the circuit courts that *this ques-*

tion has been definitely settled by several decisions by this court.

In *Vance* v. *Campbell*, 1 Black, 427, an action at law was brought in 1859 for the infringement of letters patent, the statute relating to such action being the same as it has always been since the act of 1836. The plaintiff was offered as a witness, and was objected to as incompetent, under the old rule of the common law excluding parties from testifying. His testimony, however, was made competent by *a statute of Ohio*, where the suit was brought. The court below refused to allow the party to testify. This court, in an unanimous opinion by Mr. Justice NELSON, held, —

> **"The thirty-fourth section of the Judiciary act provides that the laws of the several states, with the exceptions there stated, shall be regarded as rules of decision in trials at common law in the courts of the United States. This section has been construed to include the rules of evidence prescribed by the laws of the state in all civil cases at common law not within the exceptions therein mentioned."**

Plaintiff's exceptions were therefore sustained and judgment reversed.

The case of *Haussknecht* v. *Claypool*, 1 Black, 431, is to the same effect. The plaintiff brought "trespass on the case" against defendants in 1859, for an infringement of his patent. The facts were as in the preceding case, and the court reached the same conclusion.

The report contains a brief summary of defendant's brief, in which this language appears:

"Is an action for the infringement of rights secured by a patent, in which the pleadings are specifically regulated by the act of Congress, a case to which the provisions of the Ohio code necessarily apply?" —

thus showing that the point that this was an action on a patent was expressly presented to the court.

So, also, in the case of *Wright* v. *Bales*, 2 Black, 535, the action was trespass on the case for infringement of a patent. Here, also, the plaintiff was rejected as an incompetent witness, because of interest in the case. This court, in a full opinion by Mr. Justice WAYNE, held that the statute of Ohio, making the parties competent, applied. The court said, —

> "The rejection of Wright, then, as a witness, for incompetency to testify in his own behalf, raises again in this court the question whether the statutory enactments of the states of the Union, in respect to evidence in cases at common law, are not obligatory upon judges in the courts of the United States to apply them as rules of decision in the trials of such cases."

The court then cited the 34th section of the Judiciary act, and held that, under *McNeil* v. *Holbrook* and *Simms* v. *Hundley* (cited *supra*, p. 11), the rules of evidence prescribed by the statute of the state were to be followed by the courts of the United States; and they therefore sustained the plaintiff's exceptions.

These decisions were cited and approved by this court in 112 U.S. 255, and 102 U.S. 165; and from the time of these decisions to this day it has never been questioned that, under section 721, the laws of evidence of the state should be applied in the trial of an action on the case for infringement of letters patent.

These decisions directly determine that the laws of the several states, where the Constitution or statutes of the United States do not "otherwise provide," are rules of decision in actions at law for infringement of letters patent. That is the express point which they decide, and, to sustain plaintiff's position in this case, these three decisions would have to be overruled.

These three actions were brought under the same laws giving exclusive jurisdiction of patent cases to the circuit courts which are in force to-day; and the question which arose on the very face of these cases was whether the "laws of the states" were to be "rules of decision" in actions on the case for infringement of patents.

It has been repeatedly held, as we pointed out in prior sections of the brief, that state statutes of limitations and state laws of evidence were prominent classes of "laws of the several states" which were to be rules of decision under section 721. Now, since it has been decided by this court in three unanimous opinions that the laws of evidence of the several states are rules of decision in actions for infringement of a patent, it is clear that under these decisions another class of laws of the several states, namely, state statutes of limitations, also, are rules of decision in such actions.

Every argument in plaintiff's brief that state statutes of limitations cannot "apply" to patent cases, because such cases are not within the jurisdiction of the state courts, and therefore the state laws "cannot extend to such suits," is exactly as applicable to state laws of evidence. Plaintiff's argument is directly opposed to these three decisions of this court.

Plaintiff's brief (p. 53) does not attempt to distinguish these cases, except by saying (or implying) that they rest on Rev. Stat. sec. 858, as to exclusion of witnesses. But this court expressly rests its decisions on section 34 of the Judiciary act, now section 721 of the Revised Statutes; and the whole question was as to applying the state statute. In fact, Revised Statute 858 was not then in existence!!

Moreover, the direct question of the enforcement of state statutes of limitation has arisen in cases arising under rights granted by the United States, and entirely parallel to actions for infringement; and this court has expressly held that the question is not how plaintiff got his right, but whether the state statute applies to the form of action in question. This is the only possible meaning of the words "in cases where they apply;" and we cite here a decision of this court directly upon this point. Other cases to the same effect are considered below (pp. 59–62). This case was cited with approval in *Michigan Bank* v. *Eldred*, 130 U.S. 693, 696.

The case is *McCluny* v. *Silliman*, 3 Pet. 270. The action was an action upon the case in the Circuit Court of the United States for the District of Ohio against the defendant as register of the United States Land Office in Ohio for refusing to enter the plaintiff's application for certain lands, as the act of Congress required him to do. To the declaration the statute of limitations of the state of Ohio was pleaded. The plaintiff contended (p. 276) that the statute did not apply to an action on the case for malfeasance in office, and that the state statute was not pleadable to an action in the Circuit Court for such malfeasance "in a ministerial officer of the general government, *and especially where the plaintiff's rights accrued to him under a law of Congress.*"

This court cited section 34 of the Judiciary act (Rev. Stat. sec. 721), and said that, "under this statute, the acts of limitations of the several states, where no special provision has been made by Congress, form a rule of decision in the courts of the United States, and the same effect is given to them as is given in the state courts."

The statute of Ohio barred "all actions upon the case" after six years. It was contended, as the opinion says, that "*such a case could not have been contemplated by the legislature*," and that the statute could only apply to "persons who act under the authority of the state." The court said that, while the legislature of Ohio probably did *not* refer to such misconduct of a national official, yet they did not "restrict the provision of the statute to any particular causes for which the action on the case will lie" (p. 277).

This court said (p. 278), —

> " *Where the statute is not restricted to particular causes of action, but provides that the action by its technical denomination shall be barred if not brought within a limited time, every cause for which the action may be prosecuted is within the statute.* . . . The action on the case must be brought within six years from the time the cause of action arose, *and it is immaterial what that cause may be;* the statute bars the remedy by this form of action if it be not prosecuted within the time. *In giving a construction to this statute where the action is barred by its denomination, the court cannot look into the cause of action.* . . . By bringing his action on the case, the plaintiff has selected the appropriate remedy for the injury complained of. *This remedy the statute bars. Can the court, then, by referring to the ground of the action, take the case out of the statute?* . . . Of late years the courts in England and in this country have considered statutes of limitations more favorably than formerly. They rest upon sound policy and tend to the peace and welfare of society. The courts do not now, unless compelled by the force of former decisions, give a strained construction to

evade the effect of those statutes. By requiring those who complain of injury to seek redress by an action at law within a reasonable time, a salutary vigilance is imposed, and an end is put to litigation."

This case, we submit, is a direct authority in the case at bar. There was no right of action except under the statute of the United States, establishing the duties of defendant. The obligation of the defendant to enter plaintiff's application depended entirely on that statute, and was not within the control of the state legislature, which could not legislate regarding the lands belonging to the United States. But it was held, when the plaintiff brought an action on the case, founded on his statutory right, that the state statute of limitations must be applied under section 721. The case directly decides that if an action on the case is barred by the state statute, it is perfectly immaterial that plaintiff's right rose under the United States statute, and related to a subject matter which was wholly without the control of the state legislature. Section 721 makes the state statute the "rule of decision."

If the form of action is barred by the state law, then it is a case where that law applies; and section 721 makes such state law a rule of decision, irrespective of the nature of the right.

Another case bearing on the point is *Beatty's Adm'rs* v. *Barnes' Adm'rs*, 8 Cranch, 98, which was an action for money had and received, brought in the Circuit Court for the District of Columbia to recover moneys paid defendant by the city of Washington for land taken by the government. The plaintiffs claimed under a land patent from the Land Office for the Western Shore of Maryland; but the defendant Barnes had been in actual possession of the land for some years. "The plaintiffs sought to support their action under the statute of Maryland of 1791" concerning lands in the city of Washington, providing that if any person had made a conveyance of such lands without title, the person with the real title might, by an action for money had and received, recover the money received by the other party for any land appropriated by the United States. The defendant pleaded the statute of limitations of the state of Maryland.

It was held by this court, in a unanimous decision delivered by Mr. Justice **Story**, that the action was barred.

The court said (p. 107), —

> "The action for money had and received is clearly embraced by the statute of limitations, and it is incumbent upon the plaintiffs to show that the present case forms an exception to its operation [just as it is incumbent upon the plaintiffs in the case now at issue].
>
> "*It is contended that the present suit, being a statute remedy, is not within the purview of the statute of limitations. But we know of no difference in this particular between a common law and statute right. Each must be pursued according to the general rule of law, unless a different rule be prescribed by statute; and where the remedy is limited to a particular form of action, all the general incidents of that action must attach upon it. Upon any other construction, it would follow that the case would be without any limitation at all;* for it would be quite impossible upon any acknowledged principles, when a right had assumed the shape of a claim *in personam*, to attach to it a limitation which exclusively applied to the realty. Now the statute of limitations has been emphatically declared a statute of repose, and we should not feel at liberty to break in upon its general construction by allowing an exception which has not acquired the complete sanction of authority."

We submit that this case bears directly upon the case at bar, as the action for infringement of a patent is the "action on the case" (which would be the action at common law in any event); and "all the general incidents of that action must attach upon it," and among these are the statutes of limitations limiting actions upon the case.

The five decisions set forth above completely answer the erroneous reasoning of some few circuit judges in refusing to apply state statutes of limitations to patent cases, which will be more fully treated below. For example, it has been said that a patent is a right conferred by Congress, and that no state can legislate so as in any way to affect that right. This is completely answered by the above decisions applying state rules of evidence; for both state statutes of limitations and statutes of evidence are not legislation directed at patent rights, but they are the rules as to the period within which actions of certain classes may be brought, and as to production of evidence in trials of certain actions. Both alike affect the remedy of a patentee to secure redress. In fact, it is quite conceivable that the application of state laws as to evidence would have a far more important bearing on the question of his recovery than the application of the state statutes of limitations could ever have. The one might prevent his proving his case; the other only compels him to be diligent. No possible distinction can be drawn between statutes of limitation and statutes of evidence with regard to their enforcement in patent causes under this section.

Again, it has been said that the laws of the state are to be applied in the United States courts only in cases where those courts have concurrent jurisdiction with the state courts. There is no foundation in the statute for such exception, and the above decisions of this court in patent cases are conclusive upon the point. For when these cases were decided, the circuit courts had exclusive jurisdiction on actions for infringement under the act of 1836, just as they have to-day.

It follows, then, that the substance of the point here at issue has already been determined by this court, and the fact that some of the circuit court decisions treat the point as undecided can only be due to the fact that the above cases were not properly considered.

We shall, however, in view of the importance of the case, proceed to consider the circuit court decisions and the reasons which have been advanced for holding that actions upon patents must be regarded as an exception to the provisions of section 721.

THE DECISIONS IN THE CIRCUIT COURTS.

There has been a disagreement among the circuit courts as to the applicability of the state statutes of limitations to an action at law upon a patent; but most of the cases against such applicability were not decided on full consideration, and in none of the earlier cases was the court's attention called to the decisions of this court that the state laws of evidence governed in patent cases.

Even if the weight of authority in the circuit courts were strongly against defendant, this court is of course not bound by such decisions, except so far as it may be influenced by the reasoning therein. For instance, in *Andrews* v. *Hovey*, 124 U.S. 694, 715, this court gave an interpretation to the 7th section of the patent act of 1839, which was in accordance with only one circuit court decision, and was against four direct adjudications made by the circuit courts, as well as *dicta* in other circuit court opinions, and, as was contended, in opinions of this court.

The court says (p. 716), —

> "A question arising in regard to the construction of a statute of the United States concerning patents for inventions cannot be regarded as judicially settled when it has not been so settled by the highest judicial authority which can pass upon the question."

DECISIONS THAT STATE STATUTES ARE RULES OF DECISION IN PATENT CASES.

In the following cases, all of which were actions on patents, the decisions of the circuit courts have been favorable to defendant's contention in this case: —

In *Parker* v. *Hawk*, 2 Fish. Pat. Cas. 58 (1857), Judge LEAVITT of the sixth circuit fully considered the question. The court held that the action *for an infringement was an action on the case, and therefore within the category of the suits to which the Ohio statute applied;* and that while the act of July 4, 1836, provided that damages may be recovered by an action on the case, yet —

> "If the statute did not directly authorize it and the party complaining of the injury was remitted to his remedy at common law, this would be the proper form of action."

(This is plainly correct, — see *supra*, p. 5).

The court very well said, —

> "Does it follow, because they [Congress] have failed to establish a limitation in suits for infringements of patent rights, that the right of the patentee to sue shall be indefinitely extended? And is it not expedient, while it violates no principle, that the legislation of the states shall be invoked to protect their citizens from the annoyance of being sued upon stale claims for alleged infringements? A patentee has clearly no ground to complain of a violation of

his rights under his patent, by being required to prosecute within a reasonable time. The right to sue at any time is not a right secured to him by the emanation of a patent, and he can clearly claim nothing that is not conferred by his patent. There is no force in the argument that in this view it would be in the power of a state to defeat the rights of a patentee by prescribing a period of limitation so short as to render it impracticable to sue for an infringement. It is a sufficient reply to this, that this objection does not exist, and cannot therefore apply in reference to the statute of Ohio now in question. And this court cannot mould its decision in this case, in apprehension of such future legislation by a state as may interfere with or thwart the just rights of a patentee. It will be proper for the court to determine what its action shall be when the grievance supposed shall have an actual existence."

In the case of *Parker* v. *Hall*, 2 Fish. Pat. Cas. 62 (1857), the same question arose, and Mr. Justice McLEAN, with Judge LEAVITT, arrived at the same decision.

In *Rich* v. *Rickets*, 7 Blatch. 230 (1870), Judge HALL of the second circuit quoted the previous cases on both sides, and decided that the statute of limitations applied.

In *Howes* v. *Nute*, 4 Cliff. 173 (1870), Mr. Justice CLIFFORD, on a bill in equity, said that suits in equity or actions at law to recover damages for the infringement of letters patent may be maintained if the suit was commenced "before the claim was barred by the statute of limitations," there being at this time no United States statute bearing on the subject.

In *Sayles* v. *Richmond, Fredericksburg & Potomac R.R.*, 4 Ban. & Ard. 239 (1879), Judge HUGHES of the fourth circuit held, in an equity case, that after Congress, in 1874, had repealed the statute of limitations, as to suits on patents, of July 8, 1870. "This repeal gave the complainant the right to sue under section 721 within five years from June 22, 1874," this being the time set by the state statute of limitations.

In *Sayles* v. *Oregon Central Ry. Co.*, 4 Ban. & Ard. 429 (1879), Judge Deady of the ninth circuit held that when the national statute of limitations was repealed by sec. 5596 of the revision of 1874, sec. 5599 saved all rights of action accruing up to that time, so that they might be commenced within six years after the expiration of the patent; and said that, unless there was such saving clause, "the only statute of limitations applicable to this class of actions is that of the state."

In *Sayles* v. *Lake Shore & Michigan Ry. Co.*, 9 Fed. Rep. 515 (1879), Mr. Justice Harlan of this court, upon demurrer, said, —

> "I confess that as I thought about that question [the plea of the state statute] *I could not understand logically why the provision of the state statute did not apply if there were no statute of the United States;* but the weight of authority is the other way, and I think my business here holding this court is to be governed by the weight of authority. Purely upon the weight of authority, therefore, I overrule that view, and hold that the state statute of limitations has no application."

In *Hayward* v. *City of St. Louis*, 11 Fed. Rep. 427 (1882), Judge Treat of the eighth circuit said that, as to rights accruing before 1874, the state statute of limitations could not prevail owing to the existence of the congressional limitation; but that after repeal "no limitation would prevail except as by state statute." (Plaintiff's brief cites this case, but it is clearly an authority against him.)

In *Hayden* v. *Oriental Mills*, 15 Fed. Rep. 605 (1883), this question was elaborately considered by Judges LOWELL and COLT of the first circuit. The court said, among other things, —

> "*No reason is given in any decision for excepting one class of cases out of section 721. . . . There is no such exception in the statute itself, and none in its intent and purpose.* Exclusive jurisdiction is given for reasons which are apart from this question. For instance, in patent cases the federal courts have this control in order that the construction of the law and of the patents granted under it may be as nearly uniform as possible, not that the remedies of a patentee shall be of uniform duration. Equity is a uniform system in the federal courts throughout the United States, but the remedies in equity are barred in those courts by the state statutes of limitations in certain cases."

The court then very well pointed out that the theory of the dependence of section 721 upon "concurrent jurisdiction" of the state and federal courts was a mistaken application of the rule that courts of equity apply state statutes of limitations in cases of "concurrent jurisdiction," but that this means concurrent with the courts of common law, and is applicable only to courts of equity (not courts of law) applying statutes of limitations in patent cases. Section 721 does not apply to courts of equity (*infra*, p. 39); but in law cases it makes the state statute a rule of decision. The court therefore said that it was "as inadmissible to say that section 721 does not apply to patent cases as that the law adopting the general practice of the states does not apply to them:" and pointed out that "A dozen questions may arise in any patent case which can only be decided by the law of the state" (*e.g.*, questions of evidence as expressly decided by the Supreme Court, and other like questions).

A like decision was made by Judge CARPENTER of the first circuit in *Royer* v. *Coupe*, 29 Fed. Rep. 358, 362 (1886).

The latest case upon this subject is *Bicknell* v. *Baltimore*, 52 Fed. Rep. 737 (1892), where Judge MORRIS of the fourth circuit held, upon a very full review of the prior decisions, that —

"I find myself unable to concur in the reasoning by which the decisions adverse to the applicability of the state statutes are sustained. There are, it is quite true, many reasons why Congress should enact a statute of limitations expressly applicable to this peculiar character of property, but this, of itself, is no reason why, in the absence of such legislation, suits arising out of patents should not be governed by the same rules as govern similar actions. I am not aware of any common law actions, *growing out of private rights, even though granted by the United States*, to which, in the absence of any federal statute, the state statutes of limitations are not held applicable."

This statement is absolutely correct.

The court then continues (p. 739):

"I do not appreciate the supposed force of the argument that because Congress, *in order to secure uniformity of decisions as to the construction of the patent laws and the validity of patents*, has given to the federal courts the *exclusive jurisdiction* of questions of infringements, that, therefore, this class of cases should be the sole exception to the prevailing rule, which makes the state acts of limitations just as binding upon the federal courts as they are upon the state courts; more especially as the Supreme Court has held that section 721, so far as it makes the state laws rules of decision as to the competency of witnesses, is applicable to this very class of actions for infringement of patents. *Vance* v. *Campbell*, 1 Black. 427; *Haussknecht* v. *Claypool*, id. 431. If there be merely a doubt as to whether or not section 721 is applicable, the fact that not to hold it applicable would leave actions not affected by any statute of limitations should, in my judgment, favor the construction which would make the statute applicable. *McCluny* v. *Silliman*, 3 Pet. 270; *Hayden* v. *Oriental Mills*, 15 Fed. Rep. 605; *Copp* v. *Railway Co.*, 50 Fed. Rep. 164."

The court sustained the demurrer simply for the purpose of the trial, in order to allow the whole case to go to the jury.

To these decisions may be added —

Hathaway v. *Roach*, 2 W. & M. 63, where Judge WOODBURY of the first circuit held that costs in an action at law on a patent are to be allowed according to state statutes, under section 721.

A valuable opinion in an exactly analogous case is *Copp* v. *Louisville & N. Ry. Co.*, 50 Fed. Rep. 164. The plaintiff brought suit under the Interstate Commerce act to recover the amount of freight paid by him to defendant in excess of that paid by others. The defendant pleaded the statute of limitations of Louisiana, where the action was brought, setting the limitation of one year to actions for quasi offences. The court (BILLINGS, J.) pointed out that "the action arises from a law of Congress," and that "in the act of Congress there is no limitation as to time, and unless the state statute applies there is no limitation." The court held that the action was barred by the state statute, pointing out that "This is a purely civil action, and *by denomination and definition is within the meaning of the state statute of limitation.*" The court, in support of its decision, quoted from section 721, and from numerous decisions of the Supreme Court; and also held that the fact that the United States Circuit Court had exclusive jurisdiction of this class of actions did not affect the question.

"For if the statute would control the matter in the state courts in case they had jurisdiction, the statute is nevertheless the rule of decision. The binding force of the state statute of limitations upon the United States courts in cases where they have jurisdiction comes from section 34 of the Judiciary act, and the statute is made a rule of decision in cases to which it applies equally whether the state courts have jurisdiction or not. The statute becomes a rule of property in the United States courts if it would include a similar action in the state court."

This case is in every point analogous to the case at bar. The right of action was conferred by Congress, and exclusive jurisdiction was vested in the Circuit Court; but it was held that, as the state statute of limitations applied to the action in question, it must be enforced in the United States court under section 721.

DECISIONS THAT STATE STATUTES ARE NOT RULES OF DECISION IN PATENT CASES.

Of the cases usually cited as being to the contrary effect, many will be found upon examination not to be in point. When the act of July 8, 1870, limiting patent actions, was passed by Congress, it superseded all state statutes of limitations; and it has been generally held that when this statute was repealed by the Revised Statutes, all rights of action in existence at the date of the repeal were saved by section 5599. Therefore, as to all infringements subsequent to July 8, 1870, and prior to June 22, 1874, the national statute of limitations continued to apply, and suit could be brought within six years after the expiration of the patent. Hence, in many cases where infringement was alleged from a period before 1874, a demurrer to the whole declaration on the ground of state statutes of limitations was too broad, and was properly overruled; and many of the expressions of opinion in the circuit courts were given in such cases, and are really mere *dicta*.

Plaintiff's brief cites at length passages from the Circuit Court opinions, but does not set forth the circumstances of each case. We therefore call attention to the following summary: —

The leading case on this side is *Reed* v. *Miller*, 2 Biss. 12 (1867), a decision by Judge McDonald of the seventh circuit. The court admitted that the state statutes of limitations could, as a general rule, be pleaded in United States courts, but said that the action in question formed "*an exception to the general rule.*"

The court says, "These state laws do not apply in cases over which the state governments have no control whatever." This is directly contrary to the decisions of this court as to laws of evidence in patent cases.

This decision, which started the erroneous line of cases, is rested upon two grounds: first, that "no state can pass any law concerning patent rights,"— which is entirely erroneous in this connection, as we shall show; and second, that the national courts have exclusive jurisdiction by act of Congress in patent cases, which, as we shall show, is wholly irrelevant.

In *May* v. *County of Buchanan*, 29 Fed. Rep. 469 (1886), Judge Shiras, of the eighth circuit, decided that the state statute of limitations was not applicable. The decision is placed squarely upon the ground that letters patent are matters wholly without the control of the state.

This decision was followed in the same circuit by Judge Shiras himself, in *May* v. *Cass County*, 30 Fed. Rep. 762 (1887); and by Judge Thayer in *May* v. *County of Ralls*, 31 Fed. Rep. 473 (1887), but in each case without any extended discussion, and evidently because such was regarded as the rule for that circuit.

In another case by this same patentee, in the sixth circuit, *May* v. *County of Logan*, 30 Fed. Rep. 250 (1887), infringement was alleged, from the fourth day of April, 1873, of the extended term of the May patent, which expired on the 4th of October, 1880. As the suit was commenced within six years after the expiration of the extended term of the patent, it was seasonably commenced as to all infringements from the 4th of April, 1873, to the 22d of June, 1874, when the national statute of limitations of 1870 was repealed (see the opinion, p. 256), and therefore the action was sustainable, and the general demurrer was properly overruled (p. 258).

Judge JACKSON held (p. 256), —

> "*As there is a federal statute of limitations in force and applicable to the present suits, or the causes of action they are brought to enforce*, it is clear, under the authorities, that the state statutes cannot be invoked to displace the federal statute or shorten the period of limitation prescribed by the latter."

The court, however gave an unnecessary *dictum*, denying the applicability of state statutes, upon the ground that —

> "Letters patent, together with the rights of action and remedies given for the infringement of the same, are matters under the exclusive control of the federal legislature and federal judiciary."

The only other opinion upon this side of the question dealing with the subject fully is the opinion of Judge SHIPMAN of the second circuit, in *Brickill* v. *City of Hartford*, 49 Fed. Rep. 372 (1892). The court said, "States cannot legislate upon matters which are without state jurisdiction;" and that "cases where they apply" referred to actions "with respect to rights of property of which states have control," but that state statutes are not applicable "to rights over which the state legislatures have no control, *except as they relate to procedure, practice, or rules of evidence.*" (For any such distinction there is not the smallest basis in section 721, or in any decided case.)

The court admitted that the Supreme Court had decided that, "in actions at law upon letters patent, the rules of evidence which are created by statute in the respective states apply;" but said that "the conclusion by no means follows that the right of protection to property in letters patent was intended to be or has been controlled by state legislation."

The reasoning of the court we are entirely unable to understand. There is no doubt that "the laws of the several states" means state statutes of limitations as well as rules of evidence: and, it being conceded by the court that the state rules of evidence apply in patent cases, we fail to see any reading of the statute possible which will exclude statutes of limitations.

To interpret the statute as making one class of the "laws of the several states" rules of decision in patent cases, and not another class of such laws (laws which have universally been held to be rules of decision in various other classes of cases in the United States courts), is to make a distinction for which the statute itself affords not the slightest foundation; a distinction, moreover, which is entirely unfounded upon any sound reasoning.

This is the only adverse case in which the attention of the Circuit Court appears to have been called to the adjudications of this court upon the enforcement in patent cases of state laws concerning evidence.

The other cases usually quoted on this side of the question may be briefly disposed of.

In *Collins* v. *Peebles* 2 Fish. Pat. Cas. 541 (1865), SWAYNE, J., and *Parker* v. *Hallock*, referred to in note to the last case (1857), GRIER, J., no reasons at all were given, and there was no discussion.

In *Sayles* v. *Dubuque & Sioux City Railroad Co.*, 3 Ban. & Ard. 219, 220 (1878), DILLON and LOVE, JJ., the congressional statute of limitations of 1870 governed; and the court left the question of the applicability of the state statute "*open to further discussion.*" (The *extract* from this case in 9 Fed. Rep. 516, cited in plaintiff's brief, is absolutely misleading.)

In *Adams* v. *Bellaire Stamping Co.*, 25 Fed. Rep. 270 (1885), Judge SAGE said, "The authorities are in conflict, and the question is one of great difficulty;" and that the question must be "saved for the appellate court."

In *May* v. *County of Fond du Lac*, 27 Fed. Rep. 691, Judge DYER does not mention the state statute of limitations, though it appears to have been pleaded.

In *California Stone Paving Co.* v. *Starr*, 48 Fed. Rep. 560 (1891), Judge HAWLEY, of the ninth circuit, in an oral opinion, said that the greater part of the decided circuit court cases were against the applicability of the state statute, but that the decisions were not uniform on the subject.

In *Brickill* v. *Buffalo*, 49 Fed. Rep. 371 (1892), Judge

Coxe refused to sustain a demurrer on the ground of the statute, because "the rights of both parties can best be protected if the formal ruling is postponed until trial." He said that "the question, however, has never been decided by the Supreme Court or by any of the Circuit Courts of Appeals."

The four following cases were bills in equity, and therefore what is stated by the judges is a mere *dictum*, for section 721 is limited to actions at common law; and it is perfectly well settled that this section does not apply to *equity* or admiralty cases (see *Bucher* v. *Cheshire Railroad Co.*, 125 U.S. 555, 582); and hence these cases were not cases where section 721 made the state laws applicable, and whatever the courts said beyond that was a mere *dictum*, unnecessary to the decision.

McGinnis v. *Erie Co.*, 45 Fed. Rep. 91 (1891), was an equity case on demurrer; and Judges **McKennan** and **Acheson** of the third circuit stated that they would adhere to the rule laid down by Judge **Grier** in that circuit in the absence of any decision of the Supreme Court on the question; but said that "the decisions of the circuits are conflicting," and expressed no opinion of their own.

In *Wetherell* v. *Zinc Co.*, 1 Ban. & Ard. 485 (1874), Judge **McKennan** of the third circuit, in an equity case, on a master's account, said briefly that the state statutes of limitations were authoritative only where "the federal and state tribunals have concurrent jurisdiction of the case." Moreover, it is not at all clear from the report that the right of action was not governed by the congressional statute of 1870.

Anthony v. *Carroll*, 2 Ban. & Ard. 195 (1875), is a decision by Judge SHEPLEY of the first circuit, in an equity case, and really is not in point; for the patent, it seems (by reference to the Patent Office Gazettes), was granted on May 26, 1857, and did not expire until May 26, 1871. Consequently, under the congressional statute of limitations of July 8, 1870, the patentee had until May 26, 1877, six years after the patent expired, to sue as to all causes of action which were not barred before the statute came into operation, and the infringement appears to have continued until 1867, while the bill was seasonally filed in 1874. Therefore the case was governed by the congressional statute, and demurrer was properly overruled.

Judge SHEPLEY, however, delivered a *dictum* to the effect that laws of the state did not apply to an action for infringement of a patent.

Wood v. *Cleveland Rolling Mills*, 4 Fish. Pat. Cas. 550, 556, simply decided that a suit in equity was not barred by laches and was not affected by the act of 1870. There is no question as to applying state statutes.

The result of this discussion of the adverse cases is that in some the decisions are not to the point, and in others the judges lean unwillingly toward the supposed weight of authority in their circuits. The considered decisions which are to the point are comparatively few.

THE ARGUMENTS AGAINST THE ENFORCEMENT OF STATE STATUTES OF LIMITATIONS CONSIDERED.

We believe that it can be shown that all these decisions of the circuit courts proceed upon erroneous views; and we will deal with the different arguments advanced against the applicability of the state statutes in order.

I. THE ARGUMENT AB INCONVENIENTI.

Some of the circuit courts who have refused to enforce state statutes of limitations appear to have been chiefly influenced by the fear that some state *might* at some future time pass such a statute of limitations as would seriously impair the rights of patentees. In fact, this consideration was probably at the bottom of all the decisions to this effect. *It is not pretended that any state has ever passed such a statute*, and the question has always arisen under *reasonable* statutes of limitations, giving the plaintiff in most cases a period of six years (in some states four or five years) in which to bring *any* action on the case or *any* action of tort. That such statutes are not only reasonable but wholly beneficial, has been decided constantly by this court (cases cited *supra*, pp. 14–16).

Of course, the interpretation of section 721 of the Revised Statutes cannot be controlled by the fear of possible state legislation, if the language of the statute clearly requires state statutes of limitations to be enforced in actions at law on letters patent; and **it is the duty of this court to give the statute its proper interpretation.** If in future any state should attempt unduly to limit the time for bringing actions, the remedy is in the hands of Congress, which could at any moment obviate any such hypothetical future hardship to patentees, either by the enactment of a congressional statute of limitations for patent cases, which would at once place such cases within the exception of section 721, or by limiting that section, as some circuit judges have sought to limit it by judicial legislation, by excluding patent cases altogether from its provisions.

In *Amy* v. *Watertown No.* 2, 130 U.S. 320, the plaintiff claimed that the statute of limitations had not run, because the defendants, by a conspiracy, had prevented the service of process. No such exception, however, was made by the Wisconsin statute. The court said, —

> "The question, therefore, is whether the courts can create another exception, not made by the statute, where the party designedly eludes service of process."

And again (p. 324):

> "*The general rule is that the language of the act must prevail, and no reasons based on apparent inconvenience or hardship can justify a departure from it.*"

And again, (p. 327):

> "If this is an omission, the courts cannot supply it. That is for the legislature to do."

See, also, *Thornley* v. *United States*, 113 U.S. 310, 313; *Doe* v. *Considine*, 6 Wall. 458, 480.

This case seems to answer very aptly the ruling of Judge SHIPMAN excepting state statutes of limitations from the "laws of the several states," which apply in patent cases. No such exception is authorized by section 721.

But the apprehended hardship to patentees can never occur. **For if a state should pass a statute of limitations which did not give a patentee or any other person a reasonable time within which to sue, such statute would be unconstitutional and void.**

We find no instance in which a state legislature has ever attempted to pass a statute of limitations of the oppressive character here imagined; but the courts have constantly said that if a statute of limitations did not allow a reasonable time for commencing action it would be unconstitutional.

So, in *Wheeler* v. *Jackson*, 137 U.S. 245, 250, this court said, —

> "It is the settled doctrine of this court that a legislature may prescribe a limitation for the bringing of suits where none previously existed, as well as shorten the time in which suits to enforce existing causes of action may be commenced, provided in each case a reasonable time (taking all the circumstances into consideration) be given by the new law for the commencement of suit before the bar takes effect."

See to the same effect, —

Terry v. *Anderson*, 95 U.S. 628, 632.
McGahey v. *Virginia*, 135 U.S. 701, 705.

So, also, in *Koshkonong* v. *Burton*, 104 U.S. 668, 675, the Supreme Court said, —

> "The exertion of this power [to limit actions] is, of course, subject to the fundamental condition that a reasonable time, taking all the circumstances into consideration, be given by the new law for the commencement of an action before the bar takes effect."

See, to the same effect, Cooley's Constitutional Limitations, 451.

The cases on this point have often been suits on contracts, and so the constitutional question has arisen under the prohibition of "laws impairing the obligation of contracts." But it is plain that the same principle applies to other actions. A law providing that actions for ejectment should be begun within one day would plainly be unconstitutional under the fourteenth amendment of the Constitution of the United States, providing, —

"Nor shall any state deprive any person of life, liberty, or property without due process of law."

In the well-considered case of *Stearns* v. *Giddings*, 23 Ill. 332, 334, the question was raised of the constitutionality of a law making actual possession of lands for a term of years a defence to an action. The court quoted the prohibition of the Illinois constitution as to depriving a person of life, liberty, or property but by the judgment of his peers or the law of the land; and said that the constitution required that the act of limitations "should afford reasonable time and opportunity for the assertion of the right."

So, also, a law limiting the time for bringing actions of trespass or trespass on the case, unless it allowed a reasonable time, would be unconstitutional equally as to an owner of real property and an owner of property in letters patent.

Such a law would, moreover, in Massachusetts, be obnoxious to article 11 of the constitution, providing that "every subject of the commonwealth ought to find a certain remedy by having recourse to the laws for all injuries or wrongs which he may receive in his person, property, or character."

It follows, then, that a statute of limitations would be unconstitutional if it did not allow a reasonable time within which the owner of the patent might bring suit. This would certainly be so if the act applied to causes of action accrued before the passing of the statue, and probably would be true if the act was only prospective; but the latter point is unimportant, because Congress could at any time pass a national statute of limitations which would oust the state statute.

With this principle in mind, it is clear that any state which should be opposed to the patent system could interfere more effectively with the enforcement of rights under a patent by laws as to evidence than by a statute of limitations; for the state laws of evidence (which are conceded to apply to patent cases) might make it very difficult for a patentee to enforce his remedies. For instance, it is competent for the laws of a state to require written evidence.

So, in *McNiel* v. *Holbrook*, 12 Pet. 84, 89, this court, in applying the state rule of evidence to a federal case, said, —

> "*In some cases, the laws of the states require written evidence;* in others it dispenses with it, and permits the party to prove his case by parol testimony; and what rule of evidence could the courts of the United States adopt to decide a question of property but the rule which the legislature of the state has prescribed?"

It seems singular that some circuit judges have refused to apply state statutes of limitations, on account of an apprehension altogether unjustified by any existing state laws, when the state laws of evidence are applied without question, though they might readily throw most serious impediments in the way of proving a plaintiff's case.

The argument of expediency, if it could have any weight with this court in interpreting a clear statute, is wholly upon defendant's side. The apprehension of an oppressive state statute of limitations is not founded on any fact. On the other hand, defendant shows the *existing, unavoidable wrong* that, if the state statutes of limitations do not apply, there is *no statute of limitations at all* which bars any action at law on patents, where the right accrued since the repeal of the congressional statute of limitations on June 22, 1874, and there is no obstacle to claims being brought to-day at law on causes of action twenty years old; and such stale claims may easily be made an instrument of oppression and wrong. In the very case at bar, the Knibbs patent expired thirteen years ago, on May 24, 1881; and plaintiff brought suit against defendant (as well as eleven other Massachusetts cities) in 1887, and claims that the infringement began in 1864. If he prevails in his contention that state statutes do not apply, he may sue any other city at law in 1894, or at any time afterwards. Defendant's answer chiefly relies on a large number of prior uses (Record, pp. 13, 14) before Knibbs' invention; but how are such defences to be supported by witnesses if plaintiff may wait for thirty years, or *any* period, before bringing suit?

It was well said of actions on patents by Judges DILLON and LOVE in *Sayles v. Dubuque & Sioux City R.R. Co.*, 3 Ban. & Ard. 219–221, in an equity case, —

> "Inquiry of profits and gains for a period of five years is difficult, as the profits gained depend upon many conditions. When we come to carry such an investigation back for almost a quarter of a century, accuracy of results is almost impossible, and the laches of a patentee coming forward at such a late date does not give him a very favorable position in a court of equity."

We have quoted (*supra*, pp. 14–16) the decisions of this court, where it is emphasized that statutes of limitations are wholly useful and "statutes of repose;" and that this court will not leave an action without any limitation whatever, if such an anomaly can be avoided.

Where, therefore, the question of expediency is between the unfounded apprehension of a state passing oppressive statutes (which would be unconstitutional, and which, moreover, could be at any instant abrogated by a congressional law), and the present wrong of exposing all persons in this country to actions at law on stale claims, resting upon patents which may have expired twenty years ago, we submit that the balance of advantage is plain. Nor would this court, in any event, make an exception which section 721 of Revised Statutes in no way authorizes; for this is not interpretation, but legislation.

2. THE OBJECTION THAT PATENTS ARE "WITHIN CONGRESSIONAL CONTROL."

The argument which the adverse circuit courts have for the most part advanced against applying state statutes of limitations is that the grant of patent rights is a matter wholly within the control of Congress, and not a matter upon which the states have any power to legislate. It is, as several of these courts have expressed it, "a matter without the control of state legislation;" and it seems to be supposed that this consideration is conclusive against enforcing state statutes of limitations under section 721. This view as it seems to us is based upon several complete misapprehensions, and *it must be remembered throughout that a perfectly reasonable statute, applicable to all actions of tort, is at issue in this case, and not any law aimed directly at owners of patents.*

The fundamental error is in the failure to see that the state statute is to be enforced, not because the *state* can effect patent rights by legislation, but because *Congress* has enacted that such statutes shall be enforced in the United States courts.

This reasoning of the circuit courts is, moreover, contrary to the adjudications of this court as to enforcing state statutes of evidence in patent cases (see pp. 19–20, *supra*). If the fact that a state has not the power to grant patents is a sufficient foundation for the argument that no state laws can be enforced in cases upon patents under section 721, then laws passed by a state as to rules of evidence could not affect patent cases; but three express decisions of this court have decided to the contrary effect.

Apart from the authority of these decisions, however, the reasoning of these circuit courts seems erroneous, for reasons which we will set forth at length:

First. These courts overlook the distinction altogether between *rights* and *remedies* as regards statutes of limitations. A statute like that of Massachusetts affects only the *remedy* and *not the right.*

Second. The cases are numerous where state legislation of various kinds has been upheld, though affecting rights under patents; and it is a complete mistake to suppose that patents cannot be in any way affected by state legislation. Especially is this so when Congress itself has by section 721 made state laws applicable.

Third. These courts overlook the numerous cases of other rights granted by the United States (and "under the exclusive control" of Congress in that sense), such as actions to recover customs duties, in which state statutes of limitations have been applied without question by this court, as also the express adjudications of this court that, in considering the applicability of state statutes of limitations, it is *not the origin of the right* which is important, but the *form of action* which is brought to enforce it. These cases have a direct bearing on the case at bar.

A. STATUTES OF LIMITATION AFFECT ONLY THE REMEDY, AND NOT THE RIGHT.

It would seem, from most of the adverse cases which we have cited above, as if the circuit courts had supposed that a statute of limitations, regulating the time within which actions upon the case may be brought (like the statute of Massachusetts), touched the *right* granted by the United States under letters patent. As a matter of fact, nothing is better settled in this court than that statutes of limitations of this nature affect only the *remedy* of the plaintiff. The exclusive right given by the patent is in no way impaired by such statutes; but the patentee possessing that exclusive right is held, as a part of the general policy of the state, to bring his action on the case for the infringement on that right within a certain reasonable time, like any other plaintiff, in an action on the case. (See *Parker* v. *Hawk*, quoted *supra*, p. 28). Such "statutes of repose," protecting citizens of a state against stale claims, have often been emphatically approved by this court (*supra*, pp. 14–16); and *it would seem far plainer that such laws ought to be applied to actions on patents under section* 721 *than that the police power of the state may be used to regulate the sale of patented inventions* (*infra*, p. 54).

The decisions of this court that statutes of limitations for personal actions, like that of Massachusetts, affect only remedies and not rights, are too numerous to be cited at length.

In *Michigan Bank* v. *Eldred*, 130 U.S. 693, 696 (cited above), the court, in applying the state statute of limitations under section 721, said, —

> "*Statutes of limitations of personal actions are laws affecting remedies only, and not rights.*"

So, in the earlier case of *Townsend* v. *Jemison*, 9 How. 407, 413, this court said, —

> "The rule in the courts of the United States in respect to pleas of the statutes of limitations has always been that they directly affected the remedy and not the merits."

This is followed by an exhaustive discussion of the entire subject.

See, also, *Ogden* v. *Saunders*, 12 Wheat. 213, 349.

The same is the law of Massachusetts:

> *Hancock* v. *Franklin Ins. Co.*, 114 Mass. 155, 156.
> *Shaw* v. *Silloway*, 145 Mass. 503, 506.

In the recent case of *Currier* v. *Studley*, 159 Mass. 17, both the majority and minority of the court agreed that statutes of limitations barred only the remedy for an action for damages (pp. 22 and 25); though the majority held that the adverse possession of real or personal property might extinguish the right.

The same distinction is made by this court in *Campbell* v. *Holt*, 115 U.S. 620, 623, 624, where it is held that, while the open possession of real or personal property may give a title under statutes of limitation, yet statutes which limit the time of bringing an action to recover a debt or damages relate only to the remedy and not to the right. The minority of the court did not dissent from this portion of the opinion.

To the same effect, that statutes of limitations affect only the remedy and not the right, see —

> Story on Conflict of Laws (8th ed.), p. 793.
> Angell on Limitation of Actions, sec. 7.

The statute of limitations of Massachusetts at issue in this case is plainly a statute which simply limits the remedy without affecting the right. No question can be raised upon this point.

This being the law, this court has often decided that a state statute of limitations was to be upheld even in the strong case where there was some express compact that the state should not diminish the right upon which the action was founded.

So, for example, in *Hawkins* v. *Barney's Lessee*, 5 Pet. 457 (a case which this court has often cited and followed), an action of ejectment in the Circuit Court of Kentucky was brought by Barney to recover land in Kentucky under a Virginia land patent granted before the separation of Kentucky. It was held by this court that the subsequent statute of Kentucky, limiting an action to recover land to seven years, was a bar to the action. By a compact between Virginia and Kentucky when Kentucky became a state, it was expressly provided that —

> " *All private rights and interests of lands* within the said district, derived from the laws of Virginia prior to such separation, *shall remain valid and secure under the laws of the proposed state, and shall be determined by the laws now existing in this state*" [*i.e.*, Virginia].

The court held that, in spite of this compact, the state of Kentucky had the power to pass a shortened statute of limitations, which barred the plaintiff's action; and said (p. 464), —

> " We have an analogous case in the thirty-fourth section of the Judiciary act of the United States [now Revised Statutes, section 721], in which it is enacted that the laws of the several states shall be rules of decision in the courts of the United States, and which has been uniformly held to be no more than a declaration of what the law would have been without it: to wit, that the *lex loci* must be the governing rule of private right, under whatever jurisdiction private right comes to be examined."

The court further said (p. 466), —

> "*Such laws have frequently passed in review before this court, and occasions have occurred in which they have been particularly noticed as laws not to be impeached on the ground of violating private right. What right has any one to complain when a reasonable time has been given him, if he has not been vigilant in asserting his rights?*"

To the same effect is *Porterfield* v. *Clark*, 2 How. 76, 125.

These cases, it may be noticed, were cases where the statute of limitations was one relating to actions to recover land, which statutes are generally held to give a title; and yet it was held that such a limitation was no violation of an express provision that "all private rights and interests of lands in Kentucky should remain valid and secure."

Supposing even that Congress had expressly provided that "all private rights granted by letters patent shall remain valid and secure under the laws of the several states," could it be contended under this line of decisions that a reasonable state statute of limitations was an impairment of that right?

We submit that these cases are direct decisions to the contrary effect; and yet the chief reasoning of these circuit judges, who have refused to apply the state statute of limitations to patent cases, is based upon the error that to apply such statutes would be to allow the states to impair or "affect the patent right." We submit that these cases show the error of such reasoning; and that, while the states undoubtedly have no power to legislate so as to impair or abrogate the rights granted by Congress under letters patent, yet proper statutes of limitations as part of the general policy of the state are not subject to any objection whatever on this head (any more than are proper rules of evidence), and the right granted by the patent "remains valid and secure."

So, also, in *McElmoyle* v. *Cohen*, 13 Pet. 312–324, it was held that the statute of limitations of the state of Georgia could be pleaded in an action brought in the Circuit Court of the United States for the District of Georgia on a judgment recovered in South Carolina. The argument was that, by section 1 of the 4th article of the Constitution of the United States, it was provided that —

> "Full Faith and Credit shall be given in each State to the public Acts, Records and judicial Proceedings of every other State."

But this court held (p. 327) that it was "well settled", that a statute of limitations was only "*a plea to the remedy*," and that the states had a right to pass such statutes as to judgments of another state."

In short, the whole argument of these circuit judges that "a state can pass no law affecting patent rights," is based on a fundamental misconception.

In the first place, it is not state legislation, but the act of Congress, which makes state laws rules of decision in patent cases. In the second place, such statutes of limitations as that of Massachusetts do *not* affect the right, and in no way impair or conflict with the grant to an inventor of the exclusive right to make, use, and vend an invention for a limited term. They only provide, as part of the general policy of the state, that actions on the case must be brought within some limit of time; and this court has often decided that Rev. Stat. sec. 721, was simply declaratory of the general international principle which would lead the circuit courts, in any case, to apply the limitations prescribed by the state within which that court was organized.

We now come to consider what we believe to be a second fundamental misconception of these decisions.

B. MANY STATE LAWS HAVE BEEN HELD TO AFFECT PATENT RIGHTS.

The favorite ground with the circuit judges on plaintiff's side has been that, as patents are granted by the United States, "no state can pass any valid law concerning them" (McDonald, J.); these rights "can be affected only by the laws enacted by Congress" (McKennan, J.); "states cannot legislate upon matters which are without state jurisdiction" (Shipman, J.).

We have just shown that it is not the state but *Congress* which enforces these laws in patent cases, and that statutes of limitations do *not* "affect the right:" but, moreover, such sweeping *dicta* are plainly erroneous, — certainly as regards general statutes not aimed specifically at patents. That a state cannot directly legislate so as to extend or shorten the term of the patent granted by Congress is, of course, obvious. As Congress has the power to grant patents, the state cannot, by special legislation, affect their term, for example: for Congresss has "otherwise provided:" but to say that no laws of the state can in any way "affect" the owner of a United States patent is obviously unsound.

In the first place, there is the police power: as, for instance, in *Patterson* v. *Kentucky*, 97 U.S. 501, a man owned a patent for an improved burning oil, and was convicted under the Kentucky statute for selling that patented oil, as being unsafe for illuminating purposes. It was held that the enforcement of the state statute was correct. In a unanimous opinion delivered by Mr. Justice Harlan, this court says (p. 503) that the exclusive right granted by letters patent "*obviously is not granted or secured without reference to the general powers which the several states of the Union invariably possess over their purely domestic affairs*, whether of internal commerce or of police:" and again (p. 504):

> "By the settled doctrines of this court, the police power extends, at least, to the protection of the lives, the health, and the property of the community against the injurious exercise by any citizen of his own rights."

And so the court held (p. 505) that the right conferred upon the patentee by Congress to use and vend the patented article "*must be exercised in subordination to the police regulations which the state established by the statute of* 1874."

The case is cited and approved in both the majority and minority opinions in *Leisy* v. *Hardin*, 135 U.S. at pages 121 and 127.

So, also, in *Webber* v. *Virginia*, 103 U.S. 344, the statute of Virginia requiring the agent for the sale of articles manufactured in other states to obtain a license was held not to be unconstitutional so far as concerned the point that the Singer machine in question was covered by a patent.

This court, by Mr. Justice Field, said (p. 347), —

> "The right conferred by the patent laws of the United States to inventors to sell their inventions and discoveries does not take the tangible property in which the invention or discovery may be exhibited or carried into effect, from the operation of the tax and license laws of the state."

It follows plainly from these cases that the *exclusive right to vend* which the United States grants by a patent may be interfered with by either the police laws or the tax laws of the states.

In *Ayer* v. *Murray*, 105 U.S. 126, 128, a bill in equity was brought against a resident of the District of Columbia, praying that his patents might be sold and the proceeds of the sale applied to the payment of the judgment debt. It was held in an opinion by Mr. Justice GRAY that the provisions of the Patent act "do not exonerate the right and property thereby acquired by the patentee . . . from liability to be subjected by suitable judicial proceedings to the payment of his debts;" and the decree under the bill was affirmed.

The court cited with approval (p. 131) the intimation of Judge SHEPLEY in *Ashcroft* v. *Walworth*, 1 Holmes, 152, that the state courts might compel a debtor to execute a conveyance of his patent to an assignee in insolvency *under a state law*; and also the decisions of the courts of New York and California "affirming their power to order the assignment and sale of a patent right."

Gillette v. *Bate*, 86 N.Y. 87.
Pacific Bank v. *Robinson*, 57 Cal. 520.

In *Barton* v. *White*, 144 Mass. 281, the Supreme Court of Massachusetts granted the prayer of an assignee under the *state insolvency law*, to compel the insolvent to assign his letters patent; saying that —

> "We have no doubt that it was the intention of the legislature, in enacting the statute relating to insolvent debtors, *to include patents as property which should pass to the assignee by the assignment.*"

As full title to the patent did not pass without a written assignment, the court held that it had the power to compel the assignment. The court further held (p. 284), —

> "*The defendants further contend, though without laying very much stress upon this ground of argument, that the state*

has not the power to enact a statute to pass a title to letters patent of the United States; but we have no doubt upon this point."

See, to the same effect, —

Keach, Petitioner, 14 R.I. 571.

Under these decisions, therefore (which might be largely increased), it appears clearly that the views of some circuit judges, that the state legislatures cannot pass any laws "affecting patent rights" in any way whatever, are entirely too broad. The legislature can pass tax laws and police laws, taxing or regulating the sale of the patented invention; they can pass insolvent laws, which the courts will enforce by decree, giving to the assignee in insolvency the patents of the insolvent. If so, what objection is there to reasonable statutes of limitation being applied to the remedy of a patentee, especially when they are so applied by congressional enactment? It might be that a law directly aimed at a patentee would be held in some cases unconstitutional, but no such law is here in issue. As we said above, the state undoubtedly has not the power to directly abridge or extend the incorporeal right granted by the patent, in such manner as to interfere with the exclusive jurisdiction of Congress; but it has the right (as these cases show) to pass many laws which affect the property conferred by letters patent.

Note, moreover, that the question here is not as to the power of a state to legislate directly concerning patents, but whether, when Congress itself has enacted that state statutes are to be enforced by the United States courts, this court is to make an exception to the law and refuse to enforce a perfectly proper general statute of limitations, on the ground that this would "affect" a patent by state legislation.

C. THE QUESTION OF ENFORCING STATUTES OF LIMITATIONS DEPENDS ON THE APPLICABILITY OF THE STATUTE TO THE ACTION, NOT ON THE ORIGIN OF THE RIGHT OF ACTION.

In considering the enforcement of a statute of limitations, either under section 721 or any other law, the question is not how the plaintiff got his right, but whether the action which he brings to enforce the right is barred by that statute of limitations. A very thorough examination discloses no decision of this court which considers it material, under section 721, whether the right on which the action was based was derived from a congressional statute. On the contrary, it has been expressly settled by this court that the question is wholly as to the form of action, not as to the origin of the right. *In various cases where the right of the plaintiff is derived solely from a congressional statute, — as under a United States land patent, under bankrupt acts, and under customs laws, — it has never been suggested by this court that state statutes of limitations were not to be applied when no national statute governed the case.*

A leading decision on this point is *McCluny* v. *Silliman*, 3 Pet. 270 (cited and fully discussed *supra*, p. 22).

In this case, the plaintiff's right accrued under a law of Congress; but this court held that, under section 34 of the Judiciary act (Rev. Stat. sec. 721), the statute of limitations of Ohio applied, because it was immaterial what the cause of action was, as the particular form of action was barred by the statute.

The case (as we said above) is directly in point, and establishes that in the case at bar the only question is whether the Massachusetts statute bars actions of trespass on the case, and that it is immaterial that the plaintiff in this action derived his right from the United States grant.

So, also, in *Beatty's Adm'rs* v. *Burnes' Adm'rs*, 8 Cranch, 98 (discussed *supra*, p. 24), this court held that the suit was barred by a general statute of limitations, and that it made no difference that the suit was based on a statute right, granted by the state, because the statute of limitations attached to the form of action in question.

In *Bicknell* v. *Comstock*, 113 U.S. 149, the action was brought by Comstock to recover the consideration paid defendant Bicknell for a tract of land in Iowa. The defendant, from whom the title by mesne conveyance had been transferred to plaintiff, had obtained in May, 1869, a patent from the United States for said land. It was held that, after this patent, the statute of limitations began to run in favor of Bicknell and his grantees as being in possession under color of title; and that, under the statute of Iowa, ten years' adverse possession was a bar to any action to recover the land, and therefore the defence of the plaintiff to any suit brought against him for the land was perfect (the land having been held under Bicknell's claim for over twenty-two years), whether Bicknell's patent was valid or not, "as all title was out of the United States prior to this deed, on which this suit is brought, and vested in some one else capable of suing," etc.

This case seems very clearly to show that the state statutes of limitations will apply in cases where title is derived from the United States.

In *Barney* v. *Oelrichs*, 138 U.S. 529, the action was brought against Barney to recover back money paid to him as customs duties while collector of the port of New York. The suit having been removed into the Circuit Court of the United States, the defendant pleaded the statute of limitations of the state of New York. This court said (p. 530), —

> "The causes of action declared on accrued prior to the act of June 30, 1864 (13 Stat. 214, c. 171, sec. 14), prescribing the time within which actions against collectors might be brought, and while the act of February 26, 1845 (5 Stat. 727, c. 22) was in force, which preserved to parties paying duties under protest the right to maintain actions at law to test the validity of such duties. *Whatever limitation existed was to be found in the state law*, and, in this instance, in certain statutes of New York."

The court held upon the facts that the action was barred by the New York statute.

In this case, also, it will be noticed that the right of action was given entirely by the United States statute of 1845, as the court expressly says; and the action arose under the revenue laws of the United States, a subject "outside the control of state legislatures;" but it was held that to an action brought by virtue of that statute, the state statute of limitations clearly applied.

The facts appear to have been the same in *Andreae* v. *Redfield*, 98 U.S. 225, where it is stated that the action against the collector to recover customs duties illegally exacted was brought under 5 Stat. 727, being the act of 1845 above mentioned. It appears that the plaintiff's cause of action accrued prior to the act of June 30, 1864, prescribing the time of bringing such actions (p. 231). The state statute of limitations was pleaded, and was held by this court to be a good bar under section 721 (p. 235).

It is made plain also in this case that the remedy was entirely under the acts of Congress (p. 232). The court points out the various provisions of these statutes regulating exactly under what conditions the action may be brought; and says, —

> "Merchants importing goods find ample remedy *under the provisions mentioned* for illegal exactions made by collectors, and the better opinion is that it is *the only judicial remedy authorized by Congress for the redress of such grievances.*"

And again (p. 233), —

> "It is clear that the suit is in the nature of a suit against the United States."

That in these cases the right to sue depended entirely upon the act of Congress is made plain by the case of *Arnson* v. *Murphy*, 109 U.S. 238, where the history of these customs laws is clearly set forth. The act of March 3, 1839, was held by this court in *Cary* v. *Curtis*, 3 How. 236, to take away "all right of action against the collector."

Congress therefore passed the act of February 26, 1845, above referred to (now Rev. Stat. sec. 3011), providing that "any person who shall have made payment under protest," etc., "*may maintain an action in the nature of an action at law*, which shall be triable by jury, to ascertain the validity of such demand and payment of duties, and to recover back any excess so paid."

The 14th section of the subsequent act of June 30, 1864, above mentioned (now Rev. Stat. sec. 2931), was the first act of Congress which regulated the limitation of the action given by the act of 1845, providing, in substance, that the decision of the collector shall be final unless the importer protests within ten days, and appeals within thirty days to the secretary of the treasury; and that the latter's decision on appeal shall be final unless suit be brought within ninety days thereafter.

This case is instructive, not only as showing that the right of action against the collector is wholly given by the congressional statute, but also as showing the difference between a case where Congress has not provided any limitation and a case where Congress has provided such a limitation, as by the act of 1864 in this case. Here the cause of action arose after that act; and it was held that the congressional limitation governed, and the importer had a right to sue within ninety days after the decision of the secretary; and that, so long as the suit was brought within the time limited by the congressional statute, it was maintainable, and was not barred by the state statute of limitations.

These three cases seem absolutely conclusive of the case at bar; they show that *where the right of action is given by a congressional statute, the remedy is provided by the act of Congress, and the subject matter is wholly within the jurisdiction of Congress*, the question of enforcing the state statute of limitations turns wholly on the question whether Congress has chosen to enact a national statute of limitations for the subject matter. If it has not, any state statute, applicable to the form of action granted by Congress, will form a bar.

The matter of customs duties is strictly reserved to Congress; and it is settled that no state can pass a law touching imports, both because Congress has the exclusive power to "regulate commerce with foreign nations" by the Constitution, and also because the Constitution prohibits states from "laying any imposts or duties on imports or exports."

Brown v. *State of Maryland*, 12 Wheat. 419.

Here, then, is a subject matter which is more emphatically "without the control of the state" than the subject of patent laws, where there is no express prohibition of state legislation; and yet this court had no difficulty in applying the state statute of limitation.

All these decisions of this court, to which others could be added, prove clearly that it is the *action* to which the federal courts are to look in deciding whether the state statute of limitations forms a bar, and not the *origin of the plaintiff's right*, and that the argument is entirely erroneous that, because the action on a patent is given by an act of Congress and the state can pass no law concerning patent rights, therefore the state statutes of limitations do not apply. The right involved was not "within the control of the state" in these various cases, where the Supreme Court has so often applied the state statutes of limitations under section 721.

This section was intended to enable the courts of the United States to enforce the state statutes in all classes of actions at common law to which those statutes apply; and there is no authority in any decision of this court for saying that the court must look beyond the form of action into the origin of the right, and refuse to enforce the state statute if the right originated with Congress, and not with the state. In fact, there is so much express authority of this court to the contrary effect, that it is hard to account for the opinions of some circuit judges upon this question.

D. SUMMARY OF THE ARGUMENT UPON THE POINT OF PATENTS BEING WITHIN THE CONTROL OF CONGRESS.

The argument that state statutes of limitations are not a bar in patent suits, because the grant of patents is a matter wholly without state jurisdiction and "no state can pass a law affecting patent rights," is therefore wholly erroneous.

First. This argument is directly contrary to three express judgments of this court that state laws of evidence are to be applied in patent causes.

Second. State statutes are enforced in these cases, not because the states can legislate about such actions, but because *Congress* by section 721 has enacted that the state statutes shall be enforced.

Third. The statute of limitations here in issue does not affect the *right* granted by Congress to the patentee in any degree, but affects simply the remedy, as has been decided in numerous cases as to similar statutes by this court, and as to the Massachusetts statute by the Supreme Court of Massachusetts; and, consequently, it has been held by this court in *Hawkins* v. *Barney's Lessee* (and other cases cited above) that a proper statute of limitations is to be applied to bar an action, even in the very strong case where it had been provided by a compact between two states before the statute was passed, that the private right upon which the action was founded should "remain valid and secure, and should be determined by the laws then existing." Such cases clearly show that a proper statute of limitations does not affect or diminish the *right* of a patentee, but that (like the rights of the land patentees in the cases just referred to) the right still "remains valid and secure."

Fourth. It is a manifest error to argue that, because a patent can be granted only by Congress, therefore the right cannot be affected by any state legislation. We show by numerous cases that the police and tax laws of the state, and also statutes of insolvency, apply to the rights under Letters patent without question.

Fifth. We show that in several classes of cases, where the right which was the foundation of the action was granted by Congress, and was wholly "without the control of the state," the state statute of limitations has been enforced by this court; and that this court pointed out that the question, in ascertaining the applicability of the state statute under section 721, was not what the origin of plaintiff's right was, but whether the form of action was one to which the state statute applied. We show that this has been held by this court in cases where a right arose under a United States land patent, under a statute regulating the United States Land Office, and under statutes regulating the United States customs duties.

These cases seem to us to show that it is well established by the decisions of this court that the statute of Massachusetts, which applies to an action on the case, is clearly and without doubt a bar to this action upon the case, under the provisions of Rev. Stat. sec. 721, as it is wholly immaterial that the right upon which this action on the case is founded is derived from a congressional statute, and relates to a subject wholly within the control of Congress.

3 THE FACT THAT THE CIRCUIT COURTS HAVE EXCLUSIVE JURISDICTION OF PATENT CASES HAS NO BEARING UPON THE APPLICABILITY OF THE STATE STATUTE OF LIMITATIONS.

The argument has been made in several of the circuit court decisions, adverse to applying state statutes of limitations to a patent case, that the state statutes are to be enforced under section 721 only where the state courts have "concurrent jurisdiction" with the courts of the United States; and that when the national courts have exclusive jurisdiction, state laws do not apply. We find that plaintiff's brief lays great stress on this argument. No reasons are given for this doctrine, nor is any decision of this court cited to support the same; and an exhaustive investigation of the decisions of this court has not revealed any case which justifies such a contention.

On the contrary, the decisions of this court clearly establish that state courts have jurisdiction, concurrent with the United States courts, of actions arising under laws of the United States, unless Congress has chosen by statute to confer upon the United States courts exclusive jurisdiction, and there is no foundation whatever in the language or purpose of section 721 for holding that Congress intended to apply the state laws only to cases where the state courts had concurrent jurisdiction. The section is plainly intended to make the state laws (statutes of limitations, rules of evidence, statutes of frauds, etc.) rules of decision in the United States courts; and there is no suggestion that from the "trials at common law in the courts of the United States" are to be excepted those cases where the national courts happen to have exclusive jurisdiction.

THE ORIGIN AND PURPOSE OF THE EXCLUSIVE JURISDICTION OF THE CIRCUIT COURTS IN PATENT CASES.

The Constitution of the United States, art. ii. sec. 8, conferred upon Congress the power —

> "to promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

This was a power which had been recognized by the common law of England as belonging to the crown; and in this country, before the adoption of the Constitution, the states had exercised the power to grant patents within their limits. Even after the adoption of the federal Constitution, a patent granted by the state of New York was sustained by the Court of Errors of New York in an opinion by the eminent Chancellor KENT (*Livingstone* v. *Van Ingen*, 9 Johns. 507).

Congress did not at first confer exclusive jurisdiction of suits for the infringement of patents on the United States courts, though it had the power to do so under art. iii. sec. 2 of the Constitution, because these suits were "cases arising under the laws of the United States."

The act of February 21, 1793, sec. 5, provided simply that a forfeiture for infringement might be recovered in an action on the case, "in the Circuit Court of the United States, *or any other court having competent jurisdiction.* By this act "patentees and authors were left upon the same footing as suitors in general, their right to sue in the Circuit Court depending upon citizenship and the amount in controversy" (Conkling's Treatise on the Organization, Jurisdiction, and Practice of the Courts of the United States (5th ed.) p. 123).

The act of April 17, 1800, sec. 3, conferred jurisdiction in actions at law for infringement of patents upon the circuit courts of the United States, but in causes in equity the circuit courts still had no jurisdiction unless upon the ground of diverse citizenship. This was expressly decided by Mr. Justice LIVINGSTONE in 1817, in a very elaborate opinion in *Livingstone* v. *Van Ingen*, 1 Paine, 45.

In consequence of this decision, the act of February 19, 1819, was passed, providing that —

> "The circuit courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings and discoveries."

This has remained the law ever since.

It is well settled that the circuit courts had no exclusive jurisdiction of patent cases until Congress conferred it upon them by the statute above cited; and, in general, that where the right to sue arises under a statute of the United States, the national courts have no exclusive jurisdiction unless Congress has chosen to confer it upon them by statute.

This subject is very fully treated in the unanimous opinion of this court delivered by Mr. Justice BRADLEY, and often cited and approved, in *Claflin* v. *Houseman, Ass'ee*, 93 U.S. 130. The action was brought by an assignee under the national Bankrupt act in the state court, and the argument of defendant was:

> "That the cause of action arises purely and solely out of the provisions of an act of Congress, and can only be prosecuted in the courts of the United States, the state courts having no jurisdiction over the subject" (p. 133).

The court held (p. 136) that the result of prolonged discussions had been to affirm the concurrent jurisdiction of the state courts in cases arising under the Constitution, laws, and treaties of the United States, "where it is not excluded by express provision or by incompatability in its exercise arising from the nature of the particular case," and sustained the jurisdiction of the state court.

The court said (p. 136), —

> "*Rights, whether legal or equitable, acquired under the laws of the United States may be prosecuted in the United States courts, or in the state courts*, competent to decide rights of the like character and class; subject, however, to this qualification, that, where a right arises under a law of the United States, Congress may, if it see fit, give to the federal courts exclusive jurisdiction."

The court then (pp. 139, 140) refers expressly to patent cases, as follows: —

> "Thus the first patent law for securing to inventors their discoveries and inventions, which was passed in 1793, gave treble damages for an infringement, to be recovered in an action on the case founded on the statute in the Circuit Court of the United States, '*or any other court having competent jurisdiction,' — meaning, of course, the state courts.* The subsequent acts on the same subject were couched in such terms with regard to the jurisdiction of the circuit courts as to imply that it was exclusive of the state courts; and now it is expressly made so. . . .
>
> "These instances show the prevalent opinion which existed, that the *state courts were competent to have jurisdiction in cases arising wholly under the laws of the United States;* and whether they possessed it or not in a particular case, was a matter of construction of the acts relating thereto."

See, to the same effect, *In re Burrus*, 136 U.S. 586, 594, 609.

So, also, in *Insurance Co.* v. *Ritchie*, 5 Wall. 541, 542, it was held that until the act of 1833 (conferring on circuit courts jurisdiction of cases under revenue laws), "no original action by a citizen of any state against a citizen of the same state could be maintained in a national court for injuries arising from the illegal exaction of duty by collectors of revenue. *Redress of such injuries could be obtained only in the state courts.*"

The importance of this well-settled law is that it shows that *there is no fundamental distinction between those cases arising under the laws of the United States where the federal courts have exclusive jurisdiction, and those where they do not. On the contrary, it is simply a question whether Congress has chosen to enact that the jurisdiction shall be exclusive.*

Now section 721 of the Revised Statutes was originally section 34 of the Judiciary act of 1789; and therefore those circuit judges to whose adverse opinions we are now referring, would admit that, for some years after the adoption of the first Patent act in 1793, the state statute of limitations was clearly applicable to actions at law in the United States courts for infringement of a patent, because there was "concurrent jurisdiction" with the state courts.

But is there even the slightest reason for supposing that Congress, in passing the acts of 1800 and 1819, giving the circuit courts exclusive jurisdiction of these cases, intended to make the state laws inapplicable where they were previously enforced, and, further, to leave such actions without any limitation whatever?

We submit that such a proposition is an evident absurdity.

This court has thrice decided (as we have already pointed out) that the laws of evidence of the several states still were to be enforced in patent cases; and the same thing must, of course, be true of state statutes of limitation.

But, apart from these express decisions, the whole reason of the matter is against these circuit judges. The object of section 721 is to supply statutes of limitation and rules of evidence in actions in the United States courts where Congress has not specially provided them. To say that it was intended that there should be no limitations or rules of evidence, if the United States courts have exclusive jurisdiction, seems to us thoroughly unfounded in reason, as well as contrary to the language of section 721.

The only circuit cases giving any reason for the supposed limitation of section 721 to cases of "concurrent jurisdiction" are *Reed* v. *Miller* and *Anthony* v. *Carroll* (*supra*, pp. 35, 40), which say that the policy of the government was to provide a uniform system of rights "*and remedies*" throughout the United States upon the subject of patents. But this is *not* the object of the exclusive jurisdiction of the circuit courts.

In *Wilson* v. *Sanford*, 10 How. 99, 101 (in discussing section 17 of the act of 1836, which conferred exclusive jurisdiction of patent cases upon the circuit courts, and gave the right of appeal to the Supreme Court), it is well said, —

> "The peculiar privilege given to this class of cases was intended to secure uniformity of decision *in the construction of the act of Congress in relation to patents.*"

This is cited and approved in *Hartell* v. *Tilghman*, 99 U.S. 547, 552.

So, likewise, in *Hayden* v. *Oriental Mills*, 15 Fed. Rep. 605, and *Brickill* v. *City of Baltimore*, 52 Fed. Rep. 737, 739, it is well pointed out by Judge **Lowell** and Judge **Morris** that the federal courts have the control of patent cases in order to secure uniformity of decision as to the construction of the patent laws; and that this exclusive jurisdiction has nothing whatever to do with the enforcement of state statutes of limitation under section 721.

The contrary argument is the obviously untenable one that when Congress vested the Circuit Court with exclusive jurisdiction, it intended to *remove these cases* from the operation of section 34, Judiciary act, and thereby secure the extraordinary result that in patent suits there should be *no* statute of limitations, and also no rules of evidence, except those few provided by Congress.

And it would likewise follow that in cases under the Interstate Commerce act, where the United States courts have exclusive control, there is no statute of limitations, etc.

Judge **Lowell** very well points out (at page 606) that this theory of "concurrent jurisdiction" is really a misapplication of the equity cases, in which this court has frequently held that state statutes of limitations should be applied in cases where the court of equity had concurrent jurisdiction *with the court of law.*

This, of course, has nothing to do with the case at bar.

It is well settled (see *Bucher* v. *Cheshire R.R. Co.*, 125 U.S. 555, 582) that *section* 721 *does not apply to suits in equity* in the United States courts, but only to actions at law. Such is the express language of the statute.

The courts, however, have held that —

> "Courts of equity feel themselves bound, in cases of concurrent jurisdiction, by the statutes of limitations that govern courts of law in similar circumstances, and sometimes they act *upon the analogy* of the like limitation at law."
>
> *Kirby* v. *Lake Shore R.R.*, 120 U.S. 130, 138.

See *Wagner* v. *Baird*, 7 How. 234, 258.
Burke v. *Smith*, 16 Wall. 390, 401.

The absolute inapplicability of this principle to the case at bar can be seen without argument. Courts of equity bar an action on the ground of laches for a certain number of years, simply by analogy to the limitation in an action at law; section 721, on the other hand, makes the state statutes of limitations rules of decision in actions at law in the United States courts, *not by any analogy, but by the positive force of congressional enactment*; and the question whether the state courts have concurrent jurisdiction of the class of actions in which the statute is to be enforced is absolutely foreign both to the language of section 721 and to any reasoning as to the purpose of that statute.

Where the state statute of limitations, or any other state law, is applicable to a certain action at law, section 721 makes this law a rule of decision for any such action in the courts of the United States. Whether the right upon which the action is founded originated under a law of the United States, and whether the action is under the exclusive control of the courts of the United States, seem equally to be wholly irrelevant considerations.

We submit upon the foregoing brief that the ruling of the court below was plainly correct, because the plaintiff's action is barred by the statute of limitations of Massachusetts under Rev. Stat. sec. 721.

RULING THAT ACTION COULD NOT BE BROUGHT IN THE NAMES OF ALL THE ASSIGNORS.

We shall notice briefly plaintiff's first assignment of error. The ruling was correct: and if it had not been, the error was plainly waived, and the case framed to bring before this court only the issue as to the statute of limitations.

During the term of the patent a large number of persons were interested as owners of it, or of undivided portions of it, some simultaneously and others in succession. Three years after the patent expired, many, but not all, of these various owners assigned their claims to *back damages* to one Philbrook, trustee, who was to attempt to collect the same. Philbrook himself never had any interest in the patent.

This action was begun in the names of Philbrook and of *all* the former owners of the patent from the beginning, as joint owners. It was *not* begun in the name of Philbrook as trustee for the others, but in the names of Philbrook and the rest as co-plaintiffs (see the writ: Record, p. 2). At the trial, "the plaintiff, to maintain the issue on his part, introduced evidence to show that Philbrook had received all the title, as assignee, held by the several assignors during the life of the patent, and *claimed the right to proceed in one suit in the name of all his prior assignors*" (p. 15). The chain of his alleged title is complicated and defective, but we see no need of discussing it. These assignors had at no time all been joint owners of the patent, but each had, *at different times*, held undivided interests.

Moreover, at least one former owner, from 1867 to 1874, Tupper, had not assigned his right to damages (see his assignment, Exhibit C, p. 21): and certainly, therefore, Philbrook had no right to sue in his name in this action for damages; for it is settled that the assignment of a patent does not "carry with it a transfer of the right to damages for an infringement committed before the assignment."

Moore v. *Marsh*, 7 Wall. 515, 522.

The impropriety of suing in this way is shown by the fact that there was never any act of infringement during the life of the patent which violated the rights of all these plaintiffs. To prove invasion of the rights of all, it would have been necessary to show an act of infringement under each successive joint ownership: that is, one while A, B, and C were the owners of the patent, another while C, D, and E were the owners, another while E, F, and G were the owners, and so on. But each of these successive acts of infringement would have been a separate and distinct violation of the rights of parties who were not interested in any acts of infringement committed while the patent was otherwise owned. By bringing the suit in this way, the plaintiffs undertook to jumble together many distinct causes of action, to each of which there might have been a defence, — such as license or settlement, — not applicable to any of the others, and in each of which the measure of damages might have been utterly different. Such an action is without precedent in the history of actions at law.

Moreover, there was no warrant whatever for joining Philbrook, the mere assignee of a right to collect damages, as a party plaintiff.

This being the case, the court ruled (p. 15) that —

> "Philbrook could not sue in the names of all the assignors, but only in the name of the party or parties who held the entire title to the patent in suit for the time being."

The plaintiff took an exception to this ruling of the court: he, however, then "*discontinued as to all the plaintiffs named in his writ except Campbell, and proceeded in the name of Campbell*" (p. 15).

Not only did the plaintiffs thus acquiesce in the ruling of the court, and waive any exception on this point, but later, after the assignments had been introduced and Philbrook had testified to his title, the plaintiffs' counsel said (Record, p. 16) that it was admitted for the purposes of the trial that Campbell had the entire title from October 16, 1877, to December 10, 1880.

> "And for the purposes of this trial, no claim for damages is made in behalf of said Campbell after the 20th of December, 1880. And defendant's counsel replied, 'That saves *the issue* properly.'"

The judge then directed a verdict on the ground of the statute of limitations.

Thus it is plain, not only that the plaintiffs acquiesced in the ruling of the court as to the parties to the action, but also that the issue was carefully framed to bring before this court only the question of the applicability of the statute of limitations. **By discontinuing as to all plaintiffs except Campbell, and acquiescing in the ruling of the court, the plaintiffs lost the right to insist that the ruling was incorrect and that there was no misjoinder.**

Plaintiffs might have elected to have that point reviewed by an appellate court, in which case they should have refused to amend their pleadings; but in fact they elected to eliminate from the case all plaintiffs but one, and all causes of action but that of Campbell. By amending and going to trial upon the amended declaration, the record stands as though the parties struck out had never been in the case, and the ruling of the court is not open to review.

The principle governing such proceedings is shown in *Cook* v. *Castner*, 9 Cush. (Mass.) 266–273, which was an action to recover back the purchase money for a ship. At the trial in the common pleas the presiding judge ruled that under no state of the evidence could the plaintiff return the vessel and maintain the action if the mechanics at the time of the return had in fact a lien on the vessel which they had a legal right to enforce. To this ruling the plaintiffs excepted. Afterwards the plaintiffs amended their declaration by altering their action to an action for deceit, in which the verdict was for the defendants on the merits.

The court, by SHAW, C.J., held, —

"The plaintiffs now propose to sustain their exceptions taken before the amendment, and show, either that the mechanics had no lien on the vessel, or that, if they had, it did not prevent their offer to return the vessel from being sufficient. But it seems obvious that, by changing the form of action and changing the issue, that direction, whether right or wrong, had become immaterial. *The plaintiffs voluntarily changed their form of action and placed their case on the ground on which they chose to try it.* . . . This exception, therefore, is not now open for the plaintiffs."

In *Brown* v. *Saratoga R. R. Co.*, 18 N.Y. 495, the defendant's demurrer was overruled, with leave to withdraw the demurrer and to answer, which was done.

The court said, —

"*When a pleading is amended, the original pleading ceases to be a part of the record*, because the party pleading, having the power, has elected to make the change. It is upon the same principle that this demurrer, which has been abandoned by the defendants, is no longer a part of the record."

This case is cited with approval in *Campbell* v. *Wilcox*, 10 Wall. 421, 423, where this court held that "the filing of a plea to the merits, after the demurrer was overruled, operated as a waiver of the demurrer."

Such has been the uniform ruling of this court.

In *United States* v. *Boyd*, 5 How. 29, 31, 51, on plaintiffs' demurrer to defendants' rejoinder, the court gave judgment for the plaintiffs, but allowed defendants to amend their pleading. This court refused to revise the judgment of the court below on this point, saying, —

"*If the defendants had intended to have a review of that judgment on a writ of error, they should have refused to amend their pleadings, and have permitted the judgment upon the demurrer to stand.*"

In *Clearwater* v. *Meredith*, 1 Wall. 25, 42, the court held, —

> "But the plaintiff claims the right to have the decision of the court below on the sufficiency of his previous replications reviewed here. This he cannot do. Each replication in this cause is complete in itself; does not refer to, and is not a part of, what precedes it, and is new pleading.
>
> "When the plaintiff replied *de novo*, after a demurrer was sustained to his original replication, he waived any right he might have had to question the correctness of the decision of the court on the demurrer.
>
> "In like manner he abandoned his second replication when he availed himself of the leave of the court and filed a third and last one."

In *Young* v. *Martin*, 8 Wall. 354, 357, the court held, —

"The plaintiffs, instead of relying upon the sufficiency of the alleged demurrer, filed a replication to the answer. They thus abandoned their demurrer, and *it ceased to be a part of the record.*"

See, also, —

Stanton v. *Embrey*, 93 U.S. 548, 553.
Marshall v. *Vicksburg*, 15 Wall. 146, 149.
Aurora City v. *West*, 7 Wall. 82, 92.

In this case, therefore, it is plain that only the plaintiff's amended declaration is before this court, and that the first assignment of error, complaining of a ruling prior to such amendment, cannot be maintained.

As the case comes before this court, there is no party plaintiff except Campbell. The other original plaintiffs are not here. They are in no position to ask a review of the ruling of the court on this point. It must be held that the exception to that ruling was waived.

Furthermore, the ruling of the court if it were open to question is plainly correct.

Philbrook never had any interest in the patent in suit. The assignment to him was made in the year 1884 (Exhibit K, Rec. p. 39), three years after the patent in suit expired: consequently the assignment to him conveyed only the *choses in action* of the several assignors, namely, the rights to sue for and recover damages for infringements during the term of the patent.

Rev. Stat. sec. 4919, provides that —

"Damages for the infringement of any patent may be recovered *by action on the case in the name of the party interested*, either as patentee, assignee, or grantee."

[An assignee is one who holds by assignment the whole interest or any undivided part thereof. A grantee is one who has an exclusive right under the patent for a certain district.]

It is well settled, under this provision, that an action at law for infringement must be brought *in the name of the persons interested in the patent at the time of the infringement complained of*, whether as patentee, assignee, or grantee for the territory where the infringement takes place.

This is settled by *Moore* v. *Marsh*, 7 Wall. 515, which was an action at law under section 14, act of 1836, which is substantially the same as Rev. Stat. sec. 4919 above quoted.

The plaintiff had assigned an undivided half interest in the patent subsequent to the alleged infringement, but before the commencement of the suit. It was held that this was no bar to his recovery.

This court laid down the rule as to suits at law as follows: —

(P. 520:) "Where the patentee has assigned his whole interest either before or after the patent is issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place. *But where the assignment is of an undivided part of the patent, the action should be brought for every infringement committed subsequent to the assignment, in the joint names of the patentee and assignee as representing the entire interest.*"

(P. 522:) "*True meaning of the word 'interested' as employed in the last clause of the 14th section of the Patent act, when properly understood and applied, is that the right of action is given to the person or persons owning the exclusive right at the time the infringement is committed.* . . . The correct interpretation of the words 'person or persons interested' is that the words mean the person or persons interested in the patent at the time when the infringement was committed; which is the cause of action for which the damages may be recovered."

In the case at bar, it was not contended in the trial by the plaintiff Philbrook that he could sue in his own name, but he claimed to sue "in the name of his assignors." He was not "interested" in the patent *at the time of the infringement*, and the suit must therefore be brought in the name of those who were so interested at the time. *

Therefore it follows that in this case the action must be brought in the names of those who held the entire title to the patent *at the time of any infringement complained of.*

But plaintiffs attempted to join in one action persons who owned interests in the patent *at different times;* and this plainly cannot be done. The action is one of trespass on the case, and each infringement is a separate trespass. All the joint owners of the patent at any one time may sue for all acts of infringement committed during their ownership, just as the joint owners of real estate join in an action of trespass; but the *successive* owners of a patent can no more join in a suit for infringement against a person who infringed the patent during their successive periods of ownership, than can successive owners of land join in a single action for trespasses committed by the same individual during the successive periods of ownership. This is plain if we consider the simplest case, — a patent first wholly owned by A, then by B: — clearly A and B cannot sue an infringer jointly.

This seems to us to be elementary law. The interests of successive owners of a patent are several and not joint, and the damage sustained by such successive owners is not an entire joint damage. The infringement while A is owner is no damage whatever to a subsequent owner.

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* Furthermore, he was only an assignee of a *chose in action;* and in Massachusetts it is settled that such an assignee must sue in the name of his assignor (*Foss* v. *Nutting*. 14 Gray. 484: *Tucker* v. *Tucker*, 119 Mass. 79), and on such a question the state statute would prevail in the absence of the act of Congress (*Harper* v. *Butler*. 2 Pet. 239: *Wilkins* v. *Ellett*. 108 U.S. 256. 259).

The law is well settled that under such circumstances the parties cannot be joined as plaintiffs.

The plaintiff in his brief admits that he has found "no authority bearing directly upon the question" (p. 8); but we submit cases contrary to plaintiff's position:

Chitty on Pleading (16th Amer. ed.) p. 73, says, —

> "When two or more persons are jointly entitled or have a joint legal interest in the property affected, they must in general join in the action, and though the interest be several, yet if the wrong complained of caused an entire joint damage, the parties may join or sever in the action. . . .
>
> "*But as the courts will not in one suit take cognizance of distinct and separate claims of different persons when the damage as well as the interest is several, each party must, in that case, sue separately.*"

Barrett v. *Collins*, 10 Moore, 446, was an action on the case by Barrett and Hodsoll jointly against Collins, for causing them to be maliciously arrested.

Lord Chief Justice BEST held, —

> "The principle is most ably and satisfactorily laid down by Mr. Serjeant WILLIAMS in his note to *Coryton* v. *Lithbye*, viz., *that where two have a joint interest they may join in the same action, but that they cannot do so where the wrong done to one is no wrong done to the other*, as in the case of false imprisonment or assault and battery."

Aaron v. *Alexander*, 3 Camp. 35, was an action of trespass and false imprisonment. One of these defendants, Solomons, had not been concerned in those acts of which the plaintiff principally complained, and Lord ELLENBOROUGH ruled that the attention of the jury must either be confined to the joint acts or there must be a verdict in favor of Solomons.

So, in *Lathrop* v. *Arnold*, 25 Me. 136, 140, one tenant in common brought an action of trespass against an officer who seized and sold all the goods upon an execution against the other co-owner. It was held that it was proper for the plaintiff to sue alone. The court said, —

> "The general rule is, that tenants in common of personal property should join in an action to recover for an injury because the injury is joint and they recover joint damages. But the injury is not joint when the share of one tenant in common has been lawfully taken and sold, for, as respects that one, the justification is complete. The tenants in common do not suffer a joint injury, and they are not jointly interested in the damages to be recovered."

Similar principles prevail in actions of contract. In *Oliver* v. *Alexander*, 6 Pet. 143, a number of seamen joined in suing for wages under the same articles of agreement. The court held that this could be done in the courts of admiralty; but said, by Mr. Justice STORY, —

> "It is well known that every seaman has a right to sue severally for his own wages in the courts of common law, and that a joint action cannot be maintained in such courts by any number of seamen for wages accruing under the same shipping articles for the same voyage.
>
> "The reason is that the common law will not tolerate a joint action except by persons who have a joint interest and upon a joint contract. If the cause of action is several the suit must be several also."

So, in *Beckwith* v. *Talbot*, 95 U.S. 289, it appeared that a contract had been made between Talbot and two others on the one part and Beckwith of the second part, by which the latter agreed to give to each of the former a certain proportion of the increase in the value of certain cattle. Talbot sued for damages, and it was objected that he ought to have joined the other two parties to the contract. But the court held that the action was rightly brought, the interests being separate, and no one of the parties being interested in the compensation due to the others.

The same principle is shown in *Whiting* v. *Cook*, 8 Allen (Mass.) 63. The court reversed a judgment recovered by seven persons who sued jointly for a legacy which had been left to be divided equally among them; saying, —

> "The record of judgment shows that each of the plaintiffs in the former suit in which it was rendered had a distinct and separate claim and cause of action; for the provision in the will did not constitute a joint bequest, but a distinct and several legacy to each of them of their respective proportions."

In the present case, the successive joint owners of the patent at different periods had no joint or common interest and did not sustain any common injury. As we have explained above, the causes of action were quite separate, and there might well be different defences as well as different measures of damages.

For example, Tupper (who owned one eighth of the patent from 1867 to 1874) never had any joint interest in the patent with Campbell, who acquired no title until 1877; nor did any act of infringement during Tupper's ownership cause any injury to Campbell, or *vice versa*. It is plain that the two cannot be joined as plaintiffs in this action, and that the ruling of the court below was correct.

For all these reasons, we submit that the exception to the ruling of the court on the question of successive ownership does not require serious consideration.

CONCLUSION.

We submit that the statute of limitations of Massachusetts clearly applies to an action of trespass on the case, and that therefore, under section 721 of Revised Statutes, it is a rule of decision in this action.

The ruling of the court below, that the plaintiff's action was barred, was therefore correct, and the exceptions must be overruled.

FREDERICK P. FISH,
W. K. RICHARDSON,
of Counsel for Defendant.

ANSWER TO PLAINTIFF'S BRIEF.

Owing to the length of the foregoing brief, we shall answer plaintiff's brief very shortly.

Pages 22–56 thereof are concerned with the statute of limitations. This portion consists chiefly of extracts from the circuit court opinions already considered by us, which rest upon different and partly inconsistent grounds. Many of them contain mere *dicta* on the point in question.

The real ground relied on by the plaintiff appears to be (Brief, p. 23) that the state statute "can legally be applied only in cases in which the state court has concurrent jurisdiction with the federal courts."

And, again, —

> "When the state court has no jurisdiction, its remedies cannot be enforced in relation to causes over which state courts have no jurisdiction."

So, also, plaintiff's counsel argues (p. 28) that the law of the forum cannot extend to suits over which state courts have no jurisdiction; and (p. 32) —

> "This state statute of limitations affects the remedy to be sought in state courts, and depends upon its courts for enforcement. It has no force outside the territory of Massachusetts, and within that territory is limited to actions within the jurisdiction of its courts."

The above gives the substance of plaintiff's argument, and we submit that it is based upon a fundamental error. That the state legislature cannot pass laws which, *proprio vigore*, will affect suits in the United States courts is true; but the enforcement of state laws in those courts by direct congressional authority is an entirely different matter.

Plaintiff's statement that the *states* cannot pass laws to affect other tribunals than their own is sound, but irrelevant. Plaintiff overlooks the fact that it was for this very reason that *Congress* enacted section 34 of the Judiciary act of 1789 (Rev. Stat. sec. 721), making the state statutes rules of decision in the United States courts, where otherwise they would have no force. As was well said in *Hauenstein* v. *Lynham*, 100 U.S. 483, 487 (cited in plaintiff's brief), the *Judiciary act of* 1889 "*gives to the state statutes of limitations the same effect in the local courts of the United States which they had in the courts of the states which enacted them.*"

In short, the national authority has expressly provided that the laws of the state, which would of themselves have no force in any other forum than its own courts, are to be, by the force of congressional enactment, a rule of decision for the United States courts, in the absence of congressional statutes on the same topic.

The object of section 34 of the Judiciary act has been constantly so explained by this court and by the circuit courts; and the argument of plaintiff's brief seems to us to be directed to an issue which does not exist in the case at all. The brief reasons as if the questions were: Can the state of Massachusetts enact a statute for the United States court? But there is no such issue in the case, and the real question is, Shall the United States courts declare that Congress, in enacting that state laws shall be rules of decision in actions at common law in the United States courts, really meant that state laws should be rules of decision only in cases where the federal courts had concurrent jurisdiction with the state courts?

We have already discussed this point in the body of our brief; and we submit that plaintiff has advanced no reason whatever for making such an exception. Is it to be supposed that, in any case where Congress has chosen to confer exclusive jurisdiction upon the federal courts (as, for example, not only in patent cases, but under the Interstate Commerce act, or in revenue cases, or any other class of cases), there are to be no statutes of limitations, no rules of evidence, and no other laws of like character, unless Congress has chosen to provide them?

We submit that to answer this question in the affirmative is impossible; and that where Congress has not "otherwise provided," section 721 plainly makes the state statute applicable to all such actions at common law.

Plaintiff's counsel (p. 33) is much concerned with the supposition that "some states of the Union" *might be* opposed to the patent system and enact a statute of limitations "restricting the right to sue for such infringements to twenty-four hours after each act of infringement, . . . and by so doing destroy the grant which the United States has bestowed."

But, first, we are dealing in this case with a statute giving the unquestionably reasonable period of six years within which to bring actions; second, such a statute as he imagines would be probably unconstitutional and void; and, third, Congress could at any moment remedy this imaginary future evil by passing a national statute of limitations.

Whereas we have in this very action at bar an attempt to enforce stale claims which can only be barred by the state state statute of limitation.

THE JOINDER OF PLAINTIFFS.

Upon the question of proper plaintiffs, the plaintiff's brief seems to be inconsistent in some points, for it asserts in many places (*e.g.*, pp. 7, 10, 13, and 14) that Mr. Philbrook had, by assignment, the claims for "*all* infringements during the life of the patent." On the other hand, plaintiff admits (p. 12) that Tupper (who held title from 1867 to 1874), did not assign his claims for damages, which is plainly the fact. (Record, p. 21.) It further appears from the declaration that Richardson, another former owner, never assigned his right to damages accrued during his period of ownership.

Philbrook, therefore, had no right to sue in the names of either Tupper or Richardson, who were wrongfully joined as plaintiffs; and the court's ruling that the action could not be maintained as brought was plainly correct.

We are unable to find that the defendant has cited any authority in favor of joining successive owners of a patent in one action for infringement. Indeed, his brief says (pp. 8, 9), —

> "I have been unable to find an authority bearing directly upon the question involved in the first assignment of error."

We do not follow the plaintiff's argument upon this point very clearly. The substance appears to be that, as Mr. Philbrook had acquired the rights of successive owners, he had a right to proceed in one suit in their names (Brief, pp. 9, 10, 13), although plaintiff admits that (p. 13) —

> "The several assignors were not, during their respective ownership of portions of the invention, so interested with each other as to enable them to join in a suit with each other for their own benefit and use against the defendant."

But he contends that, when they assigned their respective rights of action to Philbrook, then "what in their possession had been several and distinct rights, in him became one right of action against the defendant."

We know of no foundation for such a doctrine, which would certainly lead to anomalous results. For instance, a person might go upon the estates of two separate owners in two separate townships, and in an action of trespass brought by one, he might have a good defence upon the ground of a right of way, and in the other case no defence at all; yet, according to plaintiff's doctrine, if the two owners assigned their rights of action to the same person, he could bring a single action of trespass in their names for both wrongs.

Now the rights of successive owners of a patent are no less distinct, and the defendant might have a defence against the owners during one period, and none against the owners during some subsequent period. Plaintiff's brief admits (p. 13) that defendant might "have a defence of payment to some one of the assignors." It is certain that the successive owners could not join as plaintiffs together in one action; and this is obviously because the causes of action are separate and there is no joint damage. How can it be that the assignment of those separate causes of action to one person will give him the right to join these distinct causes in a single action, especially when it is considered that, under the act of Congress, he cannot sue in his own name, but must sue in the names of the persons interested as patentee or assignee at the time of the infringement, as was expressly decided in *Moore* v. *Marsh* (cited *supra*, p. 80)? How can the court, moreover, when the question of misjoinder of plaintiffs is raised, go behind those who are named as plaintiffs in the writ and declaration in ascertaining whether they are properly joined?

The plaintiff's brief does not make it very clear whether plaintiff claims that Philbrook could sue in his own name or in the name of his assignors. But the claim *made in the court below* was (Record, p. 15) that he had the right "to proceed in one suit *in the name of all his prior assignors*," and no other claim can now be considered.

It is therefore unnecessary to consider plaintiff's cases bearing on the point whether Philbrook could sue in his own name. The point is no longer open to plaintiff; and, moreover, the act of Congress (Rev. Stat. sec. 4919) — as interpreted by *Moore* v. *Marsh* — expressly provides that the action must be brought in the name of the persons interested in the patent at the time of the infringement. The decision of Judge SAGE in *Adams* v. *Bellaire Stamping Co.*, 25 Fed. Rep. 270 (cited by plaintiff, to the point that an assignee may sue in his own name for infringements prior to the assignment), is carefully limited to the case where an assignee holds title to the patent during its term, which is not the case with Mr. Philbrook; and, furthermore, this case is contrary to the decision of this court in *Moore* v. *Marsh*, and is so recognized in Walker on Patents (2d ed.) sec. 395.

In another portion of the brief (pp. 15 *et seq.*), plaintiff discusses the applicability of the law of Massachusetts, which is that the assignee of a chose in action must sue in the name of his assignor. In the absence of a congressional statute, we think the law of Massachusetts would plainly govern; but, as Congress has provided a statute governing this question, it seems unnecessary to discuss the point.

Plaintiff contends (p. 14) — but without laying stress upon the point — that when the defendant answered to the merits in this case, it "admitted the capacity of the plaintiff to sue in manner and form as declared." The cases cited by plaintiff simply relate to the capacity of an executor or corporation to sue, which is undoubtedly admitted by an answer; but it is elementary law that in actions of tort the misjoinder of plaintiffs may be taken advantage of, not only by demurrer, but at the trial, or on arrest of judgment or by writ of error. (Chitty on Pleading, *66; *Vinton* v. *Welsh*, 9 Pick. (Mass.) 87, 90.)

But, in view of the fact that plaintiffs acquiesced in the ruling of the court on the misjoinder of plaintiffs, and amended their declaration, further discussion of this point is unnecessary.

FREDERICK P. FISH,
W. K. RICHARDSON,
of Counsel for Defendant.

NOV 20 1894
JAMES H. McKENNEY,

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1894.

No. 87.

CHRISTOPHER C. CAMPBELL,
Plaintiff in Error,

v.

THE CITY OF HAVERHILL.

BRIEF IN REPLY FOR PLAINTIFF IN ERROR.

HARVEY D. HADLOCK,
[illegible]

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BRIEF IN REPLY FOR PLAINTIFF IN ERROR.

Harvey D. Hadlock,
Of Counsel.

FIRST.

Reply to argument of counsel for defendant in support of the ruling that action could not be brought in the names of all the assignors.

The patent had expired before Mr Philbrook acquired an assignment which conveyed to him all the rights that had, during its life, accrued to the several owners. The patent was not in existence as a patent when he came into possession of the right to damages which had arisen by reason of the infringements of the defendant, and the rule that would apply to several owners of a patent, and prevent them joining in suit during the term of its protection, had ceased. The suit was for the sum due to the owners of the patent while it was protected. That sum had been assigned by each of the owners so that it all vested in Mr. Philbrook at the date of the writ. His claim against the defendant was the aggregation of all the sums assigned. He then stood in the position of an assignee who had acquired several distinct outstanding claims, all of the same nature, against the defendant. The claim as it then stood was a unit as against the defendant, notwithstanding it had risen from several distinct infringements against several owners of the patent. But notwithstanding these facts, it is urged that Mr. Philbrook should have brought separate actions covering the time when each of his assignors owned in the patent.

Counsel, on page 75 of defendant's brief, say that

> "the plaintiffs undertook to jumble together many distinct causes of action, to each of which there might have been a defense such as license or settlement not applicable in any of the others and in each of which the measure of damages might have been utterly different."

The reason stated in the above quotation might possibly apply to a joint action by owners of a patent during the term for which it was granted, but after it had expired and all the claims against the defendant had been assigned to one person, I fail to see how the defendant could be prejudiced in any defense he might have to the suit, as the assignees had no greater right than his assignors, and that which would have been a defense against them would be a defense against their assignees.

And if the defendant could have defended against any assignor, such defense would avail it to the same extent that it would have availed against the assignor, and to that extent reduce the amount of damages claimed.

It being well settled that an owner in a patent may assign his claim for damages caused by infringements, so as to entitle the person to whom he assigns to bring a suit in his own name under the laws of the United States, I submit that when all the claims for damages against any person or corporation vest in one person as assignee, he may bring a suit in his own name or join with him all of his prior assignors in the action so long as he fully discloses the capacity in which he sues.

Moore v. *Marsh*, 7 Wall., 515.

At the date of the writ Mr. Philbrook, as the record discloses, was the only person who could enforce a claim against the defendants as the original owners had parted with all their rights, to claim damages against the defendant, and the legal reasons that under certain conditions might be urged in support of a plea for misjoinder would under the facts stated in the declaration have no application to the case at bar.

There was no misjoinder because of different causes of action, for they were the same, and all growing out of the wrongful acts of the defendant. If there had been a misjoinder, then the defendant should have pleaded such misjoinder in abatement or raised that objection in his answer.

Gould's Pleadings, c. 5, sections 111-113.

The declaration stated all the grounds of Mr. Philbrook's claim, and, therefore, was sufficient in law.

Mr. Philbrook asserted but one claim made up of several acts, the right to recover for which had been legally assigned to him, then why should he be obliged to bring several suits when all the rights of the defendant could be protected in one suit?

The doctrine of misjoinder had its origin in the desire to protect the defendant in his defense and required that the demands of the plaintiff should be separately and distinctly stated.

In the case at bar, under the pleadings, there could be only one recovery and Mr. Philbrook was entitled to that, and, if he pursued a claim which the evidence failed to sustain, to the extent of such claim, he could not recover, but that fact would not prevent such recovery as his evidence warranted.

It is urged, on the part of the defendant, that, after the plaintiff took an exception to the ruling of the Court, "Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties who held the entire title to the patent in suit for the time being," he discontinued as to all the plaintiffs named in the writ except Campbell and proceeded in the name of Campbell, and thereby waived his exception.

The discontinuing as to all other parties was not a waiver of the exception which had been taken by the plaintiff, as the record shows, and from the state of the pleadings in the case it was otherwise impossible to preserve his rights.

If the defendant had raised the question of misjoinder by a proper plea, which would have admitted of a final judgment, it would have enabled the plaintiff to have saved his rights by a bill of exceptions.

The case cited in the 9 *Cush.* (*Cook* v. *Castner*) 266-273, related to an abandoned action, and an amendment which instituted an entirely different cause of action, and therefore an exception taken in a cause which was abandoned and not tried could not lie. Mr. Chief Justice Shaw in the case cited said: "The plaintiffs voluntarily changed their form of action and placed their case on the ground on which they chose to try it." And therefore held that the exception after the first action had been abandoned and another substituted upon which a verdict had been returned was not open for the plaintiffs. In the case at bar no change in the cause of action was made, but the plaintiff, Philbrook, was by the ruling of the Court obliged to limit the scope of his claim for damages by striking out some of the parties whom he had joined in his writ.

The cause of action remained the same, the right of recovery had been limited, but the action remained, and therefore the reasons which governed in the case cited has no force in the case at bar.

The Federal cases cited on pages 78 and 79 of defendant's brief all relate to abandoned pleadings and contain none of the elements found in the case at bar, and are not pertinent to the state of facts disclosed by the record in this case.

SECOND.

It was error in the Circuit Court to rule that the action could not be maintained by Ruel Philbrook as brought, and to hold that said Philbrook could not sue in the name of all the assignors, but only in the name of the party or parties who held the entire title to the patent in suit for the time being,

It was not necessary that Mr. Philbrook should have had title in the patent in order for him to sue in his own name, joining his assignors with him. The right to sue for past infringements are assignable even after the expiration of the patent, like any other *chose in action*, and such an assignment takes effect only as an assignment of claims for past infringements.

May v. *Saginaw Co.*, 32 Fed. Rep., 629.
May v. *County of Logan*, 30 Id., 250.
Robinson on Patents, section 790.
Bell v. *McCullough*, 1 Bond, 194.

A *chose in action* is a right of proceeding in a court of law to procure the payment of a sum of money.

The several assignors through whom Mr. Philbrook claimed had that right, and it passed to him, and what in them had been several and distinct rights became merged into one cause of action against the defendant made up of several distinct acts.

His right to bring one suit in his own name setting forth all the acts of the defendant in his declaration which constituted the basis of his claim should be conceded.

If he had brought six distinct suits, one in the name of each of his prior assignors, and entered said action at the same time in the Circuit Court, would that Court have been warranted in consuming its time and putting the plaintiff to the expense of six separate jury trials in order to determine what could be readily determined in one trial?

If such actions had been so brought, would it not have been proper for the Court to order them to be consolidated and tried as one action?

If several persons should assign wages due them from a corporation, would it be necessary to bring separate actions against such corporation in order to recover the aggregate amount of wages so assigned?

The defendant could not be prejudiced in its defense for want of separate writs, as the grounds of action were fully stated in different counts, as the plaintiff would only be entitled to recover on such counts as his evidence sustained.

That the right of action to recover damages to property may be assigned is well settled.

Gillett v. *Fairchild*, 4 Denio, 80.
North v. *Turner*, 9 Sergt. & R. 244.
Lazard v. *Wheelen*, 22 Cal. 142.

And it is a well established rule of pleading:

" That where several causes of the *same na-*

> *ture* exist between the same parties, all accruing to the plaintiff in the *same right*, and against the defendant in the *same character* or capacity, they may all be joined by several counts in one declaration. For there is no principle of law, limiting a suit to a single cause of action; and where several rights of recovery can be enforced as well by one action as by several a joinder of them is advantageous to both parties and favored by the policy of the law."
>
> *Goulds' Pleadings*, sec. 79, page 196.

The declaration states the period of ownership of each person in whose name Mr. Philbrick brought suit, and the amount of damages claimed for each year during the period of infringement, so that the defendant had full notice of the claim under each person named as a plaintiff, and such defense to any assigned claim as would be available to the defendant could be urged in its defense.

The form of action in this suit as it stood before a discontinuance was ordered, I submit, preserved all the rights of parties, and tended to a speedy and economical determination of the rights involved, and therefore the order of the Court was unwarranted, and the first assignment of error should be sustained.

THIRD.

Reply to Contention of Counsel on pages 4 and 5 of Defendant's Brief.

The argument for defendant, on page 5 of its brief, attempts to show that an action on the case for an infringement of a patent is a common law remedy, and cites *Chitty on Pleadings*, p. 139, to show that such an action lies for infringement.

And in support of that proposition mentions the venerable statute, 21 James I., c. 3, of May 25, 1624, which provides that all matters concerning letters patent * * * shall be forever hereafter examined, heard, tried and determined by and according to the common laws of the realm, and not otherwise.

It is admitted that there was no provision in the statute as to what the form of action should be. But it is urged that it has been held by all the English authorities that actions on the case was the obvious form.

If that was the proper form of action under the English law, it does not follow that such form of action can be maintained in the common law courts of the several States of the Union in suits for the infringement of patents, as those courts have no jurisdiction over such litigation, and the pleadings in the several States of the Union have no application, as Congress has provided the form of action in such cases, and conferred upon the Federal courts exclusive jurisdiction over such litigation. The English statutes and common law are enforced in the courts of the realm, and those courts have plenary jurisdiction over all suits, and no distinction is made between suits for the infringement of patents and other suits.

In the United States the jurisdiction of the Federal courts is fixed by statutory grant and the common law jurisdiction pertains exclusively to the State courts; except so far as common law has been adopted by Congressional enactment. Here we have two independent sovereignties exercising jurisdiction over cases of the same class within the territorial limits. But in cases based upon the infringement of patents the exclusive jurisdiction is vested in the Federal courts, and the courts of the States are excluded from jurisdiction in such cases; therefore the reasons which pertained to the jurisdiction of the common law courts of England and of the several States of the Union are not germain to this discussion. The contention that State statutes of limitation apply to patent suits is unsound. It is urged in behalf of the defendant corporation (*Deff's. brief, pp. 8, 9, 10 and 11;*) that the provisions of section 721 of the Revised Statutes of the United States has by express terms adopted the State statute of limitations to suits for the infringement of patents; but counsel fails to cite a single authority in support of the contention relied upon. The cases cited are such as arose in suits over which both Federal and State courts had jurisdiction, and therefore the question now before the court could not be, and was not considered.

It would be an inexcusable waste of time for counsel to discuss the cases which have been determined where the subject matter of the suit conferred jurisdiction on both State and Federal courts, and thereby endeavor to controvert the attempt to create an analogy between such cases and the one at bar, as the negation of the proposition contended for is axiomatical.

The contention that statutes of limitation must be applied to actions in patent suits because no Federal statute of limitations now exists, is based upon no line of reason of sufficient merit to command the attention of the court.

The only reason advanced in support of the proposition is the fact that Congress in 1870 enacted a statute of limitations to patent suits, and in 1874 repealed that statute, and, therefore, it is urged that "Congress undoubtedly believed that when the limitation imposed upon actions for infringement of patents by the act of 1870 was repealed, the State statutes would again be applicable."

In answer to this proposition, I submit: *First.*—If Congress had considered the State statutes of limitations applicable to patent cases under section 721 of R. S. of the U. S., it had no occasion to enact the act of 1870.

Second.—If section 721 was for the purpose of creating an uniformity of limitation in the State and Federal Courts, then no additional legislation was necessary, as the act of 1870 in many States created a diversity between the limitations applied by the State Courts and the period of limitation created by the statutes of the United States.

Therefore, it follows from the statement contained in the brief for the defendant, on page 13, that Congress did not in 1870 consider State statutes of limitations applicable in suits for the infringement of patents, and therefore the repeal of a law could not restore a State law of limitation to a class of actions to which it had no application when the Federal statutes of limitation were enacted.

If State statutes of limitation were a part of the law of the forum in 1870 in patent suits, why did Congress enact an independent statute of limitations?

If Congress intended that States statutes should be applicable to patent suits, why did it neglect to make that declaration, when, in 1874, it repealed the act of 1870? The cases cited on page 12 of the defendant's brief, were actions at common law, and not within the exclusive jurisdiction of the Federal Courts, and, therefore, cannot have weight in determining the question now at bar, as it is conceded that in cases in which the State and Federal Courts have conclusive jurisdiction, the law of the State, under the provisions of section 721, are applicable.

FOURTH.

It is urged that it is a reason for applying the State statute of limitations that no other limitation exists.

The language on page 13 of defendant's brief is as follows:

> "Under the decisions of the court, it is a material consideration that if the State statute of limitations does not apply, there is no statute of limitations to bar an action at law in patent causes, and such an action may, therefore, be brought after any lapse of time, no matter how long; a court of law has no such power as a court of equity to refuse to entertain a case upon the ground of laches, and, in the absence of a statute of limitations, the action whenever brought must be entertained."

And for the reason above quoted asks this court to assume the function that belongs exclusively to the legislative branch of the government, and, by construction, re-enact a statute which Congress has repealed.

Certainly it would be, in effect, a re-enactment of a statute of limitation to hold that State statutes of limitation apply in the case at bar, as well as to give a construction to section 721, heretofore unknown, and wholly unwarranted by its terms.

Because it must be evident that Congress enacted the statute of 1870 for the express purpose of providing a limitation to suits in patent cases and did not extend that limitation to any other class of suits, for the reason that in other suits except those over which the Federal courts had exclusive jurisdiction, the State statutes of limitations were applicable in the Federal courts.

The defendant's brief on page 14 contains these words, "and it will be a material consideration in guiding the judgment of this Court, that if the state statute of limitation is not applicable, there is no statute of limitations at all to govern this class of actions." How the fact that because Congress has not seen fit to create a period of limitation in which suits for the infringement of patents may be brought can be material in guiding the judgment of this court to a conclusion, that it devolves upon it to create by application of a state statute a statute of limitation is not readily comprehended when the three distinctive, yet co-ordinate powers of our Government are taken into consideration.

I repose in the knowledge that this Court has never since its organization assumed the functions of the legislative department, and that exigencies, be they ever so great, cannot exist which will induce it to depart from its ancient ways and extend its powers beyond the bounds of its jurisdiction and assume the powers which, under the constitution, belong exclusively to Congress.

FIFTH.

It is contended, page 19, (defendant's brief), that the State statute of limitation furnishes a rule of decision in any action in the United States Courts.

And in support of this contention cite *Vance* v. *Campbell*, 1 Black, 427. It will be obvious from an examination of this case that it does not support in the slightest degree the position assumed by the defendant. It holds that the law of evidence in the State in which the Federal courts are held shall be observed by the Federal courts and applied in cases where such application shall not contravene the laws of the United

States; but the reason of the Court in *McNeil* v. *Holbrook*, shows that the courts look upon such laws in the same light as laws of a State in relation to property, in other words, as a vested right in the citizens of the State in which the Federal court is held, and therefore the peculiar privilege of those who seek the Federal forum in such States. It related to the law of jurisdiction and did not affect the remedy. The statutes of limitation do not relate to the law of procedure, but affect the remedy, and if such statutes were applicable in a case where the Federal courts have exclusive jurisdiction, then it follows that the right to sue for infringements in the Federal courts confrered by Congress would be subject to the pleasure of the several States. That would be the result of the contention urged on behalf of the defendant. The remedy which Congress has given over which the Federal courts have exclusive jurisdiction, would be subject to State laws, and, therefore, the exclusive jurisdiction would be of small value if allowed to be curtailed by the laws of a State.

In *O'Neil* v. *Holbrook*, *supra*, Mr. Chief Justice Taney, said:

> "The 34th Section of the Judiciary Act, establishing the courts of the United States (1789, ch. 20), provides, 'that the laws of the several States, except where the Constitution, Treaties, or statutes of the United States shall otherwise require or provide, shall be regarded as a rule of decisions in trials at common law in the courts of the United States, in cases which they apply.' We do not perceive any sufficient reason for so construing this Act of Congress as to exclude from its provisions those statutes of the several States which prescribe rules of evidence in civil cases; in trials at common law. Indeed, it would be difficult to make the laws of the State in rela-

> tion to the rights of property the rule of decision in the circuit courts without associating with them the laws of the same State prescribing the rules of evidence by which the rights of property must be decided. How could the courts of the United States decide whether property had been legally transferred, unless they resorted to the laws of the State to ascertain by what evidence the transfer must be established ? In some cases, the laws of the States require written evidence ; in others, it dispenses with it, and permits the party to prove his case by parol testimony, and what rule of evidence could the courts of the United States adopt to decide a question of property, but the rule which the legislature of the State has prescribed ?
>
> The object of the law of Congress was to make the rules of decision in the courts of the United States the same with those of the States, taking care to preserve the rights of the United States by the exceptions contained in the same section. Justice to the citizens of the several States required this to be done, and the natural import of the words used in the Act of Congress includes the laws in relation to evidence, as well as the laws in relation to property."

This extract shows the reasoning of this Court in the leading case on the adoption of State laws as rules of evidence. The other cases cited in Vance *v.* Campbell, *supra*, simply follow it. From this extract the reason for following the laws of the several States as to evidence and the connection of such laws to property rights becomes apparent.

In *Vance* v. *Campbell*, the Court said :

> "This section has been construed to in-

clude the rules of evidence prescribed by the laws of the States in all civil cases at common law not within the exception mentioned.

The point has not perhaps been expressly decided in a case reported in this Court; but the principle has been recognized in several cases.

> *McNeil* v. *Holbrook*, 12 Peters, 89; *Sims* v. *Handley*, 6 How. 1; *U. S.* v. *Reid*, 12 How. 361."

I submit that no analogy exists between the case of *Vance* v. *Campbell* and the case at bar. That case related solely to the proceedings in Court irrespective of the remedy. This case relates only to the remedy given by Congress and not conferred by State law, and as the remedy exists by virtue of statutes of the United States in relation to the subject matter of the suit over which the Federal Courts have exclusive jurisdiction, it is within the exception contained in section 721; and therefore the rules of decisions and laws of the State of Massachusetts do not apply.

The only answer necessary to make to the argument for defendant, based upon pages 22 and 23 of its brief, is, that the subject matter of the case of *McClary* v. *Stillman*, 3 Pet. 270, was within the concurrent jurisdiction of the State and Federal Courts.

> *Anthony* v. *Carrol*, 2 B. & A. 195.

As to the comments of defendant's counsel upon the decisions of the Circuit Courts which have held that State statutes are not rules of decisions in patent cases, I am content to have these opinions speak their own reply, as I believe them to be sufficiently sound to refute whatsoever of criticism has been urged against them.

SIXTH.

It is contended on behalf of the defendant that if a State should pass a statute of limitations which did not give a patentee, or any other person, a reasonable time within which to sue, such statute would be unconstitutional and void.

This is a somewhat remarkable proposition. It assumes that a State statute which would give too short a time of limitation in a case like the one under discussion would be by the Federal courts declared unconstitutional. But it would be constitutional in the State courts in all cases other than those based upon contracts in which the Federal courts have concurrent jurisdiction. The cases cited in support of this proposition were based upon contracts, such as give concurrent jurisdiction to the Federal courts, and therefore the validity of the State statute might well be questioned; but in cases not involving contracts, over which the Federal courts have no jurisdiction, the constitutional question could not be raised in the Federal courts.

It is urged that the constitutional question could be raised under the prohibition of laws impairing the obligation of contracts. But certainly that proposition is not sound as stated, as the remedy which is alone to be affected by the State statutes of limitation would not affect the contract in the sense in which the words "laws impairing the obligation of contracts" are used.

Mr. Justice SWAYNE, in speaking for the Court in *Walker* v. *Whitehead*, 16 Wall., 314, said:

> "The constitution of the United States declares that no State shall pass any 'law impairing the obligation of contracts.' These proposi-

> sitions may well be considered consequent axioms in our jurisprudence. The laws which exist at the time and place of the making of a contract, and where it is to be performed, enters into and form a part of it. This embraces alike those which affect its validity, construction, discharge and enforcement."

As appears by the above quotation, the constitutional provision relates to contracts. What contract existed between the plaintiff and the defendant in the suit, from 1864 to the date of the writ?

The action is for an infringement, a tresspass, and the defendant is charged as a *tort feasor* in an action of trespass on the case specially provided by Congress to meet such acts of infringement as are charged against the defendant. When was a contract between plaintiff and defendant made so that this case may be brought within the constitutional provision against the impairment of contracts?

Suits for infringements such as counsel for defendant contends would fall within the constitutional provision are not based upon contracts with the infringer; (for such contracts would be within the jurisdiction of the State Courts); and therefore the reasoning on this point is unsound in law and has no application to the case before the Court. Neither are the authorities cited on pages 43 and 44, of defendant's brief pertinent.

If the State should pass a statute of limitation for a period of thirty days in which suits for trespass on the case could be brought, would that affect any vested right or impair the obligation of contracts?

The remedy for infringements would be limited if defendant's contention be sound; so that after the passage of such act suit would be legally limited to thirty days.

If the State should go further and provide that no suit for infringement of patents should be brought in the courts of the State, would that exclusion be held to apply to the courts of the United States held in such State? And yet such an act would not be unconstitutional, because the courts of the State could not entertain such a suit, and it would only be a declaration that its courts were excluded from entertaining jurisdiction in such cases.

If it be urged that such a statute would be unconstitutional, as claimed by the defendant, the question would naturally be asked, on what ground is it unconstitutional, and I submit that would be a troublesome and difficult question to answer. Certainly a State would have a right to declare that its courts will not entertain jurisdiction over a certain class of cases, and it may also limit its common law jurisdiction.

But counsel, on pages 43 and 44 of defendant's brief, claim that a law providing a short limitation would be unconstitutional, as such a limitation would violate the fourteenth amendment of the Constitution of the United States, which contains this provision: "Nor shall any State deprive any person of life, liberty or property without due process of law."

I submit that this is a most extraordinary claim when viewed in the light of the definition heretofore authoritively given to the words "due process of law." Miller on the Constitution of the United States, page 664, defines "due process of law" in these words:

> "Law, in its regular course of administration through the courts of law is due process of law, and when it is secured by the law of the State, the requirements of the fourteenth amendment are satisfied. Due process of law within the meaning of that amendment is secured if the laws operate on all alike and do not subject the individual to an arbitrary exercise of the powers of government."

This definition, I submit, fully negatives the proposition contained in defendant's brief, and demonstrates the contention of its counsel on the constitutional position taken in argument to be unwarranted by constitutional law.

Counsel for defendant, on page 44 of its brief, say:

> "So, also, a law limiting the time for bringing actions of trespass on the case, unless it allowed a reasonable time, would be unconstitutional equally as to an owner of real property and an owner in letters patent."

The question of reasonable time according to this view would depend upon the views of the Judge who might hold the Court and would be addressed to his discretion "based upon all the circumstances of each case," and to such discretion exceptions would not always lie, so that the statute of limitations under such conditions would be as uncertain as Lord Selden claimed the scope of equity jurisdiction to be when he asserted that it was so uncertain that it might well be made to depend upon the size of the Chancellor's foot.

In the language of LORD CAMDEN:

> "The discretion of a judge is the law of tyrants; it is always unknown; it is different in different men; it is casual, and depends upon constitution, temper and passion. In the best, it is oftentimes caprice; in the worst it is every vice, folly, and passion to which human nature is liable."

Under such a rule for the application of State statutes to cases within the exclusive jurisdiction of the Federal Courts, what would become of the uniformity of decisions so much desired, and who could advise as to whether a cause of action would or not be able to run the gauntlet of judicial discretion, "based upon all the circumstances of each case."

The authorities cited in support of this contention on page 43 of defendant's brief were based upon contracts, and the statutes considered in those cases passed after the contracts had been entered into, struck at the heart of such contracts for the purpose of destroying their life, and therefore those cases give no support to the proposition stated by counsel for the defendant.

But if the contention that the laws of a State, by virtue of section 721 of the United States Revised Statutes, are, by adoption, laws of the United States, be sound, which proposition I constantly deny, then any act of State limitations which existed at the date when a patent was granted would be a part of the law under which the grant was made, and therefore not within the constitutional prohibition; as that inhibition is directed to laws passed after the contract is in being, so that a State could, without infraction of the constitutional restriction, pass such laws of limitation in cases of trespass on the case as would limit the right to bring suit in such cases to thirty days or even to a less period of time, and such limitation would apply to all patents granted after the enactment of such a law.

Such a construction would enable any State to, in effect, make void all letters patent infringed within its jurisdiction and thus extinguish the right granted by the United States.

It is also contended on behalf of the defendant, in support of the proposition above quoted, that such a law would, in Massachusetts, be obnoxious to article eleven of its constitution, which provides that "every subject of the Commonwealth ought to find a certain remedy by having recourse to the laws for all injuries or wrongs which he may receive in his person, property or character."

If Massachusetts should under this provision of its constitution pass an act that all persons who suffered from the infringement of patents and all other actions formerly known as trespass on the case, within her borders, should have an action for redress for such infringements in the courts of the commonwealth, provided such action should be brought within thirty days after every act of infringement, would that give the courts of Massachusetts jurisdiction over suits for the infringement of patents on the ground that "every subject of the commonwealth ought to find a certain remedy for all injuries or wrongs which he may receive in his person, property or character?"

It will not, I presume, be contended that such an act would create concurrent jurisdiction with the Federal courts in patent cases, and thereby deprive the Federal courts of the exclusive jurisdiction conferred by Congress.

Yet the limitation would apply to all actions of trespass on the case over which the court had a common law jurisdiction, and also to such acts as the State Legislature might provide for, and designate a remedy by an action on the case, and as to such actions whenever the Federal courts had concurrent jurisdiction the Statute of Limitations would apply so that there might be a uniformity of decisions in both Federal and State courts.

But where there is no concurrent jurisdiction there can be no uniformity of decisions.

The name of the action does not confer jurisdiction on the Court, and to entitled proceedings under a classification within the jurisdiction of the Court, and then state facts which disclose that the Court has no jurisdiction over the subject-matter of the suit, will not confer jurisdiction upon such Court.

Defendant's brief, on page 6, contains these words: "The form of action pursued in the case now before the Court is the old common law remedy for the infringement of a patent, and not a peculiar form of remedy originated by any act of Congress," and counsel have argued that because the form of action was such as the common law Courts provided for infringement of patents, that therefore all the statutory limitations of a State are applicable thereto.

I now state, as a proposition of law, that the laws of a State must depend upon its courts for enforcement; and must relate to matters within the jurisdiction of its courts.

And that laws passed by a State which relate to matters other than such as are within the jurisdiction of its courts have no effect.

Therefore it follows that as the Federal courts have no original common law jurisdiction, the forms of the common law, only so far as adopted by legislative enactment, are not adapted to the procedure of the Federal Courts, and that when congress provided a form of action to be used in suits for infringements of patents and conferred exclusive jurisdiction on the Federal courts, the statutes of the States regulating rights, remedies and action in the common law courts ceased to apply to suits in the Federal courts for the infringement of patents.

SEVENTH.

The Objection that Patents are Within Congressional Control.

Under this heading, page 47 of defendant's brief contains the following language:

> "This view, as it seems to us, is based upon several misapprehensions, and it *must be remembered throughout that a perfectly reasonable statute, applicable to all actions of tort, is at issue in this case and not any law aimed directly at owner of patents.*"

The fundamental error is in the failure to see that the State statute is to be enforced, not because the State can affect patent rights by legislation, but because Congress had enacted that such statutes shall be enforced in the United States courts.

Section 721, upon which the contention in behalf of the defendant is based, is as follows:

> "The laws of the several States, except where the Constitution, treatises or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in the courts of the United States, in cases where they apply."

The words "in cases where they apply" are significantly potent, and limit the application of the laws of the several States to cases where such laws apply. I have heretofore urged that a State law can only apply to cases that are within the jurisdiction of its courts and to the Federal courts only when such courts have concurrent jurisdiction with the State courts.

That such State laws do not apply to patent suits is obvious, and it requires no argument to enforce a self evident proposition.

The reasoning of defendant's counsel to the effect that because a State law is applied by the Federal courts to causes of action within the jurisdiction of the State court for the purpose of maintaining an uniformity in the decisions and rules of proceeding in courts of concurrent jurisdiction, that such State statutes should be applied, even in cases where no concurrent jurisdiction exists, is, to say the least, illogical. The reason for which the act, now section 721, of the Revised Statutes of the United States was passed ceases when the jurisdiction in the Federal courts becomes exclusive, and only exists when it is concurrent, and therefore when the reason for which the law was enacted ceases the law itself in its application ceases.

But counsel assert (page 54, defendant's brief) that many State laws have been held to affect patent rights and cites several cases in which the powers of States to enforce police regulations have been considered. The case, I respectfully submit, have not the slightest bearing on the case at bar. The maxim "*sic utere tuo ut alienum non ledas*" applies to all property, and if a person had property in an invention, he is not thereby exempted from the general rules of society and the police regulations established for the protection of personal rights, and, therefore, so far as patent rights are property, such rights fall within the rules and regulations established by law in relation to property, which may be enforced in the State courts, and only in the Federal courts when the necessary diversity of citizenship exists. The right of property in a patent is like other property, and must be determined by the rules of procedure governing property rights, but the laws of a State cannot be extended beyond their just application, for to so extend them would be to violate the exception which acts as an exclusion, namely, *the laws of the States are rules of decisions only in cases to which they apply.*

That such State laws do not apply to patent suits is evident, as it must be assumed that when Congress created a form of action and gave the exclusive jurisdiction of such suits to the Federal courts, it provided a complete and unrestricted remedy, which continued until 1870, when Congress provided a statute of limitation which, after being in force for a period less than four years, was repealed. The reasons for the repeal may be conjectured as appears from the following language found in *Robinson on Patents*, Vol. 3, sec. 980 :

> "While it was in force its construction was disputed, some authorities deciding that a cause of action arising under the original term of a patent was barred in six years after the expira-

> tion of that term, although the patent might have been extended ; other regarding the original and extended terms as legally but one, and the statute inoperative against any right of the action until six years had elapsed after the patent had finally expired."

The application given to the statutes by the courts may well have caused the repeal of a limitation as not being appropriate in such cases. It fixed a limit under the construction in *Sayles* v. *Lake Shore and Mich. So R. R. Co.* which would virtually limit all actions for infringement to a period of six years after the expiration of the patent, and if the validity of the patents should be contested, and I can safely assert that the validity of all valuable patents are contested, and every obstacle put in the way by defendants to prevent a final determination of that question, the six years would in many cases elapse before the validity could be authoritively determined, and as said in *Colgate* v. *Goldsmith*, 16 Blatchf. 503: "You cannot expect a patentee to litigate with all the world," and I will add that it would be impossible for a patentee in a patent, such as involved in the case at bar, to litigate with all infringers in the United States at one and the same time. Thus many of those who have infringed during the period when the United States statute of limitations was in force escaped liability for their wrongful acts. The case at bar was commenced more than seven years ago, and has been pending in this court for more than four years.

But the statute now contended for by the defendant corporation would not apply to the expiration of the patent but to each act of infringement, so in no instance could an action at law be maintained unless suit should be brought within six years from each infringing act. Thus it would be readily perceived that patents would be of little value to the patentee, as the infringers would be secure after six years from from the time each act took place, and the patentee would be obliged to load himself with actions and all the expenses incident thereto, while the validity of his patent was being contested, or his right to damages would be lost.

When the fact is taken into consideration that infringements are not often openly made, but concealed as much as possible, the construction for which counsel contends becomes not only mischevious, but ruinous to patentees.

Congress evidently became aware that a statute of limitation tended to make worthless the granted protection which the government bestowed for inventive genius, being undoubtedly convinced that from the very nature of things acts of infringement in the main, have been and will be surreptitious and difficult of detection ; repealed the statute, so that the patentee might have an opportunity of reaping the benefit that the government had granted him, whenever he discovered his patent had been infringed.

And in this connection Congress undoubtedly was not unmindful of the fact that infringing acts are within the knowledge of the infringer, and that he alone is in a condition to show the exact amount of his gains, savings and profits by reason of the use of the infringed patent, as also the extent to which it was used, and therefore no statute of limitation was necessary to create a presumption of compensation, in his behalf, for the wrongs inflicted upon the patentee. Evidently Congress did not consider the infringer entitled to a statute of repose. I now submit that State statutes of limitation cannot be applied to suits for the infringement of patents without virtually destroying many, if not all, of the benefits granted by the government to inventors.

Therefore, I insist, that State statutes of limitation do not apply to patent suits, and that they are within the restriction, to which the laws of a State do not apply, and that the statutes of the United States which provide a remedy against infringement for the benefit of inventors require that such State statutes shall not apply. The provision in section 721, in these words: "Except where the Constitution, treaties or statutes of the United States otherwise require or provide," so restricts the section, that it devolves upon the Court to say what statutes of the United States require exemption from the laws of the several States, "as rules of decision in trials at common law."

Much has been said by counsel for defendant in relation to the constitutional provision against the impairment of contracts, and cases have been cited which to my understanding are not pertinent to, and do not sustain the position of the defendant; but which cases I now refer to as applicable to my contention against the State statute of limitations.

Robinson on Patents, vol. 1, sec. 40, page 58, says:

> "As a grant of temporary protection in the exclusive use of a particular invention, on condition of its immediate publication and eventual surrender to the people, it is an act of compromise between the inventor and the public wherein each concedes something to the other in return for that which is conceded to itself. In this latter character it is a true contract, to the stipulation in which each party is bound with the same strictness as in any other contract, and which is to be interpreted in the same manner as other legal obligations. That portion of the contract by which the public grant protection to the inventor, being intended for his benefit, should be liberally construed, in order to secure to him in its fullest extent, the protection to which he is entitled."

The people here referred to are the people of the

United States in its independent sovereign capacity, as citizens of the United States. And the contract that exists between the inventor and the public is protected by the constitutional provision which forbids the States from passing any "law impairing the obligation of contracts."

And State laws which would deprive the inventor of a right to recover for damages, which under the patent laws of the United States accrue to him during the term of his patent, would seriously impair the obligation of the contract entered into by the public with the inventor, and would, therefore, be void, and being void would not affect his right to recover. Congress has not made any limitation to the time when suit must be brought and the laws of the United States in relation to suits for infringement, which existed when the patent in suit was granted became part of the contract to which both parties were bound, save and except so far as it might be modified by Congressional action. The contract in the case at bar, between the inventor and the public, evidenced by the letters patent which fully state the contract, gave him a monopoly for a period of seventeen years, and good faith on the part of the public would preclude infringement during that period; but individuals, who are a part of that public, acting in their individual capacity, violate such contracts, and infringe upon the exclusive rights of the inventor and, therefore, become liable to the inventor, in damages to the extent of the injury wrought him by their unlawful acts. The exclusive jurisdiction for such infringement is vested in the Federal courts and the statutes of the United States provided at the time when the patent in the suit at bar was granted, no limitation as to the time such a suit should be brought; therefore, it was a part of the contract that a suit might be brought to recover damages at any time after damages should be discovered.

Mr. Chief Justice Marshall, speaking for this Court, in *Grant et al.* v. *Raymond*, 6 Wheat., 218, 242, said:

> "It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and it is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they may have been made, and to execute the contract fairly, on the part of the United States, when the full benefit has been actually received; if this can be done without transcending the intention of the statute or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it contracted to receive. The benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved, and, for the exclusive enjoyment of it during that time the public faith is pledged."

In this opinion the Court treated the letters patent as a contract between the inventor and the public acting through the government of the United States, and, therefore, I submit, that any State law which would deprive the inventor of any part of his rights by creating a bar to the action provided by the United States as a part of the contract, for the benefit of the inventor, would be void if applied to suits brought to recover damages for infringement of patents.

And in *Robinson on Patents*, Vol. 3, sec. 980, pp. 175, 176, the author says:

> "The peculiar nature of a patent right as a universal franchise co-extensive with the United States, its extreme susceptibility to secret in-

> vasion, the fact that numerous causes of action against different defendants involving in the main the same issues, and practically requiring but one extended litigation, often arise almost simultaneously, and the manifest advantage of uniformity throughout the entire country in all matters connected with the enforcement of any universal right, indicate that this important feature of remedial jurisprudence is solely within Federal jurisdiction, and can be regulated only by acts of Congress. If these prescribe no period of limitation for the remedies which they provide in cases where the rights which they create are violated, it is a fair presumption that Congress, in whom the supreme power over all these subjects unquestionably resides, intends that no such limitation shall exist."

I now submit, both on reason and authority, that the statutes of the United States relating to infringements of patents are such that, *proprio vigore*, they are brought within the exception contained in section 721 of the Revised Statutes of the United States, and are such statutes as require that the rules of decisions in trials at common law shall not in cases for infringement apply, and that therefore the Court below erred in applying the statute of limitations of the Commonwealth of Massachusetts to the case at bar.

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